

This Opinion is not a
Precedent of the TTAB

Mailed: April 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

John M. Veleno

v.

Sheena S. Todd

Opposition No. 91229357

Dorothy S. Morse, Esq. for John M. Veleno.

Christopher J. Cabott of Remick Cabott Law Offices
for Sheena S. Todd.

Before Adlin, Heasley and Lynch, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Sheena S. Todd (“Applicant”) seeks a Principal Register registration for the mark ROSA VELENO, in standard characters, for “entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings” in International Class 41.¹ In his notice of opposition, John

¹ Application Serial No. 86684985, filed July 7, 2015 under Section 1(b) of the Trademark Act, based on an alleged intent to use the mark in commerce. According to the application,

M. Veleno (“Opposer”) alleges that he is a “legendary guitar maker who introduced the first all-aluminum guitar ever made in the 1970’s and whose name and surname VELENO are notably, uniquely, and unmistakably associated with the music industry and the international music community for about forty years.” 1 TTABVUE 4 (Notice of Opposition (“NOO”)). More specifically, Opposer alleges that he and his family have “manufactured, sold, displayed, offered for sale, and repaired, refurbished, and certified the authenticity of various models of VELENO guitars” since before Applicant’s first use of her mark, and that “VELENO is currently well-known in the music industry and has become a famous trademark.” *Id.* at 5, 7 (NOO ¶¶ 1, 9). Opposer pleads co-ownership (with two family members) of: Registration Nos. 2894158 and 3298425; and an alleged “family” of VELENO trademarks. *Id.* at 7 (NOO ¶ 10). As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with, and dilute, Opposer’s marks.² *Id.* at 7, 9 (NOO ¶¶ 14, 18). In her answer, Applicant denies the salient allegations in the notice of opposition.

“The English translation of ‘ROSA VELENO’ in the mark is ‘PINK VENOM’” and “The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.” Opposer claims in its ACR Brief that after first using the mark PINK VENOM, Applicant “later translated [the mark] into the Italian words of Rosa and Veleno.” 15 TTABVUE 2. (Citations to the record reference TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear).

² Opposer also asserted claims under Sections 2(a) and 2(c) of the Act -- for false suggestion of a connection and that Applicant’s mark comprises Opposer’s name but that Opposer did not consent to Applicant’s registration thereof – but these claims were stricken as legally insufficient by Board order. 13 TTABVUE.

I. The ACR Record

After the close of Opposer's trial period, both parties filed materials which were stricken as untimely by the Board's order of November 9, 2017 (the "ACR Order"). 13 TTABVUE 5-6. However, the parties then consented to, and the Board approved, resolution of this case through the Board's Accelerated Case Resolution procedure. *Id.* at 6-7. Specifically, the parties agreed to try this case through a "modified summary judgment format," in which they would each submit briefs, "together with any evidence." The parties agreed that "the Board may resolve genuine disputes of material fact and issue a final ruling based on the parties' ACR submissions." *Id.*

With his ACR submissions, Opposer introduced affidavits from Opposer ("Veleno Aff."), his daughter Carla Hoehn ("Hoehn Aff.") and his attorney Dorothy Morse ("Morse Aff."); Internet printouts; and a sales receipt. 14 TTABVUE 11-27; 17 TTABVUE 13-26.³ Applicant did not introduce any testimony or other evidence.

³ Opposer filed his original ACR Brief, accompanied by his evidence, on December 22, 2017, the day it was due. 14 TTABVUE. Later that day, Opposer filed his Substitute ACR Brief, this time unaccompanied by any evidence. 15 TTABVUE. Accordingly, citations to evidence are to 14 TTABVUE while citations to Opposer's ACR Brief are to 15 TTABVUE. Applicant's objection that the brief is untimely is overruled because the brief was timely filed, and while Applicant did not receive her service copy of the brief until the following day, Applicant does not argue, much less establish, any resulting prejudice (and would be hard-pressed to do so having declined to introduce any evidence whatsoever and apparently having no trouble timely filing her own brief). Accordingly, we have exercised our discretion to consider Opposer's brief.

II. Standing

Opposer failed to properly introduce his pleaded registrations into evidence, despite being apprised, in the ACR Order, that they had not been properly introduced with the notice of opposition and would need to be properly introduced with Opposer's ACR Brief in order to be considered. 13 TTABVUE 4-5 and n. 6, 7. *Cf.* Trademark Rule 2.122(d)(2).⁴ Nevertheless, Opposer's and Ms. Hoehn's testimony establishes Opposer's use of VELENO for guitars. 14 TTABVUE 16-22 (Veleno Aff. ¶¶ 12-31); 14 TTABVUE 25 (Hoehn Aff. ¶¶ 1-4). This establishes Opposer's standing. *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding."); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion).

III. Priority

Having failed to introduce any evidence of use, Applicant's constructive priority date is the filing date of her application (July 7, 2015). *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140-41 (TTAB 2013) ("for when an application

⁴ Ms. Hoehn testified that she is "one of three co-owners currently identified in the U.S. Trademark Office records for U.S. trademark registration 2894158 and U.S. trademark registration 3298425, each grant protecting use of the trademark VELENO." Her testimony also at least suggests that the registrations are for "guitars." 14 TTABVUE 25. However, in the absence of status and title copies of the registrations, which contain important information absent from Ms. Hoehn's testimony, we do not have sufficient information to consider these registrations, which were not properly made of record.

or registration is of record, the party may rely on the filing date of the application for registration, *i.e.*, its constructive use date”); *Syngenta*, 90 USPQ2d at 1119 (“applicant may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority”). Opposer’s testimony establishes his earlier use of his pleaded VELENO mark for guitars, and therefore that Opposer has priority of use. 14 TTABVUE 16-22 (Veleno Aff. ¶¶ 12-31).

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). We consider the likelihood of confusion factors about which there is evidence or argument, and treat the remaining factors as neutral.

A. Strength of Opposer’s Mark⁵

Opposer argues that his mark is quite strong, and in fact “famous.” Specifically, “during the first few years of its sale,” the popularity of VELENO guitars grew rapidly and “sales exceeded 160 guitars.” 14 TTABVUE 17-18 (Veleno Aff. ¶ 14). Several famous musicians have purchased VELENO guitars, including Eric Clapton, Greg Allman, Lou Reed, Johnny Winter, Ace Frehley (KISS),



Ace Frehley With His Aluminum Veleno

Todd Rundgren, Sonny Bono, Lonesome Dave Peverett (Foghat), Jeff Lynne (Electric Light Orchestra) and Robbie Krieger (The Doors). *Id.* In addition, VELENO guitars have appeared in: three books, *The Ultimate Guitar Book*, *Vintage Guitar Classics* and *Electric Guitars – The Illustrated Encyclopedia*; the January and July 1995 issues of *Vintage Guitar Magazine*; and the November 1998 issue of *Guitar World* magazine. 14 TTABVUE 19-20 (Veleno Aff. ¶ 18-20, 23). Opposer’s VELENO guitars have been displayed at the Orlando Hard Rock Café, Boston Museum of Fine Arts

⁵ Opposer has not proven that he owns a “family” of VELENO marks. *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1204 (TTAB 2016) (quoting *Wise F & I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016)) (setting forth requirements for establishing ownership of a family of marks).

and Dolly Parton's Dollywood Rags to Riches Museum. *Id.*; 14 TTABVUE 20 (Veleno Aff. ¶ 24). There is a Wikipedia entry for VELENO guitars. 17 TTABVUE 23.

This evidence establishes that VELENO guitars are somewhat well known, at least among guitar aficionados. However, Opposer has not provided sufficient context for us to find based on this record that VELENO is famous or entitled to a wide scope of protection against Applicant's mark in this case. Opposer did not provide total sales figures or evidence of any significant advertising related to his VELENO guitars. The sales figures provided lack context and are underwhelming, and Opposer admits to being unable to produce guitars for long periods of time. 14 TTABVUE 18-19 (Veleno Aff. ¶¶ 15-18) ("For a period from about 1977 to about 1993 Veleno® guitar popularity and notoriety was mostly non-existent."). *See generally Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1831 (TTAB 2012) ("[w]e have no context for opposer's advertising and sales figures," or its other evidence of fame, "such as how the figures for the [VELENO guitars] compare with that for other brands of" competing products) and *Bose Corp.*, 63 USPQ2d at 1309. There is no way for us to gauge how well known the VELENO mark is among consumers generally, or among any consumers other than the subpopulation of guitar aficionados. This factor weighs only slightly in Opposer's favor.

B. Similarity of the Marks

Opposer's mark VELENO and Applicant's mark ROSA VELENO are more similar than dissimilar "in their entirety as to appearance, sound, connotation and commercial impression," because they both contain VELENO. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689,

1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Indeed, while Applicant's addition of the term ROSA differentiates Applicant's mark from Opposer's in appearance and sound, these differences are outweighed by an important similarity.

Specifically, VELENO is not only the Veleno family's trademark for guitars, but also the family surname, while ROSA is a common personal name. Thus, consumers, or at least the subpopulation which is familiar with VELENO guitars and does not speak Italian, could assume that a musical artist, composer and producer named Rosa Veleno is part of the Veleno family that offers guitars under the VELENO mark. Any consumers who know that multiple Veleno family members are engaged in the family guitar business could be especially vulnerable to this type of confusion, with Applicant's mark potentially being perceived as a variation of the VELENO mark, or as identifying a new venture by the source of VELENO guitars. *See generally, In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004) (finding JOSE GASPARGOLD for tequila confusingly similar to GASPARGOLD for beer, based in large part on affirming findings that "the first name JOSE and the word GOLD both simply modify the name GASPARGOLD" and that JOSE "simply reinforces the impression that GASPARGOLD is an individual's name," and thus "does not alter the commercial impression of the mark"). In short, because the shared term VELENO is the entirety of Opposer's mark and a family name, the addition of the personal name ROSA would not be sufficient to avoid the likelihood that some consumers would be confused.

We accept that to many Italian-speaking consumers, ROSA VELENO, which means “pink venom,” will convey a much different meaning than VELENO alone. Rather than being perceived as Applicant’s actual name, ROSA VELENO could be perceived by Italian speakers as an alter ego or abstract stage name, perhaps along the lines of SID VICIOUS, MADONNA, THE WEEKND, M.I.A., MEAT LOAF or 50 CENT.

Nevertheless, when we consider the marks in their entireties, focusing on how they look and sound and the meaning they convey, and how they are likely to be perceived by American consumers, including those who speak Italian and those who do not, we find that the marks’ overall commercial impressions are more similar than dissimilar. This factor also weighs in favor of finding a likelihood of confusion.

C. The Goods and Services and Their Channels of Trade

Despite vague allusions to being part of the “music industry,” and arguing that he has the “right to use” his VELENO mark “with other goods and services commonly related to the music industry,”⁶ 15 TTABVUE 8, Opposer’s evidence does not establish his use of VELENO for anything other than guitars. Thus, there is no

⁶ To the extent Opposer argues that consumers might expect a producer of guitars to expand into music composition and production services, there is no evidence to support the contention or that expansion of this type would be “natural.” In any event, the “doctrine of natural expansion” is typically relevant when there is a question regarding priority, and here, as indicated, it is clear that Opposer has priority. *See Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985). To the extent Opposer argues that there might be confusion if Applicant begins offering t-shirts or other ancillary merchandise, this is at best merely speculative. In any event, there is no evidence of a relationship between guitars and any ancillary merchandise.

evidence that Opposer has used VELENO for composing or producing music, or for related services.

The fact that Opposer's goods and Applicant's services are both music-related in the broadest sense is not enough by itself to establish that the goods and services are related for likelihood of confusion purposes. Indeed, "a finding that the goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both." *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010) (citing *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975)); *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007) ("to demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods"); *see also, Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Cir. 2002) (stating, in dicta, that "a broad general market category is not a generally reliable test of relatedness of products"). *See generally In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993) (finding PHOENIX for leather sold in bulk unlikely to be confused with PHOENIX in stylized form for, *inter alia*, briefcases and handbags, stating "[w]hat is missing from the record is convincing evidence that finished products of this nature commonly carry not only the trademark of their manufacturer but also the trademark of the producer of the leather from which they are made ... there is no convincing evidence that the ultimate purchasers of registrant's goods are likely to encounter applicant's mark as well as registrant's"). Nor is there any evidence that consumers expect guitars and the production or

composition of music to emanate from the same source. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). In a somewhat analogous situation, our primary reviewing court reversed our finding that gloves are related to barbeque mitts:

The mere fact that “mitt” is defined as a type of glove has no relevance to whether a consumer would believe that the two products emanate from the same source ... First, Shen’s product is not a mitt, it is a *barbeque* mitt. It is designed to protect the hand from heat while cooking. While it covers the hand like a glove, it is better understood as a tool than as an article of clothing. The unrelatedness of RHL’s and Shen’s products is highlighted by comparing a similar set of goods: hard hats used by construction workers and fedoras. While both are hats that are used to cover the head, they have different purposes. The first is used for protection, just as a barbeque mitt is, while the second functions to keep the head warm in addition to adding an air of style, just as ready made or tailored gloves do. The mere fact that both barbeque mitts and gloves are worn on the hands simply does not support a finding that consumers would associate these products with a common source.

Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 73 USPQ2d 1350, 1357 (Fed. Cir. 2004). Similarly, in finding no likelihood of confusion between VERITONE for magnetic recording tape and VARITONE for a “wind instrument ... and related accessories,” we stated:

What we have here is an electronic musical instrument. There is no indication in the record that electronic musical instruments and magnetic recording tape are sold through the same channels of trade although it is certainly probable that the person who purchased an electronic musical instrument is a prospective purchaser of magnetic recording tape. It is clear, however, that the goods are

substantially different in nature, use and physical characteristics. There is no inherent relationship between magnetic recording tape and an electronic musical instrument which would lead prospective purchasers to assume that such goods originate with a single producer or seller.

In re Audio Magnetics Corp., 180 USPQ 607 (TTAB 1973). And we dismissed an opposition to registration of the mark LITTLE PLUMBER for liquid drain opener filed by the owner of the same mark for advertising services in the plumbing field. As we stated in that case:

We see no reason why plumbing contractors would believe that an advertising agency sells or sponsors a liquid drain opener, or that a liquid drain opener manufacturer would provide advertising services. Thus, even though opposer's services and applicant's product are or can be marketed to the same class of customers, namely plumbing contractors, these services and goods are so different that confusion is not likely even if they are marketed under the same mark.

Local Trademarks Inc. v. The Handy Boys Inc., 16 USPQ2d 1156, 1158 (TTAB 1990).

Here, while musical compositions may be played on guitars, and musical recordings may feature guitars, there is no evidence, argument or reason to believe that guitars would come from the same source as music composition or production services. In fact, the record contains no evidence of any relationship between manufacturing guitars, which according to Opposer's testimony requires engineering and fabrication skills,⁷ and composing and producing music, which are artistic

⁷ Mr. Veleno testifies that "In 1966, after learning about making patterns for casting aluminum insofar as shrinkage, draft angles, gates, risers, etc. from an experienced aluminum foundry pattern maker, I cast the aluminum neck and guitar body parts of my

endeavors. Nor is there any evidence that guitars and music composition and production services travel in the same channels of trade.

Opposer bears the burden of establishing a relationship between the parties' goods and services. In fact, in particular cases, the dissimilarity of the goods and services and their channels of trade may be dispositive, and establish that there is no likelihood of confusion. *See e.g. Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1560 (Fed. Cir. 2001); *The North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1233 (TTAB 2015); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1325 (TTAB 2010); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1143 (TTAB 2009). Here, Opposer has not met his burden of establishing a relationship between the goods and services or an overlap in their channels of trade.

Opposer's suggestion that there is a relationship between the parties' goods and services is in some ways reminiscent of arguments made in *North Face Apparel*. There, we rejected the opposer's argument that its clothing is related to bicycle parts merely because the clothing could be worn while riding a bicycle. We also rejected the argument that consumers would assume that the opposer offered bicycle parts merely because it sponsored bicycle races. *North Face Apparel*, 116 USPQ2d at 1230-31. In this case, the mere fact that guitars can play music does not establish any likelihood that consumers would perceive Applicant as a source of guitars or Opposer as a source

first guitar, an electric guitar intended for electronic amplification" 14 TTABVUE 15 (Veleno Aff. ¶ 8).

of musical composition or production services. *See also Edwards Lifesciences*, 94 USPQ2d at 1410 (finding that computer system which monitors adverse drug events and heart monitors have only “superficial similarities” and would not be confused) and *In re W.W. Henry*, 82 USPQ2d at 1214 (finding no relationship between cement patches for repairing wall and floor surfaces and chemical filler for cosmetic repair of polyolefin surfaces).⁸ These factors therefore weigh heavily against finding a likelihood of confusion.⁹

D. Balancing the Factors

While Opposer’s mark is somewhat well known among guitar aficionados, and the marks are more similar than dissimilar, Opposer’s mark is not strong enough, and the marks are not close enough, to overcome the lack of any evidence of a relationship between the goods and services, or that the channels of trade overlap. Accordingly, we find confusion unlikely and Opposer’s Section 2(d) claim is dismissed.

V. Dilution

As indicated in connection with Opposer’s likelihood of confusion claim, Opposer failed to establish that his mark is famous. This is a prerequisite to finding dilution.

⁸ The mere fact that some consumers of music production or composition services will at some point also purchase guitars, or vice versa, is not a basis upon which to find that the channels of trade or classes of consumers are the same. *Coach Services*, 101 USPQ2d at 1723; *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1794 (TTAB 2002) (“We think it a fit subject for judicial notice that purchasers of computer hardware and software also would be purchasers of, at least, footwear and apparel, and perhaps sporting goods and equipment. There is nothing in the record, however, to suggest that merely because the same consumer may purchase these items, such consumer would consider the goods as likely to emanate from the same source or have the same sponsorship.”).

⁹ On a different record, including evidence of a relationship between guitars and music composition or production services, there could be a different result.

Opposition No. 91229357

15 U.S.C. § 1125(c)(1); *Coach Servs.*, 101 USPQ2d at 1723-24 (“to prevail on a dilution claim under the TDRA, a plaintiff must show that: (1) it owns a famous mark that is distinctive ...”); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1296 (TTAB 2016). Accordingly, Opposer’s Section 43(c) claim is also dismissed.

Decision: The opposition is dismissed.