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

Proceeding	91224580
Party	Plaintiff Andre Young
Correspondence Address	JAMES D WEINBERGER FROSS ZELNICK LEHRMAN & ZISSU PC 4 TIMES SQUARE, 17TH FLOOR NEW YORK, NY 10017 UNITED STATES Email: jweinberger@fzlz.com, eweiss@fzlz.com
Submission	Brief on Merits for Plaintiff
Filer's Name	James D. Weinberger
Filer's email	jweinberger@fzlz.com
Signature	/s/ James D. Weinberger
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ANDRE YOUNG, Opposer, -against- DRAION M. BURCH DO, LLC, Applicant.	Consolidated Proceedings Opposition No. 91224580 (parent) Opposition No. 91226572

OPPOSER ANDRE YOUNG'S TRIAL BRIEF

James D. Weinberger (jweinberger@fzlz.com)
Emily Weiss (eweiss@fzlz.com)
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
4 Times Square, 17th Floor
New York, New York 10036
(212) 813-5900

Attorneys for Opposer Andre Young

TABLE OF CONTENTS

TABLE OF AUTHORITIES

CASES

STATUTES

RULES

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE

TREATISE

PRELIMINARY STATEMENT

Opposer Andre Young, known by his stage name Dr. Dre (referred to herein as "Dr. Dre" or "Opposer"), is one of the most influential people in music. Dr. Dre pioneered West Coast hip hop in the 1980s and then went on to produce some of the most successful artists of the last twenty years. Dr. Dre also is an entrepreneur and businessman, known for his popular line of headphones. As a result of his extraordinary success, *Forbes* magazine ranked Dr. Dre as the eighth wealthiest celebrity in 2016. Moreover, *The New York Times* has called him "the single most important force behind L.A. hip-hop," *Rolling Stone* has referred to him as "one of the greatest producers of the past 25 years," and National Public radio has called him "hip-hop's most lauded musician." Accordingly, it cannot be disputed that Dr. Dre is incredibly well known throughout the United States. In addition, since 1999, the mark DR. DRE has been registered with the United States Patent and Trademark Office ("USPTO") for use in connection with a variety of good and services, including entertainment services.

Nearly two decades after Opposer registered the DR. DRE mark with the USPTO, Applicant Draion M Burch Do, LLC ("Applicant") applied to register the marks DR. DRAI and DOCTOR DRAI OBGYN & MEDIA PERSONALITY & Design for various goods and services, including entertainment services. Applicant's registration and use of the DR. DRAI and DOCTOR DRAI OBGYN & MEDIA PERSONALITY & Design marks is likely to falsely suggest a connection with Dr. Dre and to cause confusion with Opposer's DR. DRE mark. Accordingly, this opposition should be sustained and Applicant's applications to register the DR. DRAI and DOCTOR DRAI OBGYN & MEDIA PERSONALITY & Design marks should be refused under Sections 2(a) and 2(d) of the Lanham Act, 15 U.S.C. §§ 1052(a), 1052(d).

FACTUAL RECORD

A. Dr. Dre's Evidence

Dr. Dre submitted during his testimony period the following Notices of Reliance:

- Notice of Reliance on Official Records and Exhibits DR1-DR7, which consist of Opposer's trademark registrations for the DR. DRE mark, an office action finding that Opposer is "so famous" that the mark DOCS BY DRE was likely to falsely suggest a connection with Opposer, and documents filed with or issued by the Board demonstrating Opposer's enforcement efforts (dkt no. 14);
- Notice of Reliance on Discovery Responses and Exhibit DR8, which consists of Applicant's responses to certain of Opposer's interrogatories (dkt. no. 15);
- Notice of Reliance on Printed Publications and Exhibits DR9-DR196, which consist of printed publications and Internet printouts concerning Dr. Dre or his goods or services offered under the DR. DRE mark (dkt. nos. 16-18);
- Rebuttal Notice of Reliance on Discovery Responses and Exhibit DR197, which consists of Applicant's responses to one of Opposer's interrogatories (dkt. no. 27); and
- Rebuttal Notice of Reliance on Printed Publications and Exhibits DR198-DR200, which consist of printouts from Amazon.com rebutting Applicant's claim that the books authored by Applicant's owner are best sellers (dkt. no. 28).

B. Applicant's Evidence

Applicant submitted testimony and exhibits through the June 21, 2017 trial deposition of Dr. Draion M. Burch ("Burch Tr.") (dkt. no. 25), who is the owner of Applicant. Applicant also submitted during its testimony period a Notice of Reliance and exhibits attached thereto ("App. Not. Reliance") (dkt. nos. 20-21).

STATEMENT OF FACTS

A. Dr. Dre and His DR. DRE Mark

1. Brief Biography of Dr. Dre

Dr. Dre, who grew up in Compton, California, was a founding member of the rap group N.W.A., along with rappers Eazy-E and Ice Cube. (Ex. DR77.)[1] In the early 1990s, Dr. Dre broke out on his own, leaving Eazy-E's record company and launching Death Row Records. (Exs. DR77, DR150.) In 1992, Dr. Dre released his first solo album, *The Chronic*, which spent many months in the top ten and was the sixth best-selling album of 1993. (Exs. DR77, DR140, DR147.) Indeed, the album was so successful that *The New York Times* referred to it as "the year's 'Jurassic Park.'" (Ex. DR133.) *The Chronic* also jumpstarted the career of Snoop Doggy Dogg, whose first album was produced by Dr. Dre. (Exs. DR141-DR143.) Dr. Dre has produced work for many other artists as well, including 2Pac, Ice Cube, and The Lady of Rage. (Exs. DR128, DR131, DR134.)

Dr. Dre eventually left Death Row Records and founded the record label Aftermath Entertainment. (Ex. DR127.) Aftermath Entertainment has signed some of the biggest artists of

[1] While Opposer is aware that generally printed publications cannot be used to prove the truth of the statements contained in them, Rule 803(16) of the Federal Rules of Evidence provides that a "statement in a document that is at least 20 years old and whose authenticity is established" is an exception to the hearsay rule. Newspapers and periodicals are self-authenticating. *See* Fed. R. Evid. 902(6). Therefore, Opposer can rely on the printed publications introduced through its Notice of Reliance on Printed Publications that are at least twenty years old, or were published before May 1997, for the truth of the statements asserted therein. *See Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1086 n.20 (T.T.A.B. 2014).

the last two decades, including Eminem, 50 Cent, and Kendrick Lamar. (Ex. DR183 (website of Aftermath Entertainment showing artists signed to label).)

2. The Fame and Legacy of Dr. Dre

a. Press Coverage of Dr. Dre

The press has covered nearly every aspect of Dr. Dre's career. Both Dr. Dre's solo albums and albums released by N.W.A. have been the subject of extensive press coverage, including reviews of the albums and articles noting the albums' extensive sales. (Exs. DR24, DR27, DR37-DR40, DR42-47, DR49, DR51-DR52, DR62, DR92-DR93, DR145-DR147, DR149, DR151.) The press also has covered Dr. Dre's collaborations with and production work for other artists, such as Eminem, 50 Cent, Jay-Z, Snoop Doggy Dogg, The Game, Mary J. Blige, Ice Cube, Eve, Gwen Stefani, and 2Pac, among others. (Exs. DR89, DR95, DR98-DR99, DR101, DR103, DR105-DR106, DR116-DR117, DR122, DR128, DR131, DR134, DR139, DR141-DR144, DR157.) Indeed, even Dr. Dre's unreleased *Detox* album has been the subject of numerous articles, with the press speculating over a period of many years whether and when the album would be available. (Exs. DR48, DR71, DR73, DR75-DR76, DR81, DR84.)

The media also has written about the awards received by Dr. Dre and his performances at various awards shows, such as the Grammy Awards (Exs. DR22, DR72, DR107, DR118-120), the American Music Awards (Exs. DR123-DR124), the Billboard R&B/Hip-Hop Awards (Ex. DR109), ASCAP awards (Exs. DR83, DR110), and the Source Hip-Hop Music Awards. (Exs. DR129, DR136-DR137.) In addition, Dr. Dre has been interviewed or profiled in numerous publications, including *Rolling Stone*, *Hollywood Reporter*, and *Vibe*, and on programming on MTV and National Public Radio. (Exs. DR41, DR50, DR77, DR80, DR97, DR112, DR121.)

As a result of Dr. Dre's storied career, numerous national publications have remarked on his fame and legacy. A selection of such articles is provided below:

- An article in the January 16, 1993 issue of *Billboard* magazine referred to the album *The Chronic* as the "first rap music masterwork of 1993." (Ex. DR147.)
- *Rolling Stone* magazine published a profile of Dr. Dre in the summer of 1993. The profile quoted Jimmy Iovine, the co-head of Interscope Records, as saying that "'[t]here aren't three people like [Dr. Dre] in the music business. . . . He can rap, he can produce and he can direct a video with humor.'" Moreover, the article stated that it was "Dre's production work—on Eazy-E, on N.W.A., on Snoop Doggy Dogg, on himself—that made gangsta rap among the most vital pop genres to come along in the last few years." Finally, the article noted the diversity of Dr. Dre's fan base, from listeners in the South Bronx to suburban high school kids. (Ex. DR77.)
- *The New York Times*, in an article dated November 21, 1993, credited Snoop Doggy Dog's success to his producer Dr. Dre, who the article described as "an innovator as important in hip-hop as Quincy Jones has been in jazz. Unlike most hip-hop producers who create tracks by sampling from original sources, Dr. Dre uses a band." Moreover, *The New York Times* quoted another rapper as saying that "'I don't know if Snoop would be as big [without Dr. Dre], because Dre's production plays a big part.'" (Ex. DR143.)
- An article in the November 27, 1993 issue of *Billboard* magazine stated: "To industry observers (and everyone else), Snoop Doggy Dogg and Dre were behind the most significant musical and marketing stories in rap this year." (Ex. DR142.)
- In an August 14, 1994 article comparing New York City rap with Los Angeles rap, *The New York Times* remarked that "[t]hough L.A. has produced a few great rappers like the

Pharcyde, Snoop Dogg and the Lady of Rage, most of them were discovered and are produced by Dr. Dre. From N.W.A. to Snoop, Dre has been the single most important force behind L.A. hip-hop. Take him off the screen, and in a discussion of hip-hop esthetics, L.A. fades to black." (Ex. DR133.)

- In an interview with Dr. Dre published in *Scratch* magazine in summer 2004, Dr. Dre was described as the "measuring stick for how far hip hop's come and where it's going. You can't deny the gift the man has for putting together some hot shit. Truth be told, he makes anyone sound good." (Ex. DR104.)
- A March 10, 2005 article in *Slate* magazine examined why Dr. Dre's protégés always become best-selling artists, or what the article referred to as "Dre's Midas touch." According to the article, "the former Andre Young finally has his hitmaking formula down to a science—just plug in a new rapper and clear some wall space for the platinum records." However, Dr. Dre's "aesthetic genius alone doesn't account for the speed with which Dre productions ascend the charts; plenty of hip-hop producers know how to put together a catchy song. Dre became a mogul, rather than a mere superstar producer, because of his innate grasp of two core business principles: quality control and law of supply and demand." Moreover, music produced by Dr. Dre was so sure to be a hit that "[m]agazines and clothing companies can be confident that the pre-release capital they spend plugging Dre's protégés is a safe bet—sort of like buying hip hop's version of municipal bonds." (Ex. DR101.)
- In a June 29, 2006 review of the album *Death Row's Greatest Hits: The Chronicles* in *Pitchfork*, the reviewer stated that "[l]avishing Andre Young with praise is like getting worked up about filet mignon. You're not going to impress anybody with description

and deification. Dr. Dre didn't just reconfigure rap music with *The Chronic*, he played perhaps the largest role in making it the most viable form of American popular music this century." (Ex. DR100.)

- A June 1, 2007 profile of Dr. Dre on National Public Radio stated that "[p]roducer Dr. Dre is one of the most important and influential figures in rap music, known for popularizing the distinct West Coast rap sound." (Ex. DR97.)
- A September 2, 2007 article on the website *www.ihill.com* about Dr. Dre's movie production deal quoted an executive from New Line Cinema as saying "'[e]verything Dre has worked on becomes a hit, and one of the reasons for that is that he never puts his name on anything that he doesn't really believe in.'" (Ex. DR94.)
- An August 9, 2008 article in *Billboard* magazine stated that N.W.A.'s *Straight Outta Compton* album "is considered a pioneering record of gangsta rap" and it "redefined the direction of hip-hop at the time, shifting powers to the West Coast from the East Coast." (Ex. DR92.)
- In a June 2, 2010 article in *Billboard* magazine about Dr. Dre receiving the ASCAP Founders Award, which is given to "songwriters and composers whose musical legacies have inspired and influenced fellow music creators," ASCAP's president stated that "'Dre is one of the most important voices in modern music. . . . He created a unique, recognizable sound that dominated rap music in the early 90s and continues to inspire artists and producers across all genres with his musical techniques.'" (Ex. DR83.)
- In an August 8, 2013 review of N.W.A.'s *Straight Outta Compton* album published in *Billboard* magazine, N.W.A. was described as "documentarians, shining much needed light on the plight of a class of increasingly disgruntled and disenfranchised Americans."

Moreover, the review notes that *Straight Outta Compton*'s "significance as West Coast hip-hop and gangsta rap's breakthrough album cannot be understated." (Ex. DR62.)

- A July 31, 2015 article in *Rolling Stone* stated that as early as 2002 Dr. Dre "was already considered one of the greatest producers of the past 25 years." (Ex. DR48.)
- An article in the August 3, 2015 issue of *Forbes* magazine called Dr. Dre a "legendary rapper and producer." Moreover, "in addition to producing hits for some of the most popular acts in hip-hop, Dre has also become the industry's most successful businessman" as a result of the Beats by Dre line of headphones. (Ex. DR46.)
- A review of Dr. Dre's *Compton* album, published by National Public Radio on August 7, 2015, called Dr. Dre "hip-hop's most lauded musician." (Ex. DR44.)
- *Billboard* magazine's review of Dr. Dre's *Compton* album, published on August 10, 2015, stated that "Dre has the most bulletproof reputation in hip-hop. . . . The truth is, no one in hip-hop makes music that sounds this good." (Ex. DR43.)
- A January 14, 2017 article in *USA Today* called Dr. Dre one of "the most influential people in popular culture." (Ex. DR9.)

b. Dr. Dre's Commercial and Critical Success

Dr. Dre's music has been both commercially and critically successful. Dr. Dre has had nine songs on the *Billboard* Hot 100 chart, and he has won six Grammy Awards. (Exs. DR176, DR184.) Moreover, the total global sales for his three solo albums is over 17 million. (Ex. DR185.)[2]

[2] Opposer relies on Exhibits DR176, DR184, and DR185 to prove the truth of the statements contained therein under Rule 803(17) of the Federal Rules of Evidence, which provides that "[m]arket quotations, lists, directories, or other compilations that are generally relied on by the public or by persons in particular occupations" are not excluded by the rule against hearsay.

As a result of such success, Dr. Dre consistently is ranked as one of the world's wealthiest musicians. For example, Dr. Dre has appeared in *Forbes* magazine's annual Cash Kings list, which has ranked the top-earning hip-hop stars since 2007. (Ex. DR91.) Dr. Dre was ranked fifth in 2007 with a reported $20 million in earnings, fourth in 2008 with a reported $15 million in earnings, fifth in 2010 with a reported $17 million in earnings, sixth in 2011 with a reported $14 million in earnings, first in 2012 with a reported $110 million in earnings, first in 2014 with a reported $620 million in earnings, fourth in 2015 with a reported $33 million in earnings, and third in 2016 with a reported $41 million in earnings. (Exs. DR14, DR33, DR56, DR66, DR70, DR79, DR91, DR96.)[3] Based on these earnings, *Forbes* named Dr. Dre the highest-earning hip-hop performer of the last decade, finding that his earnings accounted for one-fifth of the total earnings of all hip-hop acts who have appeared on the Cash Kings list. (Ex. DR16.) Moreover, in 2016, *Forbes* ranked Dr. Dre as the second wealthiest hip-hop artist, reporting that he was worth about $710 million. (Ex. DR20.)

Dr. Dre has been included in broader rankings as well. In 2016, *Forbes* named Dr. Dre the eighth richest celebrity in the United States, and in 2012 and 2014, *Forbes* ranked him as the world's highest paid musician. (Exs. DR10, DR54, DR64.) Finally, *Rolling Stone* reported that Dr. Dre was the second highest earning artist in 2001. (Ex. DR111.)

c. Recognition of Dr. Dre in Reference Works

Dr. Dre's renown and commercial success is further demonstrated by his recognition in reference works. For example, the Encyclopedia Britannica has an entry for Dr. Dre, which

[3] To be clear, Opposer does not rely on these Internet printouts to prove that Dr. Dre in fact earned these amounts each year, but to demonstrate that he is consistently included in *Forbes* magazine's rankings of the top earnings artists.

chronicles his life and work.[4] Moreover, Dr. Dre and his musical works are featured in many online reference works, such as Wikipedia, Genius, IMDB, Biography, and AllMusic. (Exs. DR152-155, DR158-DR162, DR175, DR179-DR180, DR192-DR196.)

d. Dr. Dre's Online Presence

Opposer maintains an extensive presence online under the name and mark DR. DRE. Dr. Dre maintains his own website as well as social media accounts. (Exs. DR182, DR188-DR191.) Millions of consumers are exposed to the DR. DRE name and mark on Dr. Dre's social media sites; the Dr. Dre Facebook page reflects that it has over 14 million likes, the Dr. Dre Instagram page reflects that it has over 1.7 million followers, the Dr. Dre Twitter page reflects that it has over 2.9 million followers, and the Dr. Dre YouTube page reflects that it has over 1.6 million subscribers and has been viewed over 890 million times. (Exs. DR188-DR191.) In addition, Dr. Dre's albums and singles are available for sale and streaming on Amazon.com, iTunes, and Google Play. (Exs. DR178, DR186-DR187.)

3. Opposer's Trademark Registrations for the DR. DRE Mark

Dr. Dre owns several trademark registrations for the DR. DRE mark, including the following registrations:

- U.S. Registration No. 2,275,314 for use in connection with "series of musical sound recordings" in International Class 9, registered on September 7, 1999, and based on a first use in commerce in 1981;

[4] The Board may take judicial notice of information in encyclopedias. *See B.V.D. Licensing, Corp. v. Body Action Design, Inc.*, 6 U.S.P.Q.2d 1719, 1721 (Fed. Cir. 1988); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 U.S.P.Q.2d 1921, 1934 n.61 (T.T.A.B. 2011).

- U.S. Registration No. 2,271,448 for use in connection with "clothing, namely, T-shirts, sweatshirts, caps" in International Class 25, registered on August 24, 1999, and based on a first use in commerce in 1981;
- U.S. Registration No. 2,271,449 for use in connection with "posters, art prints and stickers" in International Class 16, registered on August 24, 1999, and based on a first use in commerce in 1981; and
- U.S. Registration No. 2,271,450 for use in connection with "entertainment services by a musical artist and producer, namely, musical composition and production of musical sound recordings" in International Class 41, registered on August 24, 1999, and based on a first use in commerce in 1981.

(Exs. DR1-4.) All of the above registrations have become incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and therefore serve as conclusive proof of Dr. Dre's exclusive right to use the marks in connection with the goods and services identified therein, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

B. Applicant and Its DR. DRAI Mark

1. Applications to Register Applicant's Marks

Applicant, a Pennsylvania limited liability company, is owned and managed by Dr. Draion M. Burch. (Burch Tr. at 8:19-9:4.) Two applications of Applicant are at issue in this proceeding:

- Application Serial No. 86/590,205 for the mark DR. DRAI in standard character format (the "DR. DRAI Word Mark") for use in connection with "educational and entertainment services, namely, providing motivational speaking services in the field of osteopathic medicine, obstetrics and gynecology provided by a doctor" in International Class 41 and

"health care consulting in the field of osteopathic medicine, obstetrics and gynecology rendered by a doctor; obstetric and gynecology services rendered by a doctor" in International Class 44; and

- Application Serial No. 86/730,410 for the mark 

(the "DOCTOR DRAI Design Mark," and together with the DR. DRAI Word Mark, "Applicant's Marks") for use in connection with "audio books in the field of women's health and men's health; downloadable MP3 files, MP3 recordings, on-line discussion board posts, webcasts, webinars and podcasts, news, and audio books in the field of women's health and men's health; downloadable webinars in the field of women's health and men's health; electronic publications, namely, magazines, books, manuals, worksheets, workbooks, blogs, journal articles, newspapers, tutorials, forums, research papers, conference papers featuring men's health and women's health topics recorded on computer media" in International Class 9; "a series of books, written articles, handouts and worksheets in the field of men's health and women's health" in International Class 16; "education services, namely, providing non-downloadable webinars in the field of women's health and men's health; education services, namely, providing classes, webinars, seminars, workshops, conferences in the fields of women's health and men's health; educational and entertainment services, namely, providing motivational and educational speakers; educational and entertainment services, namely, providing motivational speaking services in the field of osteopathic medicine, obstetrics and gynecology; educational services, namely, conducting classes, seminars, conferences, workshops in the fields of women's health and men's health and distribution of training materials in connection therewith; educational services, namely,

providing online instruction in the field of women's health" in International Class 41; and "providing a web site featuring medical information; Providing medical information; Providing medical information, consultancy and advisory services" in International Class 44.

Applicant did not conduct a trademark search before applying to register either mark. (Burch Tr. at 135:21-22; Ex. DR8 at response no. 13.)

The application for the DR. DRAI Word Mark is based on a first use in commerce of July 1, 2011, and the application for the DOCTOR DRAI Design Mark is based in part on a first use in commerce of July 1, 2011, and in part on an intent to use the mark under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b). However, Applicant's testimony calls into doubt the claimed date of first use of July 1, 2011. Specifically, Applicant previously had applied to register the DR. DRAI Word Mark for use in connection with similar services, but the prior application was based on a first use in commerce of September 2013. (Burch Tr. 137:2-9 & Ex. 23.) Applicant could not explain the discrepancy between the dates of first use. (*Id.* at 147:20-148:6.)

This was not the only discrepancy in Applicant's testimony. In an interrogatory response, Applicant stated that it did not become aware of the DR. DRE mark until it received Opposer's cease-and-desist letter in 2015. (Ex. DR197 at response no. 12.) Dr. Burch then testified at trial that he first became aware of Dr. Dre when he purchased Dr. Dre's Beats by Dre headphones sometime between August 2011 and June 2015. (Burch Tr. at 173:20-174:12.) When pressed on cross examination whether Dr. Burch had truly not heard of Dr. Dre until he purchased Beats by Dre headphones, Dr. Burch admitted that he had "heard of the name before, but not in detail." (*Id.* at 176:5-6.) These discrepancies call into question Dr. Burch's credibility as a trial witness.

2. Applicant's Limited Use of Applicant's Marks

Despite Dr. Burch's testimony that Applicant has extensively used Applicant's Marks and that he is well known, the evidence in the record shows that very few consumers have been exposed to Applicant's Marks. For example, Dr. Burch testified that all of his books, which are marketed under one or both of Applicant's Marks, are best sellers on Amazon.com. (*Id.* at 57:9-11 & Ex. 3, 11, 13, 15.) However, none of Dr. Burch's books, which are self-published (*id.* at 160:5-7), are best sellers on Amazon.com, as demonstrated by printouts from Amazon.com showing the rankings of Dr. Burch's books. (Ex. DR198 (showing that the Kindle version of *20 Things You May Not Know About the Penis* is ranked 1,244,747 and the paperback version is ranked 2,731,209); Ex. DR199 (showing that the Kindle version of *The Making of a Medical Mogul, Volume 1* is ranked 2,637,961 and the paperback version is ranked 3,728,816); Ex. DR200 (showing that the Kindle version of *From Medicine to Mogul: 7 Steps to 7 Figures* is ranked 938,956).) Moreover, Dr. Burch himself testified that only over a hundred people have purchased his book *20 Things You May Not Know About the Penis*. (Burch Tr. at 44:6-8.)

Dr. Burch also testified that he has "been in media a lot" and he describes himself as a "go-to media expert on women's health & transhealth." (*Id.* at 38:9, 45:15-16.) However, he has appeared on television only eleven or twelve times and those appearances mainly were limited to local audiences. (*Id.* at 63:4-7 & Ex. 12.) Also, the webinars that Dr. Burch conducts are watched by only twenty to thirty people. (*Id.* at 54:6-8.) As such, consumers have not been extensively exposed to Applicant's Marks.

Indeed, there are many other reasons to discount much of Dr. Burch's testimony as exaggerated self-promotion. For example, Dr. Burch testified that he has a Facebook fan page because he is a "public figure" who is in the "limelight" (*Id.* at 35:18-36:14), but such testimony

is belied by the fact that his Facebook page reflects that it has only 6,800 fans, despite Dr. Burch's efforts to attract more Facebook fans. (*Id.* at 37:16-38:5 & Ex. 4.) Dr. Burch barely has a following on his other social media profiles either, such as YouTube (only 1,941 subscribers), Google+ (only 3,198 followers), Pinterest (only 3,700 followers), Instagram (only 5,233 followers), and Twitter (only 6,689 followers). (*Id.* at 39:12-51:10 & Exs. 5-9.) These numbers are not consistent with Dr. Burch's claim that he is a public figure or the "go-to" expert on women's health and, again, raise serious questions about Applicant's credibility as a witness.

ARGUMENT

Dr. Dre has opposed the applications to register Applicant's Marks on the grounds of false suggestion with a person, living or dead, under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and likelihood of dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).[5]

A. Dr. Dre Has Established Standing

As an initial matter, Dr. Dre has standing to bring this proceeding. Under the Lanham Act, "[a]ny person who believes he would be damaged by the registration of a mark" may file an opposition. 15 U.S.C. § 1063(a). This threshold standing requirement is satisfied where the opposer possesses a "real interest" in the proceeding. *Compuclean Mktg. & Design v. Berkshire Prods., Inc.*, 1 U.S.P.Q.2d 1323, 1324 (T.T.A.B. 1986) (citing cases). As the owner of the DR. DRE mark and registrations for the same, Dr. Dre has standing to challenge the applications for Applicant's Marks, which falsely suggest a connection to Dr. Dre and are confusingly similar to the DR. DRE mark. Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 309.03(b). Standing is therefore established.

[5] Opposer has elected not to pursue his dilution claim.

B. Applicant's Marks Falsely Suggest a Connection with Dr. Dre

Section 2(a) of the Lanham Act states in pertinent part that a trademark shall be refused registration if it "consists of or comprises . . . matter which may . . . falsely suggest a connection with persons living or dead . . . ." 15 U.S.C. § 1052(a). Following the Federal Circuit's decision in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 217 U.S.P.Q. 505 (Fed. Cir. 1983), the Board utilizes the following four-part test to determine whether a false suggestion of a connection has been established: (i) the applicant's mark is the same as, or a close approximation of, the name of or identity previously used by another person; (ii) the applicant's mark would be recognized as such because it points uniquely and unmistakably to that person; (iii) the person named by the mark is not connected with the activities performed by the applicant under the mark; and (iv) the prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods or services. *See, e.g.*, *In re Peter S. Herrick P.A.*, 91 U.S.P.Q.2d 1505, 1507 (T.T.A.B. 2009); *Hornby v. TJX Cos.*, 87 U.S.P.Q.2d 1411, 1424 (T.T.A.B. 2008). Each of these elements is satisfied here.

1. Applicant's Marks are a Close Approximation of DR. DRE

There is no requirement that the competing names be identical in order for there to be a false suggestion under Section 2(a). Rather, Applicant's Marks need only be a "close approximation" of the name previously used by another person. 15 U.S.C. § 1052(a); *see also In re Peter S. Herrick*, 91 U.S.P.Q.2d at 1507; *In re White*, 80 U.S.P.Q.2d 1654, 1658 (T.T.A.B. 2006). Here, Applicant's Marks are unquestionably a "close approximation" of the previously-used name DR. DRE.

Opposer has used and has been referred to by the press as DR. DRE for decades, and Dr. Dre is the name under which he achieved fame. (*See* pages 10-17, *supra*.) Applicant has applied to register the marks DR. DRAI and DOCTOR DRAI OBGYN MEDIA PERSONALITY & Design. Applicant has admitted that DR. DRAI sounds identical to DR. DRE (Burch Tr. at 154:20-155:1), and, thus, a consumer hearing them would think they are the same. As to appearance, the names look remarkably similar. Both of Applicant's Marks and DR. DRE begin with the terms doctor or the abbreviation for doctor, which are followed by a term that begins with the letters "D" and "R" and ends with vowels that make the same sound.

The inclusion of a the terms OBGYN MEDIA PERSONALITY and a design element in the DOCTOR DRAI Design Mark does not preclude a finding that the DOCTOR DRAI Design Mark is a close approximation of DR. DRE. As the Board has repeatedly stated, an applicant cannot overcome a Section 2(a) challenge by merely adding matter to a person's name. *See In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co.*, App. Ser. No. 77600412, 2012 WL 3224711, at *3 (T.T.A.B. July 11, 2012) (finding the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) a close approximation of the name Benny Goodman); *In re Peter S. Herrick*, 91 U.S.P.Q.2d at 1508 (stating that applicant's addition of design elements did not avoid commercial impression that the mark was a "close approximation"); *In re Hsieh*, App. Ser. No. 78367205, 2008 WL 4877059, at *2 (T.T.A.B. Oct. 29, 2008) (applicant's P. MAURIAT & Design mark was a close approximation of the name of composer and musician PAUL MAURIAT); *In re N. Am. Free Trade Ass'n*, 43 U.S.P.Q.2d 1282, 1285 (T.T.A.B. 1997) (finding applicant's NAFTA & Design mark a close approximation of NAFTA).

Accordingly, Applicant's Marks are a "close approximation" of the DR. DRE name and the first element for finding a false suggestion is satisfied.

2. Applicant's Marks Point Uniquely and Unmistakably to Dr. Dre

The second factor asks whether consumers would view Applicant's Marks as pointing uniquely and unmistakably to Dr. Dre. *See Hornby*, 87 U.S.P.Q.2d at 1423. Here, as detailed above, Dr. Dre is considered one of the most influential and prominent people in American music over the past quarter century. (*See* pages 10-17, *supra*.) Indeed, Dr. Dre is credited with making rap "the most viable form of American popular music this century" (Ex. DR100), and *USA Today* described him as one of "the most influential people in popular culture." (Ex. DR44.) Moreover, Dr. Dre has been called "the industry's most successful businessmen" (Ex. DR46), and he consistently has been featured in *Forbes* magazine's various rankings of the wealthiest rappers and musicians. (*See* pages 15-16, *supra*.) As such, the name DR. DRE points uniquely and unmistakably to Opposer.

The issue, then, is whether Applicant's Marks would, in the minds of the consuming public, likewise point uniquely and unmistakably to Dr. Dre, or whether consumers would perceive Applicant's Marks as having a different meaning. *See In re Jackson Int'l Trading*, 2012 WL 3224711, at *2. Because of the undeniable renown of Dr. Dre, Opposer submits that the answer to this question is straightforward: Applicant's Marks, which are identical in sound to the well-known name Dr. Dre, inevitably remind consumers of the famous musician and entrepreneur Dr. Dre.

Applicant made of record evidence purporting to show third-party marks or names similar to the name Dr. Dre, but this evidence does not establish that consumers would perceive Applicant's Marks as having a meaning other than Dr. Dre. Applicant introduced two types of

evidence: third-party registrations for marks purportedly similar to DR. DRE (App. Not. Reliance, Ex. A) and Internet printouts referencing five third parties who purportedly use marks or names similar to DR. DRE. (App. Not. Reliance, Exs. D, F, G, H, I, L.) As for the third-party registrations, the Board repeatedly has held that third-party registrations "are not evidence that the marks which are the subjects thereof are in use and that the public is familiar with the use of those marks." *In re White*, 80 U.S.P.Q.2d at 1659-60 (noting that Applicant had not pointed to any case law holding that third-party registrations should be accorded significant weight in a Section 2(a) claim); *see also In re Pedersen*, 109 U.S.P.Q.2d 1185, 1196-97 (T.T.A.B. 2013). Moreover, none of the registrations are for the same goods and services as those identified in Applicant's applications, making their probative value negligible even if they were supported by evidence of use (which they are not). *In re Pedersen*, 109 U.S.P.Q.2d at 1197 (explaining that third-party registrations for goods and services unrelated to applicant's goods "have little, if any, probative value"). Therefore, the third-party registrations do not show that Applicant's Marks do not point uniquely and unmistakably to Dr. Dre.

As for the Internet printouts, they likewise do not rebut Opposer's showing that Applicant's Marks point uniquely and unmistakably to Dr. Dre. As an initial matter, the "requirement that [Applicant's Marks] point 'uniquely' to [Dr. Dre] does not mean that [DR. DRE] must be a unique term." *Hornby*, 87 U.S.P.Q.2d at 1426. Rather, the question is whether consumers would view Applicant's Marks as pointing to Dr. Dre, or whether they would perceive such marks to have a different meaning. *Id.* None of Applicant's Internet printouts show that any of the referenced third-party people or places are as famous as Dr. Dre. Much of Applicant's Internet evidence concerns the MTV host Doctor Dré (App. Not. Reliance, Exs. D, I), but there is no evidence in the record that the MTV host Doctor Dré has achieved renown

comparable to that of Opposer. Moreover, Applicant's own evidence shows that consumers do not consider Doctor Dré as famous as Opposer. For example, consumers wrote the following comments in an online message board made of record by Applicant: "Until just now, I didn't know there were two. I only know the Dr. Dre who hangs around with Snoop Dogg and Eminem. So to me, he is the only Dr. Dre," and "I never really faced much confusion with the two Dres. In the 80's 'Dr. Dre' was just the fat host of that show. His popularity waned. Then, when 'The Chronic' hit (in 91?) there was no mistaking Dr. Dre for the fat guy." (App. Not. Reliance, Ex. I.) Moreover, the Encyclopedia Britannica has an entry for Opposer and does not have any entry for the MTV host Doctor Dré.[6] (*See* pages 16-17, *supra*.) Therefore, the evidence relating to the MTV host Doctor Dré has no bearing on this factor.

The remainder of Applicant's Internet printouts similarly do not show that any of the people or places referenced have achieved anything even close to Dr. Dre's level of fame, as they merely consist of articles or Internet printouts referring to or referencing the third parties.[7] (App. Not. Reliance, Exs. F, G, H, L.) Moreover, a total of five third parties is not sufficient to rebut Opposer's evidence. *See In re Pedersen*, 109 U.S.P.Q.2d at 1195 (finding fourteen examples of third-party use "not sufficient"). Accordingly, it is undeniable that consumers would recognize

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[6] Applicant also introduced what it describes as an "[a]rticle confus[ing] Petitioner [sic] with third party Doctor Dre while discussing Petitioner [sic]." (App. Not. Reliance, Ex. K.) However, there is no confusion in this article. Rather, the article consists of several blurbs about developments in rap music. One blurb discusses Opposer's *The Chronic* album, and another blurb discusses the film *Who's The Man?*, which starred the MTV host Doctor Dré. It is clear that the article recognizes that these are two different people.

[7] In addition, none of the other referenced third parties are using a name as similar to Dr. Dre as Applicant is using. The other people and places referenced in Applicant's Internet printouts are a nightclub called Drai, a talent scout named Irene Dreayer who is referred to as The Dray, a podcast called Dray Day, and a Detroit-based DJ with the stage name SuperDre. (App. Not. Reliance, Exs. F, G, H, L.) Unlike Applicant, none of these third parties use the terms "doctor" or "dr." in their names or marks.

Applicant's Marks as a reference to Dr. Dre, not any third party. *See In re Sauer*, 27 U.S.P.Q.2d 1073, 1074 (T.T.A.B. 1993) (rejecting applicant's argument that BO BALL & Design would not be understood to refer to Bo Jackson due to other widely recognized celebrities with the given name "Bo"; the Board found that "[w]hile these other people named 'Bo' have been in the public eye to varying degrees, the record does not show that any of them is famous to nearly the same degree as Bo Jackson").

Applicant's Marks further point to Dr. Dre because the applied-for services include entertainment services. As set forth above, Dr. Dre is known in the press as a musician and producer. (*See* pages 11-15, *supra*.) Therefore, because Applicant has applied to use its marks in connection with services that relate to the industry in which Dr. Dre is recognized, it is beyond question that Applicant's Marks would be viewed by the public as pointing uniquely and unmistakably to Dr. Dre. *See In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629, 1637 (T.T.A.B. 2015) (finding that the ROYAL KATE mark, when used in connection with fashion products, was likely to be viewed as pointing to Kate Middleton because she is a fashion trendsetter); *In re Peter S. Herrick*, 91 U.S.P.Q.2d at 1508 (finding applicant's mark likely to be viewed as pointing to U.S. Customs and Border Protection because applicant's applied-for services related to U.S. customs law).

For these reasons, the second element is satisfied.

3. Dr. Dre is Not Connected to Applicant

There is no evidence in the record that Dr. Dre has any connection with Applicant or its applied-for goods and services, nor has Applicant claimed that any such connection exists. Indeed, the very fact that Dr. Dre brought this proceeding shows that Dr. Dre does not have any connection to Applicant. *See King v. Trace Publ'g Co.*, Opp. No. 91096881, 1999 WL 546877,

at *4 (T.T.A.B. July 15, 1999). This factor therefore is satisfied. *See Frank Sinatra Enters., LLC v. Loizon*, Opp. No. 91198282, 2012 WL 4361418, at *6 (T.T.A.B. Sept. 12, 2012) (finding third part of likelihood of association test satisfied where record did not reflect connection between the parties).

4. The Name DR. DRE is of Sufficient Fame or Reputation that Consumers Would Presume a Connection

The final element in the false suggestion test is whether the name DR. DRE is of sufficient fame or reputation that consumers would presume a connection between Dr. Dre and Applicant when they see Applicant's Marks used in connection with the applied-for goods and services.[8] *See In re Nieves & Nieves*, 113 U.S.P.Q.2d at 1637 (finding fourth factor satisfied when 1) the name is of sufficient fame or reputation, and 2) its use in connection with particular goods or services would point to a particular person). This is not a "strict fame requirement" because the requirement is one of "fame or reputation." *See Ass'n Pour La Defense Et La Promotion De L'Oeuvre De Marc Chagall v. Bondarchuk*, 82 U.S.P.Q.2d 1838, 1843 (T.T.A.B. 2007) (emphasis in original) (distinguishing "fame or reputation" requirement under Section 2(a) of the Lanham Act from fame requirement in a dilution claim under Section 43(c) of the Lanham Act); *In re White*, 73 U.S.P.Q.2d 1713, 1720 (T.T.A.B. 2014) (cautioning that the inquiry is "not focused on whether the APACHE name would qualify as famous under traditional likelihood of confusion analysis or as famous under evolving dilution analysis").

[8] The fourth factor is "closely related" to the second factor's inquiry of whether Applicant's Marks point uniquely and unmistakably to Dr. Dre. *L'Oeuvre De Marc Chagall*, 82 U.S.P.Q.2d at 1842. This relatedness makes sense, for if an applicant's use of a previously-used name points uniquely and unmistakably to the prior user, then it seems highly likely that the prior-user's name is of sufficient fame such that consumers would presume a connection between the prior user and the applicant who is using the famous name. *See In re Sauer*, 27 U.S.P.Q.2d at 1074-75 (relying on the same evidence for the second and fourth factors of the false suggestion test).

As discussed in detail above, the name DR. DRE is of sufficient fame or reputation. (*See* pages 10-17, *supra*.) Indeed, Opposer is the subject of numerous articles and Internet posts that refer to him as one of the most influential and successful people in music. *Cf. In re Hsieh*, 2008 WL 4877059, at *3 ("The excerpts from the Space Age Music and Wikipedia websites are sufficient to establish the fame or renown of Paul Mauriat for purposes of proving that applicant's mark falsely suggests a connection with Paul Mauriat."). *In re Jackson Int'l Trading*, 2012 WL 3224711, at *3 (finding internet printouts sufficient to show that the name Benny Goodman had fame or renown). Moreover, Dr. Dre is featured in the Encyclopedia Britannica, which further establishes his recognition and reputation. *See Frank Sinatra Enters.*, 2012 WL 4361418, at *3 (finding FRANK SINATRA name to be of sufficient fame or reputation in part based on inclusion of Frank Sinatra in Encyclopedia Britannica). In addition, the USPTO previously has found that that the name DR. DRE is of sufficient fame or reputation under the fourth factor of the false suggestion test. (Ex. DR5 (citing several articles referring to Dr. Dre as one of the greatest rap producers).)

Given the fame of the DR. DRE name, the issue is whether consumers would presume a connection between Dr. Dre and Applicant when they see Applicant's Marks used on Applicant's applied-for goods and services. Applicant has applied to register Applicant's Marks in connection with various goods and services, including education and entertainment services such as providing motivational and educational speakers, providing motivational speaking services in certain medical fields, and providing webinars and classes in certain medical fields. (*See* App. Ser. Nos. 86/590,205 and 86/730,410.) While many of Applicant's goods and services are related to medicine and wellness, there is no requirement that Dr. Dre be known for medical products or services. *See In re Nieves & Nieves*, 113 U.S.P.Q.2d at 1637 ("We do not require

proof that Kate Middleton is well-known for [applicant's applied-for goods]."); *Frank Sinatra Enters.*, 2012 WL 4361418, at *6 (rejecting applicant's argument that fourth factor was not satisfied because Frank Sinatra's reputation did not extend into applicant's field of services). Rather, the question is whether Dr. Dre's renown is such that when Applicant's Marks are used in connection with medical products and services, including entertainment services, consumers will recognize Applicant's Marks as referring to Dr. Dre. *See In re Nieves & Nieves*, 113 U.S.P.Q.2d at 1637.

The Board previously has found that "it is common knowledge that in the United States today licensing is widespread and the names and likenesses of celebrities . . . are frequently used in connection with the advertising and sale of goods and services." *King*, 1999 WL 546877, at *5 (finding that consumers would recognize applicant's mark, applied for "promoting sports competitions and/or events of others," as referring to Dr. Martin Luther King, Jr. due to the "general merchandising climate"); *see also In re Sloppy Joe's Int'l Inc.*, 43 U.S.P.Q.2d 1350, 1354 (T.T.A.B. 1997) (explaining that because "the names and likenesses of well-known persons frequently are licensed for use on various goods and services," consumers would view the name or likeness of Ernest Hemingway used on goods or services unrelated to writing to be referring to Hemingway). Here too, because of Dr. Dre's renown and the common practice of celebrities using their names in connection with a vast array of goods and services, consumers will recognize Applicant's Marks as referring to Opposer.[9]

Accordingly, the fourth element is satisfied.

* * *

[9] Moreover, as set forth below with respect to Opposer's Section 2(d) claim, Applicant uses its marks in non-medical settings. (*See* pages 38-39, *infra.*) Therefore, consumers are even more likely to believe that Applicant's Marks refer to Opposer.

After considering all relevant requirements of the false suggestion test, it is clear that Applicant's Marks falsely suggest a connection with Dr. Dre. Accordingly, Applicant's applications to register Applicant's Marks should be refused under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

C. Applicant's Marks Are Likely to Cause Confusion With the DR. DRE Mark

Given the evidence of false suggestion noted above, this opposition should be sustained in its entirety without the need to reach the issue of likelihood of confusion under Section 2(d). However, the applications to register Applicant's Marks must also be rejected because Applicant's registration of such marks is likely to cause confusion and deceive the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

To succeed on his likelihood of confusion claim, Dr. Dre must prove both priority and likelihood of confusion. *See Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 U.S.P.Q.2d 1887, 1891 (T.T.A.B. 2007). Dr. Dre easily establishes both.

1. Dr. Dre's Priority is Not in Question

To establish priority, Dr. Dre must show proprietary rights in the DR. DRE mark arising from "a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); *see also* TBMP § 309.03(c)(A). Where the opposer proves that it owns a registration for its pleaded mark, priority is not an issue. *See L'Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1436 n.7 (T.T.A.B. 2012) ("[T]here can be no priority dispute when an opposer properly introduces its registrations into the record, and the applicant fails to file a counterclaim to cancel

them."); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1072 (T.T.A.B. 2011) (stating that priority not at issue as to the marks and goods covered by the pleaded registrations that were of record). Here, Dr. Dre's pleaded registrations for his DR. DRE mark are of record (Exs. DR1-DR4), and thus priority is established.

Moreover, Dr. Dre registered the DR. DRE mark long before Applicant's priority date. Dr. Burch testified that Applicant first used Applicant's Marks on July 1, 2011[10] (Burch Tr. at 106:9-107:8), which is over a decade after Dr. Dre first registered the DR. DRE mark with the USPTO. (Exs. DR1-DR4.) This is more than sufficient to show Dr. Dre's priority. *See Herbko*, 64 U.S.P.Q.2d at 1378.

2. Dr. Dre Has Established Likelihood of Confusion

In determining likelihood of confusion, the Board weighs the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973), to the extent those factors are relevant to the case at hand. *See Opryland USA Inc. v. Great Am. Music Show, Inc.*, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992) (explaining that "[n]ot all of the *du Pont* factors are relevant or of similar weight in every case"). Here the relevant *du Pont* factors are: (i) the close similarity of the parties' marks; (ii) the relatedness of the parties' goods and services; (iii) the strength of the DR. DRE mark; (iv) the overlap of the parties' trade channels and consumers; and (v) Applicant's intent.

The Board's analysis of the *du Pont* factors must be guided by two broad principles. First, all doubts about whether confusion is likely must be resolved in favor of the prior user. *See Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir. 1989); *Gillette Can. Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (T.T.A.B. 1992). Second,

[10] However, as noted above, Applicant's claimed date of first use is in doubt.

Applicant, as the newcomer, is obligated to avoid selecting a mark close to the established DR. DRE mark in order to protect consumers from confusion and to protect Dr. Dre's goodwill and investment in his mark. *See Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992); *Nina Ricci*, 12 U.S.P.Q.2d at 1904.

Applying the above *du Pont* factors leads to the conclusion that Applicant's Marks, when used on or in connection with the applied-for goods and services, are likely to cause confusion, to cause mistake, or to deceive. Therefore, the applications to register Applicant's Marks should be denied based on Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

a. Applicant's Marks are Nearly Identical to the DR. DRE Mark

The two key factors in a likelihood of confusion analysis are the similarities of the marks and the similarities of the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 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 Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010) ("In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services."). As for the similarity of the marks, this factor examines the similarity of the parties' marks in their entireties as to appearance, sound, connotation, and commercial impression. *du Pont*, 177 U.S.P.Q. at 567.

When comparing the marks, any one of the dimensions of appearance, sound, connotation, and commercial impression may be critical in finding the marks to be similar in a particular case. *See In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 (T.T.A.B. 1987). The focus of the inquiry is on the recollection of the average purchaser, who normally retains a general, rather than specific,

impression of a trademark. *See Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975). Therefore, 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 U.S.P.Q.2d 1713, 1721 (Fed. Cir. 2012) (citation and internal quotation marks omitted).

Applying these rules for comparison, it is clear that Applicant's Marks are highly similar to the DR. DRE mark in sound, appearance, and commercial impression. As set forth above with respect to Opposer's Section 2(a) claim, Applicant has admitted that that the DR. DRAI Word Mark and the DOCTOR DRAI portion of the DOCTOR DRAI Design Mark sound identical to Opposer's DR. DRE mark. (Burch Tr. at 154:20-155:1) The similarity in sound alone is sufficient to support a finding of likelihood of confusion. *See In re Delaney*, App. Ser. No. 87152683, 2017 WL 3822863, at *2 (T.T.A.B. Aug. 11, 2017) ("'Despite specific differences in spelling . . . the dominant factor for consideration is the likelihood of confusion arising from the similarity in sound of the two words when spoken.'" (quoting *Krim-Ko Corp. v. Coca-Cola Co.*, 156 U.S.P.Q. 523, 526 (C.C.P.A. 1968)); *In re 1st USA Realty Prof'ls, Inc.*, 84 U.S.P.Q.2d 1581, 1587 (T.T.A.B. 2007); *Re/Max of Am., Inc. v. Realty Mart, Inc.*, 207 U.S.P.Q. 960, 964 (T.T.A.B. 1980).

The marks also are similar beyond their identical sounds. Applicant's Marks and Opposer's DR. DRE mark are highly similar in appearance and commercial impression, as both of Applicant's Marks and the DR. DRE mark begin with the terms doctor or the abbreviation for doctor, followed by a one-syllable term that begins with the letters "D" and "R" and ends with vowels that sound alike. These similarities also support a finding of likelihood of confusion. *See*

GTFM, Inc. v. Wilson, Opp. No. 91170761, 2007 WL 4663348, at *4 (T.T.A.B. Dec. 27, 2007) (finding marks FUBU and FYBY similar because despite differences in vowels, both marks had the same structure of the letter F, a vowel, the letter B, and another vowel); *In re Ferro Corp.*, App. Ser. No. 75891291, 2002 WL 1434231, at *2 (T.T.A.B. June 28, 2002) (finding marks similar where they had the same consonants and differed only in their vowels).[11]

While the DOCTOR DRAI Design Mark includes other elements, namely the terms OBGYN & MEDIA PERSONALITY and a design, those elements do not distinguish Applicant's DOCTOR DRAI Design Mark from Opposer's DR. DRE mark. To start, DOCTOR DRAI is the dominant portion of the DOCTOR DRAI Design Mark because it is the most visually prominent portion of the mark. *See Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 U.S.P.Q.2d 1182, 1188 (T.T.A.B. 2014) (finding term MINERS most dominant portion of composite mark because it was the most visually prominent portion); *Venture Out Props.*, 81 U.S.P.Q.2d at 1891 (finding CABANA the dominant portion of applicant's mark because of its "larger size and bolder presentation"). And as set forth above, the DOCTOR DRAI portion of the mark is nearly identical to Opposer's DR. DRE mark.

The other parts of Applicant's DOCTOR DRAI Design Mark do nothing to detract from the overwhelming similarity of the DOCTOR DRAI portion of the mark and Opposer's DR. DRE mark. First, the terms OBGYN & MEDIA PERSONALITY have little significance when comparing the parties' marks. Applicant disclaimed these terms in its application, thereby

[11] The difference between the vowels in DRE and DRAI also does not distinguish the parties' marks because the vowels are at the end of the marks. *See In re Bioenergy, Inc.*, App. Ser. No. 77503783, 2011 WL 2730928, at *1 (T.T.A.B. June 22, 2011) (acknowledging that although there were differences between the marks, "because these differences are at the end of each mark, and . . . make a lesser commercial impression, they are insufficient to distinguish the marks").

making DOCTOR DRAI far more significant in the similarity of the marks analysis.[12] *See Citigroup, Inc. v. Capital City Bank Grp., Inc.*, 98 U.S.P.Q.2d 1253, 1257 (Fed. Cir. 2011) ("[W]hen a mark consists of two or more words, some of which are disclaimed, the word not disclaimed is generally regarded as the dominant or critical term."); *In re Dixie Rests., Inc.*, 41 U.S.P.Q.2d 1531, 1535 (Fed. Cir. 1997) (affirming Board's finding that dominant portion of the design mark THE DELTA CAFE was the term DELTA because the term CAFE was disclaimed).

Second, the design portion of Applicant's DOCTOR DRAI Design Mark is nearly irrelevant to the comparison of the parties' marks. In a composite word and design mark such as Applicant's DOCTOR DRAI Design Mark, the word portion of the mark tends to be the dominant portion.[13] *See In re Viterra Inc.*, 101 U.S.P.Q.2d 1905, 1911 (Fed. Cir. 2012) ("In the case of a composite mark containing both words and a design, 'the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.'" (quoting *CBS Inc. v. Morrow*, 218 U.S.P.Q. 198, 200 (Fed. Cir. 1983)); *Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 U.S.P.Q.2d 2001, 2023 (T.T.A.B. 2013) ("When a composite mark contains both words and a design, the word portion is more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and services."); *M.C.I. Foods, Inc. v. Bunte*, 96 U.S.P.Q.2d 1544, 1551 (T.T.A.B. 2010) (holding that word portions of mark were dominant elements based

[12] Even if these terms were not disclaimed, the terms MEDIA PERSONALITY merely reinforce the connection with Dr. Dre.

[13] While composite marks are to be compared by looking at them as a whole, there "is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark." *In re Nat'l Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *see also Cunningham*, 55 U.S.P.Q.2d at 1845 ("[T]he Board was justified in examining each component of the mark LASERSWING and the effect of that component on the issue of likelihood of confusion as between the respective marks in their entireties.").

on "a number of cases that reflect the principle that if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services"). Moreover, because Opposer's DR. DRE mark is registered in standard character format (Exs. DR1-DR4), the protection to which Opposer is entitled extends to a depiction of the DR. DRE mark in the same stylization as Applicant's DOCTOR DRAI Design Mark. *See In re Paetzold*, App. Ser. No. 79039083, 2009 WL 625584, at *2 (T.T.A.B. Feb. 18, 2009). Therefore, the design element in Applicants' DOCTOR DRAI Design Mark is afforded less weight than the verbal portion of the mark, which, as set forth above, is nearly identical to Opposer's DR. DRE mark.

In sum, both of Applicant's Marks are highly similar to Opposer's DR. DRE mark, and this factor decidedly supports a finding of likelihood of confusion.

b. The Parties' Goods and Services are Related

Another *du Pont* factor critical to the likelihood of confusion analysis is the similarity of the parties' goods and services. The inquiry under this factor is whether the parties' goods and services are sufficiently related such that consumers are likely to believe that they come from the same source. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002) ("Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services"); *Herbko Int'l*, 64 U.S.P.Q.2d at 1381 (same). Therefore, there is no requirement that the goods and services be identical or even competitive in nature in order to support a finding of likelihood of confusion. *See In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (T.T.A.B. 1991).

Here, Opposer's registrations for his DR. DRE mark cover series of musical sound

recordings, various clothing, posters, art prints, stickers, and entertainment services, namely musical composition and production of musical sound recordings. (Exs. DR1-4.) Applicant has applied to register Applicant's Marks in connection with various good and services, including educational and entertainment services. In particular, Applicant has applied to register the DOCTOR DRAI Design Mark for "educational and entertainment services, namely, providing motivational and educational speakers." Such services are related to Opposer's entertainment services because consumers would perceive that the provision of motivational or educational speakers is related to Opposer's musical composition and production services due to the entertainment nature of both types of services.

The remainder of Applicant's applied-for goods and services, which include educational and entertainment services, series of books, articles, handouts, and worksheets, and various electronic publications, are in the fields of women's and men's health, medicine, obstetrics, or gynecology. Consumers, however, still would view such goods and services as related to the goods and services offered under the DR. DRE mark. First, Applicant's goods and services are provided in non-medical settings. For example, Applicant's specimens filed in connection with its applications state that "Dr. Drai makes a variety of appearances," including on television and radio shows and at charity functions and corporate events. Moreover, Dr. Burch testified that he is a "media personality" and that he appears on general interest television shows on CBS San Francisco, ABC Chicago, and Fox Houston and on general interest radio shows on stations such as Kiss FM, on which he offers his educational and entertainment services and promotes his goods such as his books. (Burch Tr. at 10:18-19, 23:13, 61:12-62:20, 74:7-9.) Applicant also offers and promotes its goods and services on social media, such as Facebook, Instagram, and Twitter. (*Id.* at 35:18-45:19 & Exs. 4-9.) Therefore, despite many of Applicant's goods and

services being in various fields of medicine, consumers still would view such goods and services as related to Opposer because they are offered in non-medical settings to the general public.

Second, as set forth above with respect to Opposer's Section 2(a) claim, the Board frequently has observed that "the names and likenesses of well-known persons frequently are licensed for use on various goods and services." *In re Sloppy Joe's*, 43 U.S.P.Q.2d at 1354 (citing cases); *see also Frank Sinatra Enters.*, 2012 WL 4361418, at *9 ("[I]t is commonplace for performers to expand their product lines to incorporate a diverse set of goods and services to capitalize on the renown of their names and brands."); *L'Oeuvre De Marc Chagall*, 82 U.S.P.Q.2d at 1844; *King*, 1999 WL 546877, at *5. Therefore, consumers would view Applicant's goods and services as licensed products and services of Opposer. This further confirms the relatedness of the parties' goods and services.

For these reasons, the similarity of the goods and services factor weighs in favor of Opposer.

c. The DR. DRE Mark is Strong and Entitled to a Broad Scope of Protection

Another important *du Pont* factor is the strength of the senior mark. *See Recot, Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000) (explaining that this factor "plays a 'dominant role'" in the likelihood of confusion analysis). The stronger the mark, the greater the legal protection to which it is entitled. *See Kenner Parker Toys*, 22 U.S.P.Q.2d at 1456 ("[T]he Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark."). As the Federal Circuit has explained, "[a] strong mark . . . casts a long shadow which competitors must avoid." *Id.* A mark's strength is determined first by examining its inherent distinctiveness and, second, by determining its marketplace recognition. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 U.S.P.Q.2d 1081, 1086 (1992); 2 J. Thomas

McCarthy, *McCarthy on Trademarks & Unfair Competition* (hereinafter, "*McCarthy*") § 11:83 (5th ed. 2017).

The inherent strength of a mark is determined according to where the mark falls along the spectrum of generic, descriptive, suggestive, and arbitrary/fanciful marks. *See In re MBNA Am. Bank, N.A.*, 67 U.S.P.Q.2d 1778, 1780 (Fed. Cir. 2003). Suggestive, arbitrary, and fanciful marks are considered inherently distinctive, whereas generic and descriptive marks are not. *See Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 71 U.S.P.Q.2d 1173, 1178 (Fed. Cir. 2004). Here, DR. DRE does not describe or suggest any characteristics or qualities of the recited goods or services in Dr. Dre's registrations, which comprise a series of musical sound recordings, various clothing, posters, art prints, stickers, and entertainment services, namely musical composition and production of musical sound recordings. Therefore, DR. DRE is an arbitrary mark. *See id.* at 1180 ("[A]n arbitrary mark is a known word used in an unexpected or uncommon way."); 2 *McCarthy* § 11:11 ("Arbitrary word marks are words in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services."). As an arbitrary mark, DR. DRE is entitled to a broad scope of protection. *See In re A.C.E. Int'l Co.*, App. Ser. No. 76120896, 2003 WL 22174266, at *4 (T.T.A.B. Sept. 16, 2003) ("Based on the record before us, COBRA is an arbitrary mark for the registrant's protective gloves, and the registration is therefore entitled to a broad scope of protection . . . ."); *In re Wilson*, 57 U.S.P.Q.2d 1863, 1865 (T.T.A.B. 2001) ("PINE CONE is an arbitrary and strong mark entitled to a broad scope of protection.").

The evidence of record also demonstrates that the DR. DRE mark possesses marketplace strength. The strength of a mark can be shown indirectly, including through unsolicited press

mentions. *See Bose Corp. v. QSC Audio Prods., Inc.*, 63 U.S.P.Q.2d 1303, 1305-06 (Fed. Cir. 2002). Here, the DR. DRE name and mark has been the subject of immeasurable publicity and accolades, including unsolicited publicity in prominent national publications such as *The New York Times*, *Rolling Stone*, *Billboard*, *Forbes*, and *USA Today*. (*See* pages 11-15, *supra*.) In addition, *Forbes* magazine consistently has ranked Dr. Dre as one of the highest-earning celebrities and musicians. (*See* pages 15-16, *supra*.) This evidence is sufficient to establish the strength of Opposer's DR. DRE mark. *See Frank Sinatra Enters.*, 2012 WL 4361418, at *7 (finding the marks FRANK SINATRA and SINATRA famous for entertainment services "based on the widespread critical assessments and notice by independent sources").

Accordingly, the DR. DRE mark is strong and should be afforded broad protection.[14]

d. The Parties' Trade Channels and Customers Overlap

Another relevant *du Pont* factor that clearly weighs in Dr. Dre's favor is the overlap of the parties' trade channels and consumers. *See du Pont*, 177 U.S.P.Q. at 567. In considering the trade channels and purchasers to determine likelihood of confusion, the Board must look to the applications and registrations on the record before it. *See CBS*, 218 U.S.P.Q. at 199.

Here, neither the applications for Applicant's Marks nor Opposer's registrations for his DR. DRE mark contain limitations as to trade channels or purchasers. Therefore, the parties' respective goods and services are presumed to travel though all normal channels of trade for the identified goods and services.[15] *See Canadian Imperial Bank of Commerce v. Wells Fargo*

[14] Applicant's third-party evidence does not establish that Opposer's DR. DRE mark is weak for the same reasons it is not relevant to Opposer's Section 2(a) claim. (*See* pages 25-28, *supra*.)

[15] For this reason, Dr. Burch's testimony that his customers are largely women (Burch Tr. at 28:6-11) is irrelevant because the applied-for goods and services are not limited to female consumers. *See Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 U.S.P.Q.2d 1157,

Bank, Nat'l Ass'n, 1 U.S.P.Q.2d 1813, 1814 (Fed. Cir. 1987) (affirming Board's determination of likelihood of confusion based on the scope of the goods and services covered by the contested mark); *In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1639 (T.T.A.B. 2009) (stating that where "there are no limitations as to channels of trade or classes of purchasers," it is presumed that the goods "move in all channels of trade normal for those products, and that they are available to all classes of purchasers for the listed goods").

As set forth above, Dr. Burch testified that the entertainment and education services offered in connection with Applicant's Marks are offered and promoted on television, radio shows, and social media (pages 21-22, *supra*), which are the same channels through which Dr. Dre's musical sound recordings and entertainment services are offered. (Exs. DR188-DR191.)[16] Therefore, both the trade channels and consumers overlap and this factor weighs in Dr. Dre's favor.

e. Applicant's Bad Faith Intent

Applicant's bad faith, which can be inferred from the evidence of record, further establishes a likelihood of confusion between the parties' marks. Dr. Burch did not conduct a trademark search before applying to register Applicant's Marks (Burch Tr. at 135:21-22; Ex. DR8 at response no. 13), which is consistent with a bad faith intent. *See Int'l Star Class Yacht Racing Ass'n v. Tommy Hilfiger, U.S.A., Inc.*, 38 U.S.P.Q.2d 1369, 1372-73 (2d Cir. 1996)

1162 (Fed. Cir. 2014) (finding that because neither party limited its investment services to high net-worth consumers, such services could be offered to anyone with money to invest, including ordinary consumers); *Bose*, 63 U.S.P.Q.2d at 1311 (rejecting applicant's argument that confusion was unlikely because its products were sold exclusively to the professional market as the application contained no limiting language).

[16] The Board may infer the general channels of trade and classes of customers from the identifications of goods and services in Opposer's registrations. *See Viterra*, 101 U.S.P.Q.2d at 1908.

(finding that failure to conduct a full trademark search could support a finding of bad faith). Moreover, Dr. Burch's full name is Dr. Draion Burch. (Burch Tr. at 155:2-5.) There is no reason that Applicant could not have used or applied to register the mark DR. BURCH, which would have been consistent with how other doctors refer to themselves. (*Id.* at 171:11-17 (admitting that no other doctors on the program for the 2014 Ohio Osteopathic Symposium were referred to by their first names other than Dr. Burch).) Moreover, even if Applicant wanted to use and apply to register Dr. Burch's first name, he could have chosen the mark DR. DRAION rather than DR. DRAI. Just because Dr. Burch's nickname is DR. DRAI does not entitle him to use and apply to register that nickname as a trademark. *See* 2 *McCarthy* § 13:8 (explaining that there is "no absolute right to use one's own personal name as a mark when someone else has used the name first as a mark and achieved consumer recognition though secondary meaning").

As set forth above, Applicant was obligated to avoid selecting a mark close to the established DR. DRE mark. *See Kenner Parker Toys*, 22 U.S.P.Q.2d at 1456; *Nina Ricci*, 12 U.S.P.Q.2d at 1904. Despite having other options available, Applicant, without conducting any trademark search, applied to register a mark that sounds and looks identical to the well-known DR. DRE mark, a name that Dr. Burch admitted he had heard of before Applicant applied to register Applicant's Marks. (Burch Tr. at 176:5-6.) Therefore, the Board can infer Applicant's bad faith intent.

* * *

Every single likelihood of confusion factor relevant to this proceeding favors Dr. Dre. *None* favor Applicant. Under these circumstances, Applicant's Marks are likely to cause confusion, mistake, and deception with Dr. Dre's prior used and registered DR. DRE mark in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

CONCLUSION

For the foregoing reasons and based on the evidence properly of record in this proceeding, Dr. Dre respectfully requests that the registration of the marks shown in Application Serial Nos. 86/590,205 and 86/730,410 be denied and that final judgment for Dr. Dre be entered in this proceeding.

Dated: New York, New York
November 9, 2017

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

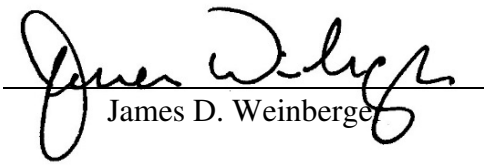
By: _____

James D. Weinberger (jweinberger@fzlz.com)
Emily Weiss (eweiss@fzlz.com)
4 Times Square, 17th Floor
New York, New York 10036
Tel: (212) 813-5900

Attorneys for Opposer Andre Young

CERTIFICATE OF SERVICE

I hereby certify that I caused, on this 9th day of November 2017, a copy of the foregoing **OPPOSER ANDRE YOUNG'S TRIAL BRIEF** to be sent by email to Applicant's counsel at andrea.evans@evansiplaw.com, jon@schiffrinlaw.com, and alexis@schiffrinlaw.com.



James D. Weinberger