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OF THE TTAB

Oral Hearing:
September 28, 2006

Mailed:
April 30, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bose Corporation
v.
Custom Electronic Design & Installation Association

Cancellation No. 92042327

Charles Hieken of Fish & Richardson P.C. for Bose Corporation.

Peter G. Mack of Foley & Lardner for Custom Electronic Design & Installation Association.

Before Quinn, Hairston and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Bose Corporation (Bose) has petitioned to cancel the following registrations owned by Custom Electronic Design & Installation Association (CEDIA) for the mark ELECTRONIC LIFESTYLES (in typed form, ELECTRONIC disclaimed) for "printed publications, namely, pamphlets, newsletters, and

magazines featuring electronics" in International Class 16,¹ "consulting services, namely, providing technical assistance and advice in the field of electronics via a global communications network" in International Class 42,² "educational services, namely, arranging and conducting conferences, seminars, workshops and classes in the field of electronics and distributing course materials therewith" in International Class 41,³ and "arranging and conducting trade show exhibitions in the field of electronics and related consultation therewith" in International Class 35.⁴

As grounds for cancellation against all four of respondent's registrations petitioner asserts the claims of abandonment and fraud. More specifically, with respect to abandonment petitioner alleges that "none of the specimens submitted by Respondent in its Statements of Use or Section 8 [affidavit] showed actual use of the Mark in connection with the goods and/or services recited in the documents." Second Amended Petition to Cancel ¶5. Further, with respect to fraud petitioner alleges that respondent did not use its

¹ Registration No. 2155296, issued May 5, 1998, Section 8 accepted.

² Registration No. 2285765, issued October 12, 1999, Section 8 accepted.

³ Registration No. 2296293, issued November 30, 1999, Section 8 accepted.

⁴ Registration No. 2270920, issued August 17, 1999, Section 8 accepted.

mark on its involved goods and services prior to its "asserted first use" dates. Second Amended Petition to Cancel ¶8.

Petitioner asserts the additional ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. 15 U.S.C. § 1052(d), against Registration Nos. 2285765, 2296293 and 2270920.⁵ Petitioner alleges that respondent's mark, when used in connection with respondent's various services, so resembles petitioner's mark LIFESTYLE, previously used and registered in connection with "loudspeaker systems"⁶ and "music systems consisting of a loudspeaker system and power amplifier and at least one of a CD player, tape player and radio tuner,"⁷ as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respondent, in its answer, denies the salient allegations in the petition for cancellation and asserts the affirmative defenses of laches, estoppel, waiver, acquiescence and unclean hands. Inasmuch as respondent has only argued the defense of laches in its brief, we consider the other affirmative defenses to have been waived. In

⁵ The ground of likelihood of confusion under Section 2(d) originally asserted against Registration No. 2155296 was stricken by the Board inasmuch as that registration had been registered for more than five years prior to the filing of the petition to cancel.

⁶ Registration No. 1622251, issued November 13, 1990; renewed.

⁷ Registration No. 2108847, issued October 28, 1997; renewed.

addition, respondent asserted as an affirmative defense, as to each registration, that respondent is at least entitled to registration with the additional restriction that its goods and services "relate to or are in connection with the activities of a trade association composed of member businesses that specialize in the design and installation of custom electronic systems for the home, which activities feature an awards program recognizing outstanding achievements in the specialized field of the member businesses." Second Amended Answer ¶¶ 8, 9, 10 and 11.

The record includes the pleadings; the files of the registrations sought to be cancelled; trial testimony, with related exhibits, taken by each party; respondent's responses to petitioner's interrogatories made of record by petitioner's notice of reliance; and petitioner's responses to respondent's interrogatories made of record by respondent's notice of reliance. The parties have filed briefs, and both parties were represented by counsel at an oral hearing held before the Board.

The Parties

Petitioner is a manufacturer of music systems, home theater systems, speakers, amplifiers and related home electronic goods. William B. Allen Dep., petitioner's employee (hereinafter Allen Dep.), pp. 7-53. Petitioner also provides custom design, installation services and

training services. Allen Dep. pp. 93-106. Petitioner is a founding member of respondent. Allen Dep. p. 143.

Respondent is a non-profit trade association founded in 1989 that "represents 3,000 companies globally that design and install home theater, home automation electronic systems for the home, and companies that service those designer/installers as well." Donald L. Gilpin Dep., respondent's Assistant Executive Director (hereinafter Gilpin Dep.), p. 7. Its core constituency consists of "electronic systems contractor[s], the actual company that designs and installs those electronic systems for the home." Id. Its "core purpose is to create and promote a marketplace for our members as well as to be the core component of our members' success, and we achieve that through education, technical assistance, i.e., global communications, the publications and the trade show." Billilynne D. Keller Dep., petitioner's Executive Director (hereinafter Keller Dep.), pp. 6-7. Respondent's trade shows are targeted at designer/installers but it also offers a trade show to manufacturer members. Keller Dep. p. 8. The trade shows serve as an educational conference and trade show; 252 educational seminars are offered at the trade shows. Id. Attendees at the conference include consultants, publishers of magazines and trade publications, architects, builders and designers. It is not a show for

consumers. In the custom electronic design industry, designer/installers typically integrate up to 15 different branded products into the final home system. Keller Dep. p. 11.

Evidentiary Objections

Petitioner and respondent have objected to several exhibits introduced during testimony. We have considered these objections and have accorded the appropriate weight and probative value to the evidence in view of those objections. Specific evidence and objections are addressed where appropriate.

Standing/Priority

The earliest date upon which respondent may rely for purposes of priority, is the filing of each respective registration. Because petitioner has made of record its pleaded Reg. No. 1622251, which has an earlier filing date than the registrations in issue, and its claims are not frivolous, petitioner has established its standing to cancel the registration of respondent's marks,⁸ and its priority is not in issue. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, petitioner has submitted

⁸ Once standing is established for one claim it is established for all claims. *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983).

testimony with accompanying evidence that establishes petitioner's prior use of the mark LIFESTYLE in connection with loudspeakers and music sound systems.

Abandonment/Fraud

Petitioner supports its abandonment and fraud claims with respondent's response to petitioner's Interrogatory No.

5. The interrogatory and response are set forth below:

Interrogatory No. 5 - Identify and provide a detailed description of every product or service manufactured, licensed for manufacture, rendered or sold by or on behalf of Respondent since the inception of Respondent's business that bears or uses Respondent's mark, and/or that Respondent, or a person on behalf of Respondent, intends to manufacture, license for manufacture, render or sell that bears or uses Respondent's mark, and identify all documents relating thereto.

Answer - Respondent objects to this interrogatory to the extent that the information sought is not relevant to the issues raised in this cancellation nor reasonably calculated to lead to the discovery of admissible evidence. Respondent further objects to this interrogatory as vague and ambiguous, overly broad and unduly burdensome in that it would subject Applicant to unreasonable and undue annoyance, oppression, burden and expenses. Subject to these specific objections and the above general objections, Respondent has presented awards known as the "Electronic Lifestyle" awards to various entrants in respondent's award contests. Further subject to these specific objections and above general objections, Respondent has also accepted sponsorships from commercial sponsors for Respondent's "House of Electronic Lifestyles."

With regard to the abandonment claim, petitioner also relies on respondent's alleged failure to produce documents in response to several of petitioner's document requests for

representative samples of current advertising, goods, labels, packaging for goods and documentation used in connection with respondent's goods and services and "all documents that establish respondent's continuous use of the Mark in connection with Respondent's Goods and Services since Respondent's claimed first use dates." Document Request No. 16.

Abandonment

A mark is deemed abandoned under Section 45 of the Trademark Act when its use has been discontinued with intent not to resume or commence use. Intent not to resume or commence use may be inferred from circumstances, and nonuse for three consecutive years constitutes prima facie evidence of abandonment. 15 U.S.C. § 1127. Petitioner bears the burden of proof by a preponderance of the evidence.

Cerveceria Centroamericana S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1310 (Fed. Cir. 1989). "The protection due the registrant is provided by requiring that the inference have an adequate foundation in proven fact.

Whenever an inference is based on pure speculation and 'there is no basis...to infer nonuse,' a prima facie case of abandonment must fail." *Id.* (citation omitted). Once a prima facie case is made, "only the burden of going forward (burden of production) shifts to the trademark registrant." *Id.* at 1312.

With regard to all of the involved registrations, petitioner argues that respondent has never used its mark for the goods or services listed in the registrations and in each case "has also admitted that it has no intention to use the mark" for these goods or services. Br. p. 26.

Respondent states that its "response to Interrogatory No. 5 describes use of the ELECTRONIC LIFESTYLES mark in connection with two of its major venues for creation, dissemination and rendering of all the goods and services recited in the four registrations." Br. p. 42.

Petitioner mistakenly characterizes a response to an interrogatory as an admission. In addition, any omission of these particular services from respondent's response to Interrogatory No. 5 is hardly conclusive evidence of abandonment, particularly given the objection made concurrently with the response. If petitioner were dissatisfied with the response and believed the interrogatory to be appropriate and not unduly burdensome, petitioner could have moved to compel a complete response absent objection. Rather than availing itself of this procedural tool petitioner opted to lay in wait and present a case of abandonment based on this response. *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) *aff'd* *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Time Warner*

Entertainment, Co. v. Jones, 65 USPQ2d 1650, 1656 (TTAB 2002). As noted by respondent, petitioner's counsel wrote to respondent's counsel "requesting complete responses to several discovery requests that [respondent] had previously objected to, however, in this letter no mention was made of [respondent's] objections to Interrogatory No. 5, and [petitioner] never complained to [respondent] regarding [respondent's] discovery responses again." Br. p. 44. In addition, the abandonment and fraud claims were added to the complaint after discovery closed and petitioner never sought further discovery related to those claims.

With regard to respondent's alleged failure to produce documents and petitioner's objection to certain documents on the grounds that they were not produced during discovery, respondent argues that "CEDIA's response to Interrogatory No. 5 describes use of the ELECTRONIC LIFESTYLES mark in connection with two of its major venues for creation, dissemination and rendering of all the goods and services recited in the four registrations. [citation omitted] In response to requests for documents, CEDIA provided numerous documents showing representative uses of ELECTRONIC LIFESTYLES for all the goods and services recited in the registrations...These documents were referenced in CEDIA's response to Bose's Interrogatory No. 10, which response is in evidence via Petitioner's Notice of Reliance.

Interrogatory No. 10 requested 'all literature or prospective literature' used in connection with Respondent's mark on each of Respondent's Goods and Services-defined as goods and services recited in the four registrations that Bose seeks to cancel. In addition, CEDIA's responses to Interrogatories Nos. 9 and 11 (in evidence as well) also cover use of its marks in the context of channels of trade and time period of such use by reference to the documents being produced. Thus, CEDIA's responses to these interrogatories, by reference to the documents produced, fully provided Bose with evidence of use of the marks on all the goods and services listed in its registrations." Br. p. 42 text and footnote 4. Petitioner does not rebut this argument. Respondent further argues that any of the documents submitted during trial that were not submitted during discovery simply serve to amplify its set of documents showing continuous use in connection with its trial exhibits.⁹ Given the circumstances of discovery and

⁹ It is unclear if the documents petitioner claims were not produced, were, in fact, not produced. Although petitioner has listed certain documents as not produced, based on respondent's description of how discovery was handled it is possible that some of these documents were produced but not copied and retained by petitioner. ("Despite CEDIA's offer to make photocopies of the documents being produced and furnish them to Bose, Bose insisted on the parties handling their own inspection and copying of the documents produced, i.e. its first wave of documents produced. Bose apparently took no steps to number those documents, and it returned the documents to CEDIA's counsel without any indication of exactly what had been copied. Hence the lack of production numbers on Bose's copies of CEDIA's principal production of documents occurred at the hands of Bose

the mere amplification these documents provide, petitioner's objections on this ground are overruled. We finally note that petitioner had ample opportunity to address these documents on cross-examination and to rebut any of these documents during its rebuttal period.

To the extent petitioner has made a prima facie case of abandonment, based on the evidence of record we find that respondent has submitted sufficient evidence to show that it has used its mark ELECTRONIC LIFESTYLES in connection with each of the goods and services in the respective registrations continuously from the filing date of the statements of use. The mark is used in connection with the trade show services. See e.g., Keller Dep. pp. 25-26 Exhs. 115, 116 (1996 and 1997 program and directory for trade show); Keller Dep. p. 30 Exh. 117 (2001 brochure highlighting award show that is part of the trade show); and Keller p. 72 Exh. 134 (2002 brochure for trade show). It is used in connection with educational services. See e.g., Raymond J. Lepper Dep., petitioner's former president,

itself. Later, CEDIA made a supplemental document production by photocopying and furnishing the documents to Bose. CEDIA placed production [numbers] on all these photocopies in the supplemental production. Internally, CEDIA also placed production numbers on copies of original documents inspected by Bose, and is citing only a handful of them herein. A fair, extensive and substantial proportion of respondent's exhibits that were in existence as of the fall, 2003 time frame when Bose inspected CEDIA's documents were produced to Bose; and CEDIA adamantly denies any discovery inadequacies in this regard.") Resp. Br. p. 25.

(hereinafter Lepper Dep.) pp. 18-19, 33-34; Donald L. Gilpin, petitioner's Assistant Executive Director (hereinafter Gilpin Dep.) pp. 12-13, 17, 35, Exh. 96; Keller Dep. pp. 25, 46-47, Exh. 115. It is used in connection with consulting services providing technical assistance and advice in the field of electronics via a global communications network. See e.g., Keller Dep. pp. 24-25, 63, Exhs. 114 (printout from website in 1996), 129 (2004 advertisement referring to website and finder service); Lepper Dep. pp. 18-19; Gilpin Dep. p. 14; and Scott Fuelling Dep., one of petitioner's member companies, (hereinafter Fuelling Dep.) pp. 14, 18. It is used in connection with pamphlets, newsletters and magazines. See, e.g., Keller Dep. 24-25, 45, 68, 78-79, Exhs. 115 (brochure/program pamphlet), 122 (magazine), 130-134, 136 (use of ELECTRONIC LIFESTYLES in separate logo format on 2002 newsletter); Lepper Dep. pp. 18 ("It's used for education products, it's used for our trade show, it's used for our online advice, publications."), 29 (Q. "...what kind of publications does CEDIA put out under the banner of ELECTRONIC LIFESTYLES?" A. "Newsletters, magazines, pamphlets."), 40, Exhs. 142 (magazine), 143, 144; Gilpin Dep. pp. 8, 9-10 ("We have a publication called Electronic Lifestyles that's an outreach vehicle."), 16, 31-33 Exhs. 86 (publication produced in conjunction with HOME OF ELECTRONIC LIFESTYLES), 95;

Fuelling Dep. p. 14 ("I've seen it on their website. I've seen it in the publications they put out.")¹⁰

Petitioner argues that respondent does not use ELECTRONIC LIFESTYLES by itself but rather surrounded by other matter or that its manner of use does not have source-identifying significance. First, these uses are the same types of uses depicted in the specimens of use submitted by respondent and ultimately accepted by the USPTO. Thus, to challenge these uses would be tantamount to challenging the acceptability of the specimens of use, which is not an appropriate inquiry in an inter partes proceeding. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of ex parte examination). Moreover, we find that in the examples of use in this record ELECTRONIC LIFESTYLES creates a separate commercial impression sufficient to establish respondent's use of the mark ELECTRONIC LIFESTYLES. In view of the above, petitioner's claim of abandonment fails as to all four registrations.

¹⁰ We present in the decision only a representative example of respondent's various uses in the record. Petitioner's argument that various types of advertising or brochures are insufficient to support trademark use is misplaced with regard to services. See TMEP §1301.04 (4th ed. April 2005).

Fraud

Fraud in obtaining or maintaining a trademark registration "occurs when an applicant [or later, registrant] knowingly makes false, material misrepresentations of fact in connection with his application." *Torres v. Cantine Torresella S.R.L.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). Fraud in procuring a registration involves a willful withholding from the Patent and Trademark Office by an applicant of material information or facts which, if transmitted and disclosed to the examiner, would have resulted in the disallowance of the registration sought. See *National Semiconductor Corp. v. Varian Ass.*, 184 USPQ 62, 64 (TTAB 1974). Fraud may exist where no use of the mark was made on some of the goods recited in a use-based application as of the filing date of the application, *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1905 (TTAB 2006), or an intent-to-use application as of the filing date of the statement of use, *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205, 1209 (TTAB 2003). The intent element of fraud may be found when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

Petitioner asserts that respondent committed fraud when it filed its statements of use in connection with all of the underlying applications for its involved registrations, and its Section 8 and 15 declaration in connection with Reg. No. 215529. Petitioner relies on respondent's response to Interrogatory No. 5 in support of its fraud claim. Fraud must be proven to the hilt and reliance on this single interrogatory response, in particular given the objections and no follow up inquiry or motion to compel, is quite misplaced. In addition, petitioner argues that in support of the statements of use for all of the underlying applications for its involved registrations (and the Section 8 declaration for Reg. No. 2155296), respondent submitted specimens of use that did not "evidence use of the discrete mark ELECTRONIC LIFESTYLES" for the identified goods and services. Reply Br. p. 13. As noted above, the acceptability of these specimens is not reviewable in an inter partes proceeding. Century 21 Real Estate, supra. Finally, in connection with Reg. No. 2285765, petitioner alleges that respondent committed fraud when in response to an inquiry from the trademark examining attorney about respondent's use of its mark, respondent stated that the specimen of use, an excerpt from its website, shows use of the term "Electronic Lifestyles" in connection with its technical services because it served as a hyperlink to those

services. In support of its allegation of fraud in this instance, petitioner points to evidence and testimony regarding an archived version of that web page. This evidence is ambiguous at best and nowhere near sufficient to prove fraud. In any event, given our findings of fact with regard to respondent's use discussed above, the fraud claims must fail.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Petitioner focuses its arguments on the fame of its mark, the similarity of the marks, the relatedness of the goods and/or services, and the absence of restrictions on

the channels of trade and class of purchasers in respondent's registrations.

Fame

A key factor can be the fame of the prior mark. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Petitioner has argued that its LIFESTYLE mark is famous and we begin our analysis with this factor, because fame "plays a 'dominant' role in the process of balancing the du Pont factors." Recot Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

In support of its assertion of fame for its LIFESTYLE mark, Mr. Allen testified that since 1989 petitioner has manufactured and sold a variety of LIFESTYLE home electronic systems which include loudspeakers and music systems. Allen Dep. 12-53. Petitioner markets its LIFESYTLE products by direct mail, in airport kiosks, in-flight magazines, via corporate sponsorships, via its website, via television and movie product placements, in general circulation magazines and newspapers, and in industry-specific publications. Allen Dep. pp. 56, 60-61. In addition, he testified that its dealers and retailers also advertise petitioner's electronic products. In the sample advertisements submitted, LIFESTYLE frequently appears as a product mark in conjunction with opposer's house mark and often is not

displayed in a prominent manner. Further, there is no specific testimony as to where some of these particular examples were published, or even if they were in fact published, and for how long and how pervasive. As to the third-party advertisements, Mr. Allen testified that he did not know if they were actually printed or distributed. Allen Dep. pp. 185-187. Mr. Allen testified to a few press mentions and identified a few examples, ranging from industry magazines to the New York Times. In addition, Mr. Allen testified that some of the LIFESTYLE products have received awards in 2004 from industry trade press. While petitioner's sales revenues and volume are confidential, we note that they are substantial.¹¹ Petitioner has also expended considerable sums on advertising. Mr. Allen testified that its LIFESTYLE products are also marketed and sold under another one of petitioner's product lines called BUILT-Invisible.

¹¹ Respondent's objection to this testimony as hearsay and not falling within the business records exception based on lack of foundation and personal knowledge is overruled. Mr. Allen's testimony sufficiently identified and authenticated the documents showing the sales and advertising figures. As noted by petitioner, "Mr. Allen identified [the exhibit as] a document showing sales revenue generated by records kept in the ordinary course of business that was produced by a person in [petitioner's] finance department with whom he regularly works" and "Mr. Allen identified [the documents with advertising figures], the source of these documents, and indicated [these documents were kept] in the ordinary course [sic]." Reply Br. p. 4.

In arguing that petitioner's mark is not famous, respondent noted that Mr. Fuelling and Ms. Keller testified that they had never heard of petitioner's LIFESTYLE mark which indicates "that it can not be too well-known, especially in the field of custom design and installation of residential electronic systems." Br. p 37. In addition, respondent submitted an excerpt from the magazine CE LIFESTYLES, a consumer electronics publication, which contained an advertisement for one of petitioner's other products. Resp. Notice of Reliance Exh. G. Respondent argues that the "placement of this advertisement is thus demonstrative of the limitations of the Bose LIFESTYLE mark and the narrow scope of protection to which it is entitled." Br. p. 38.

We first note that the determination of the strength or fame of a mark is not a binary analysis, but rather is the examination of a continuum from the weakest to the most famous. Based on this record, we do not find that the LIFESTYLE mark is famous on the scale of, for example, Coca Cola, in particular because the evidence does not show such a pervasive and sustained advertising campaign to infuse the LIFESTYLE mark into the consumer's mind. However, given the substantial volume of sales and the substantial advertising expenses, we find that LIFESTYLE is a strong, well-known

mark for loudspeakers and music systems within the relevant consumer base and deserving of broad protection.

Similarity of the Marks

We turn next to the du Pont factor of whether applicant's mark and opposer's marks are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods and services offered under the respective marks is likely to result.

Respondent's mark ELECTRONIC LIFESTYLES encompasses the whole of petitioner's mark LIFESTYLE. Although it begins with the additional word ELECTRONIC, this term has minimal source-identifying significance in the context of respondent's goods and services and is in fact disclaimed. We, therefore, find that LIFESTYLES is the dominant portion of respondent's marks. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("That a particular feature is descriptive [or otherwise lacking in distinctiveness] ... with respect to the involved goods or

services is one commonly accepted rationale for giving less weight to a portion of a mark...). The word "lifestyle" is defined as "A way of life or style of living that reflects the attitudes and values of a person or group." The American Heritage Dictionary of the English Language (4th ed. 2006).¹² While the meaning and commercial impression of respondent's marks are somewhat different to the extent they convey a more specific impression, i.e., the use of electronics to create a style of living, the basic meaning, a style of living, is shared. Respondent argues that the addition of the word ELECTRONIC to its mark creates a different impression because the consumer would know that ELECTRONIC is a primary focal point of the services identified by the mark, with a corresponding inference that high technology, complexity and specialized expertise is involved." Br. p. 30. However, petitioner's mark, as applied to its goods, would have a similar connotation since its goods are electronic products. Thus, the commercial impression and connotation respondent's mark presents also relates to petitioner's goods. Respondent also argues, without evidence, that the term lifestyle is "highly laudatory and highly suggestive." While it may be possible that the term falls into the suggestive end of the spectrum

¹² We may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*,

for consumer goods, regardless of any possible suggestiveness we have found that the mark is a strong, well-known mark. On balance, we find that despite the differences in sound and appearance the ELECTRONIC LIFESTYLES mark in Registration Nos. 2285765, 2296293 and 2270920 is more similar than dissimilar to petitioner's mark LIFESTYLE.

Goods and Services/Trade Channels

We now consider whether the involved goods and services are related and the channels of trade overlap in such a manner to cause a likelihood of confusion. The goods or services need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods or services need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods or services come from a common source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). On the other hand, the parties goods or services may be so disparate and commercially unrelated that no likelihood of confusion exists even if the marks used thereon are quite similar.

213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

See, e.g., *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

We will analyze the possible relationship of each of respondent's goods and services to petitioner's loudspeakers and music systems. We begin with the services identified in Registration No. 2270920, namely, "arranging and conducting trade show exhibitions in the field of electronics and related consultation therewith." On its face, we do not find that these services are related to petitioner's goods. The mere fact that the field of these trade shows encompasses petitioner's goods, or in petitioner's words "showcases exactly the same kind of electronics products that [petitioner] sells under its LIFESTYLE mark," (Br. p. 22) does not compel a finding of a relationship between the goods and services. There is no evidence in the record to support a finding that consumers are accustomed to seeing manufacturers of loudspeakers or music systems arranging trade shows in the field of electronics.

As to the channels of trade, they do overlap. Petitioner has testified that it exhibits at respondent's trade shows and has used its mark LIFESTYLE at these trade shows. The ordinary consumer of respondent's services would include exhibitors and attendees at these specialized trade shows. As petitioner stated, the parties "target the same consumers, namely, custom installers, builders and

architects." Br. p. 23. Thus, the overlapping consumers are highly sophisticated. Respondent testified that it is precluded from advertising or sponsoring any particular product of a member or associate member. It is highly unlikely that attendees or exhibitors at respondent's trade shows [custom installers, builders, architects, manufacturers] would be confused into thinking that petitioner, an associate member, was the source of the trade show services offered at the trade shows.

We find that although the channels of trade overlap, there is no inherent relatedness between the parties' respective goods and services, and the level of sophistication of the shared consumer base militates against a finding of likelihood of confusion. *Continental Plastic Containers v. Owens Brockway Plastic Prods., Inc.*, 141 F.3d 1073, 1080-81, 46 USPQ2d 1277, 1282 (Fed. Cir. 1998).

Registration No. 2296293 is for "educational services, namely, arranging and conducting conferences, seminars, workshops and classes in the field of electronics and distributing course materials therewith." Again, the fact that the field of the educational services could include education regarding the same type of products that petitioner sells does not per se establish a relationship. Petitioner attempts to collapse its use of its mark LIFESTYLE in connection with loudspeaker and music systems

with its alleged educational services. However, these services are simply product support services and are used under a different mark. Mr. Allen testified that petitioner offers training seminars for custom installers on the selection and use of petitioner's BUILT-Invisible products that include the LIFESTYLE loudspeakers and music systems. Examples of these "educational services" consist of a training presentation, the date of which is unknown and the title of which is "BOSE BUILT-Invisible Multi-Room Audio." Deep into the presentation are a couple of slides titled "Lifestyle SA-1 Wiring" and "Lifestyle SA-1 for Custom." Another training presentation, undated, is titled Bose BUILT-INvisible Home Theater" and has no reference to the mark LIFESTYLE. Based on this record we find that the mark LIFESTYLE is not used as a mark for educational or training services. To the extent it is used at all in the training seminars for petitioner's products it is used to identify the goods, i.e., loudspeakers and music systems. To the extent petitioner offers training seminars in connection with its products, the only relevance would be that petitioner itself is an example of a manufacturer of loudspeakers that also provides training or educational services to custom installers and its mark for loudspeakers and music systems is sometimes used to identify those products during such presentations. Thus, the parties'

overlapping consumers have been exposed to at least one entity that does both, although as noted above these services are merely ancillary support services for petitioner's goods. There is no evidence of third parties marketing both petitioner's types of goods and respondent's types of services. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

As noted above, this overlapping consumer base is highly sophisticated and could distinguish between similar marks that had some differences. Of course, as noted by petitioner, respondent's identification is not limited and could include general consumers; however, we do not believe that the normal channels of trade for loudspeakers and music systems for general consumers overlap with educational services in the field of electronics, and there is no evidence that general consumers of electronic goods are exposed to a manufacturer of loudspeakers providing training seminars on electronics or on the custom installation of a home audio or theater system. Thus, to the extent there would be an overlap in the general consumer base, there would be no perception of a relationship between these goods and services.

Registration No. 2285765 is for "consulting services, namely, providing technical assistance and advice in the field of electronics via a global communications network."

Once again petitioner collapses its LIFESTYLE product mark with its service offered under its house mark BOSE that consists of the provision of technical advice and support for its products. While this advice and support is provided under the BOSE mark, the LIFESTYLE product mark does appear on the site in connection with the LIFESTYLE loudspeakers and music systems. Again, the only possible relevance here would be the fact that the overlapping consumers have been exposed to a manufacturer also offering technical advice and support for its products, a purportedly similar service to respondent's services. While respondent's identification is not limited and would include general consumers, petitioner has not submitted a registration for these services and is relying on its common law use, which consists only of providing advice on their products and their installation, and is accessible only by a limited consumer base, professional installers and dealers. See Allen Confidential Dep. pp. 10-12 Exh. No. 61. As petitioner states "the record shows that the parties actually direct their consulting services to the same people, by the same methods [petitioner] offers its consulting services to custom installers in order to educate them on the selection and use of the BUILT-Invisible and LIFESYTLE electronic products, and has done so online, via an e-mail newsletter, and at its website [and] ...the channels of trade and class of

purchaser of respondent's home electronics product and service offerings are primarily for and to custom installers." Br. p. 37. Thus, petitioner's technical advice is simply an ancillary service to support its products, and any possible overlap in the consumer base for these services would only be sophisticated consumers. There is no evidence of record that the general consumer is exposed to this type of product/service overlap. On balance, we find that petitioner's loudspeakers and music systems are not related to respondent's technical assistance services. To the extent there is an overlap in the general consumer base, e.g., a purchaser of a LIFESTYLE speaker seeking technical advice on the ELECTRONIC LIFESTYLES website, there is nothing in the record to support a possibly perceived relationship between the loudspeakers and the technical advice services inasmuch as petitioner's service is ancillary to its product and respondent's service is a general advice service.

Actual Confusion

At the time of trial, the parties' marks had been in contemporaneous use for approximately eight years. We note that there is no evidence in the record of even a single occurrence of actual confusion during this time. This is not surprising given the level of sophistication of respondent's and petitioner's overlapping consumers. Both

parties state that petitioner exhibits at respondent's trade shows and petitioner submitted testimony regarding its continuous presence at respondent's trade shows and the exhibition including the LIFESTYLE products. Based on these facts, there has been a meaningful overlap of concurrent use as regards the trade show and educational services.

Petitioner simply argues that evidence of actual confusion is not necessary to find likelihood of confusion. We find that, at least as to Registration Nos. 2296293 and 2270920, the lack of actual confusion weighs in favor of respondent. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Based on the evidence of record pertaining to the relevant du Pont likelihood of confusion factors, we conclude that no likelihood of confusion exists. Notwithstanding the similarity of the marks and the strength of petitioner's mark in the field of loudspeakers and music systems, we find that petitioner's loudspeakers and music systems and respondent's trade show, educational and technical advice services are too dissimilar for source confusion to result. We find petitioner's likelihood of confusion theory to be speculative and that the extent of potential confusion is de minimis at best. As stated by our primary reviewing court: "We are not concerned with mere theoretical possibilities of confusion, deception or mistake

or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal."

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) quoting Witco Chem. Co. v. Whitfield Chem. Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g 153 USPQ 412 (TTAB 1967).

While we find that the parties' respective goods and services as identified are not related, for completeness we address respondent's affirmative defense that it is entitled to registration for these three registrations with the added restriction that respondent's services "are rendered through the activities of a trade association composed of member businesses that specialize in design and installation of custom electronic systems for the home which activities feature an awards program recognizing outstanding achievements in the specialized field of the member businesses." The restriction limits the trade channels to that of a trade association in a very specialized field. Thus, to the extent the original identifications allow for overlap in trade channels and the general consumer base,

these restrictions eliminate that overlap and serve to preclude a likelihood of confusion.¹³

Laches

Although we have determined that there is no likelihood of confusion, we take up for consideration respondent's affirmative defense of laches. The defense of laches is provided for in the Trademark Act. 15 U.S.C. §1069. In this case, this defense may only be applied to the claim of likelihood of confusion, and, thus, only pertains to Registration Nos. 2285765, 2296293 and 2270920.

The party raising the affirmative defense bears the burden of proof. *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001). "To prevail on its affirmative defense [of laches, respondent] was required to establish that there was undue or unreasonable delay by [petitioner] in asserting its rights, and prejudice to [respondent] resulting from the delay." *Id.*

A petitioner must be shown to have had actual knowledge or constructive notice of a registrant's trademark use to establish a date of notice from which a delay of laches can be measured. *Loma Linda Food Co. v. Thomson & Taylor Spice*

¹³ The identifications remain unrestricted. If on appeal, the Board's decision is reversed as to the unrestricted identifications but affirmed as to the restricted identification, on remand the Board will amend the registrations to include the pleaded restriction.

Co., 279 F.2d 522, 126 USPQ 261 (CCPA 1960). Laches based on constructive notice begins to run from the date of registration on the Principal Register. *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203 (TTAB 2006), *aff'd*, *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 208 Fed. Appx. 886, unpublished Nos. 2006-1366, 2006-1367 (Fed. Cir. December 6, 2006). See also, *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

Respondent argues that petitioner "has unreasonably delayed in asserting its rights with respect to its LIFESTYLES mark" when petitioner was on "constructive notice of [respondent's] ELECTRONIC LIFESTYLES mark at least as of March 18, 1997, the first publication for opposition of one of respondent's four underlying applications and on April 22 and 29, 1997 when the other three underlying applications were published for opposition. In addition to constructive knowledge, respondent's witnesses testified that "No way in my mind can I imagine that they had not seen Electronic Lifestyles everywhere, especially at Expo, in all the publications that they received. I can't believe they didn't see it for seven years. I mean, it just - it's unbelievable to me. Absolutely astonishing." Keller Dep. p. 100. Mr. Gilpin introduced an exhibit showing attendees

at respondent's trade shows from 2000 that showed that representatives from petitioner, including Mr. Allen, attended respondent's trade shows during this time period. Respondent also introduced evidence that shows that an employee from petitioner visited respondent's website in February 2002 and searched the term "lifestyles" which brought that person to the web page displaying the Electronic Lifestyles Awards. David E. Stevens Dep. (hereinafter Stevens Dep.) a consultant for respondent, pp. 6-13, Exh. 152.¹⁴ In addition, Mr. Gilpin testified to the broad and significant use of the mark ELECTRONIC LIFESTYLES throughout the expo, Gilpin Dep. pp. 43, 46, 49 and Mr. Raymond J. Lepper testified as to the use of ELECTRONIC LIFESTYLES above the voting kiosks at respondent's trade shows. Lepper Dep. 59, Exh. 147.

The first contact respondent ever had with regard to petitioner's objection to its use of ELECTRONIC LIFESTYLES was approximately June 12, 2003 the date petitioner sent respondent a cease and desist letter. Keller Dep. p. 98, Exh. No. 140. At no time prior to that letter did respondent receive any objection or complaint from petitioner. Keller Dep. p. 99.

As to prejudice, respondent testified as follows:

¹⁴ The earliest date respondent could have checked was February 2002 inasmuch as they had changed servers and had discarded the previous log files. Stevens Dep. p. 9.

Q. To what extent, if any, has CEDIA made investments in the Electronic Lifestyles marks since it first began using them?

A. Well, in any marketing endeavor we've invested hundreds of thousands of dollars in developing the trademark, developing the tag line, making sure it's where it's supposed to be, making sure it's published where it's supposed to be, branding it, talking about it. So it's been an investment that we chose to make but a very expensive investment.

Q. And in making that investment, did CEDIA rely upon the lack of any objection by anyone prior to June of 2003 to commit itself to those investments in the Electronic Lifestyles mark?

A. Of course.

Keller Dep. p. 101.

As noted earlier, respondent was founded in 1989, Keller Dep. p. 6, and petitioner is a founding member of respondent, Allen Dep. p. 123. Petitioner has frequently attended and exhibited at respondent's trade shows, including a presentation that referenced the LIFESTYLE mark. Allen Dep. p. 110, 111. However, Mr. Allen testified that he was not aware of any use of the trademark ELECTRONIC LIFESTYLES by respondent. Allen Dep. p. 113.

Based on the record, at a minimum, we find that respondent has submitted sufficient un rebutted evidence that at least some employees of petitioner had actual knowledge of respondent's use of, THE SHOW FOR ELETRONIC LIFESYTLES in the 1996 trade show brochures and ELECTRONIC LIFESTYLES used on respondent's website since 1996 prior to publication. We do not find credible the idea that petitioner was not aware

of the uses of the mark ELECTRONIC LIFESTYLES, at least as to the use of the mark in conjunction with other wording or services.¹⁵ However, in view of Mr. Allen's testimony, we will calculate the length of delay from the date of registration of the respective registrations, Reg. No. 2296293 November 30, 1999, Reg. No. 2285765 October 12, 1999, Reg. No. 2270920 August 17, 1999.¹⁶ The petition was filed on August 11, 2003. Thus, the length of petitioner's delay in filing the petition for cancellation is approximately four years. Petitioner is completely silent as to the reason for the delay. See J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 31:14 (4th ed. 2005) ["The trademark owner is usually expected to give some reason for delay which appears to cause prejudice. It is dangerous to simply stand mute and take the position that there is no obligation to explain apparent lethargy."]. See also *Procter & Gamble Co. v. J.L. Prescott Co.*, 102 F.2d 773, 40 USPQ 434, 442 (3d Cir. 1939), cert. denied, 308 U.S. 557 (1939) (that delay was unexplained "must weigh heavily in the balance against it"). Rather than addressing the laches defense in either its main brief or reply brief,

¹⁵ For example, respondent's very visible use of the HOME OF ELECTRONIC LIFESTYLES in its trade show exhibits simply could not be missed; however, it is not clear if this use occurred prior to publication of the applications.

¹⁶ The dates of publication of the respective registrations are: March 16, 1997, April 29, 1997, and April 8, 1997.

petitioner merely states that laches "must fail because it is based on the false presumption that Respondent was actually using the mark for the ELECTRONIC LIFESTYLES mark for the goods/services identified in the registrations at issue when it was not, and Respondent has not demonstrated there was prejudice."¹⁷ Reply Br. p. 16. In view of our findings regarding respondent's use of the mark ELECTRONIC LIFESTYLES and petitioner's objection to that use brought forward by a claim under Section 2(d) of the Trademark Act, this does not constitute a "reason" for inaction. Moreover, petitioner is charged with the knowledge of the registrations as of the registration dates for these goods and services and the issue pertains to petitioner's delay in acting to object to the registrations not to the use.

We find that petitioner's delay of four years and the complete absence of any reasonable excuse for its inaction, constitutes undue delay prior to filing the petition for cancellation.

Further, we find that respondent has established economic prejudice based on its development and maintenance of its operations and good will around its ELECTRONIC LIFESTYLES mark during the time petitioner continued to attend and exhibit at respondent's trade shows and raised no

¹⁷ Petitioner also correctly states that the laches claim is not an applicable defense to the claims of fraud and abandonment.

objections. Petitioner's argument that respondent's claim of prejudice is unsubstantiated is not correct. Ms. Keller, respondent's Executive Director, sufficiently testified as to the level of prejudice. Although respondent did not provide specific figures regarding its investment in building this brand it is clear that during petitioner's period of silence, respondent invested in and promoted its ELECTRONIC LIFESTYLES brand. Accordingly, respondent has established a laches defense against petitioner's likelihood of confusion claim.

Our next inquiry would be to consider whether any confusion between the parties' marks is inevitable. *Ultra-White Co., Inc. v. Johnson Chemical Industries, Inc.*, 465 F.2d 891, 175 USPQ 166 (CCPA 1972); *Teledyne*, supra. In view of our finding of no likelihood of confusion, we find that the evidence of record does not support inevitable confusion, particularly given the sophistication of the overlapping consumers and the absence of confusion over a period of approximately 8 years. In view thereof, respondent's valid laches defense is applicable and petitioner's likelihood of confusion claim must be dismissed.

Decision: The petition to cancel Registration Nos. 2155296, 2285765, 2296293, and 2270920 is dismissed on all grounds.