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

Proceeding	92057241
Party	Defendant Steven Berlin
Correspondence Address	THOMAS CARULLI KAPLAN MASSAMILLO & ANDREWS 70 EAST 55TH STREET, 25TH FLOOR NEW YORK, NY 10022 UNITED STATES tcarulli@kmalawfirm.com
Submission	Brief on Merits for Defendant
Filer's Name	Thomas Carulli
Filer's e-mail	tcarulli@kmalawfirm.com
Signature	/tgc/
Date	07/11/2016
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Daniel M. Goodman,

Cancellation: 92057241

Petitioner,

-v-

Steven Berlin,

Registrant

REGISTRANT STEVEN BERLIN'S BRIEF

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STATEMENT OF THE CASE

Registrant Steven Berlin (“Berlin”) is the owner of the mark LOS SUPER SEVEN and Registration 4199114 therefor for services in Class 41, namely “entertainment services in the nature of live musical performances.”

Petitioner Daniel Goodman ("Goodman") filed a Petition for Cancellation of Registrant Berlin’s mark on the basis that Petitioner allegedly was the “prior user” of the mark for goods in Class 9 (i.e., musical recordings) and services in class 41 (i.e., “live musical performances”) (Petitioner’s Brief, p.1).

Registrant Berlin is a multi-Grammy Award winning record producer, saxophonist and keyboard player (TTABVUE 26, p. 3-6), as well as a multi-Grammy Award winning performer and member of the iconic Latin rock band LOS LOBOS (TTABVUE 22, p. 2-3).

Petitioner Goodman, by his own admission, has been a manager for certain musical performers, not a record producer (TTABVUE 20, p. 2).

Awards that Registrant’s group LOS LOBOS have received include: Grammy Awards, Best Mexican/American Performance for “Anselma,” 1983; Best Mexican-American Performance for “La Pistola Y El Corazon,” 1989; Best Pop Instrumental Performance for “Mariachi Suite,” 1995; selected Band of the Year and Best New Artist, Rolling Stone critics’ poll, 1986; Billboard Latin Music Awards, Lifetime Achievement Award, 2001 (TTABVUE 22, p. 3)¹.

¹ LOS LOBOS has made numerous appearances in live and televised musical performances, including at the White House in 2009, and was featured on the White House website (TTABVUE 22, p. 2).

It was at the 1997 South by Southwest Music Festival that several musical artists, including Registrant, at an *impromptu* music session, spoke about gathering prominent Latin artists who generally performed separately (TTABVUE 22, p. 2-3). That resulting in Registrant asking his fellow LOS LOBOS band members, including the internationally renowned artists David Hidalgo and Cesar Rosas, to join in that effort (TTABVUE 22, p. 2)². The idea was presented to RCA Records on behalf of those performing artists, and agreement was reached - and contracts entered into - between RCA and the artists for their participation (including the famous LOS LOBOS band members) (TTABVUE 22, p. 3), between RCA and Registrant Steven Berlin for Berlin to handle the actual production of the musical recording (TTABVUE 22, p. 4), and between RCA and Petitioner to handle the administrative and fiscal matters associated with the recording process, as Executive Producer (TTABVUE 22, p. 3-4)³.

Paragraph 8A of the RCA Agreement further confirms there was a separate RCA Agreement between RCA and the Producer Steven Berlin (TTABVUE 20, p. 9)⁴ – and that producer was Registrant Steve Berlin. Petitioner did not “retain” Registrant, RCA did.

² It was during that time that Registrant’s wife suggested that the artists use LOS SUPER SEVEN as the name (TTABVUE 22, p. 3). At that time the artists entered into their agreements with RCA, LOS LOBOS was already one of the most famous Latin rock bands of all time, had won Grammys in 1989 and 1995, and had a hit song, LA BAMBABA, having already gone platinum (TTABVUE 22, p. 2).

³ Petitioner’s involvement in the RCA recording LOS SUPER SEVEN in 1998 was not as the actual producer of the sound recording, and Petitioner does not claim that it was (indeed, Petitioner admits in his testimony that Registrant Berlin was the Producer (TTABVUE 20, p. 2)).

⁴ Paragraph 8A expressly conditions RCA’s fulfilling RCA’s obligations on the artists and producer Steven Berlin fulfilling their independent obligations to RCA under their separate agreements with RCA. Paragraph 5A of the RCA Agreement further states that RCA was to pay the artists and Producer Steven Berlin separate royalty payments from Petitioner pursuant to the terms of their separate agreements (TTABVUE 20, p. 7).

When Sony subsequently decided to do another album in 2001, the evidence of record is that the same facts held true – Petitioner was solely the Executive Producer under contract with Sony, the artists were under contract solely with Sony, not Petitioner, and Registrant produced the album under contract with Sony, not under contract with Petitioner (Ppetitioner again had no involvement with the actual production and recordation of the music), and the album was released to the public by Sony, not Petitioner (TTABVUE 22, p. 4).

With respect to any live performances of music by the artists involved in the recordings discussed herein, the members of LOS LOBOS, including Registrant Berlin, never joined or participated in any live performances under the control of Petitioner, or by being retained by Petitioner (TTABVUE 22, p. 5).

1. Petitioner does not own and never owned rights in the subject mark for products in Class 9, namely “musical sound recordings, pre-recorded compact discs, videotapes and audio visual discs, all featuring music.”

Ppetitioner’s own admissions and submitted documentary evidence conclusively prove that Petitioner did not and does not own any rights in the subject mark for sound recordings.

First, the documentary evidence made of record on this issue by Petitioner, the RCA Agreement, expressly states that regardless of what task Petitioner performed under his contract with RCA in 1998, it was as a “work for hire.” Paragraph 1 (b) of the RCA Agreement states:

During the term ("Term") of this agreement you (sometimes, hereinafter the "Executive Producer") **shall perform non-exclusively for RCA as the Executive Producer of Master Recordings** (the "Masters" or "Subject Masters") for an as yet untitled album featuring Latin-influenced Texas music of the 1920's to 1940's (the "Album") **embodying the performances of David Hidalgo, Cesar Rosas, Joe Ely, Flaco Jiminez, Rick Trevino and Freddy Fender (each, individually, an "Artist" and collectively, the "Artists") subject to recording agreements with RCA ("Artists' Agreements")**. (emphasis added) (TTABVUE 20, p. 5).

The RCA Agreement also conclusively evidences that RCA, not Petitioner (or even Registrant who did the actual record production), controlled the nature and quality of the products (the sound recordings). Paragraph 7 of the RCA Agreement first states:

Each Master Recording made hereunder is intended to be, and will be a "work made for hire" (as specified in the United States Copyright Act) for RCA and, as between Executive Producer and RCA, RCA shall have the right of copyright in the Masters in RCA's name as owner and author and the right to secure any and all renewals or extensions of such copyright...(emphasis added) (TTABVUE 20, p. 8).

Paragraph 7 of the RCA Agreement further states:

The Masters made hereunder and all derivatives **manufactured** therefrom **together with the performances embodied thereon shall be entirely and forever the property of RCA**, free of any claims whatsoever by Executive Producer or any person deriving any rights or interests from Executive Producer. Except as otherwise specifically provided for in this agreement, **the method, manner and extent of release, packaging, promotion, advertising, distribution and sale relating to reproductions of the Masters shall be within the sole discretion of RCA**. Without limiting the generality of the foregoing, **RCA shall have the sole and exclusive right throughout the world; (i) to manufacture Phonograph Records embodying the Masters by any method now or hereafter known in any form; (ii) to sell, transfer, advertise, publicize or otherwise deal in the Masters and reproductions thereof;... RCA shall have the right, in perpetuity throughout the Universe, to embody the Masters on the Album. RCA may exploit the Album and the Masters embodied therein in any manner by all means and in any and all media now or hereafter known.** (emphasis added) (TTABVUE 20, p. 8).

Paragraph 7 concludes:

RCA shall have the right, in perpetuity throughout the Universe, to embody the Masters on the Album. RCA may exploit the Album and the Masters embodied therein in any manner by all means and in any and all media now or hereafter known. (TTABVUE 20, p. 9).

Thus, the RCA Agreement confirms that it was RCA, and only RCA, that had the right to control the nature and quality of the sound recordings and to manufacture the sound recordings of that album on which the name LOS SUPER SEVEN was used.

As the TTAB explained in *In re Innertemple Music LLC* (at p. 4, unpublished decision attached hereto) that:

... the owner of a registration for compact discs is considered to be the entity that produces or **manufactures the physical object**. (emphasis added)

See also, two registrations owned by The Warner Entertainment Company, L.P. for marks containing the name “Warner Bros.” for, inter alia, pre-recorded phonograph records and tapes, as examples of the Office practice that it is the manufacturers of records, as opposed to the artists whose performances are embodied in the records, that are treated as the source of records, tapes and downloadable audio recordings.

As Registrant testified, the same uncontroverted facts were true for the succeeding sound recording in 2001, when Sony manufactured and released the sound recording, not Petitioner (TTABVUE 22, p. 4). Petitioner again was solely the Executive Producer under contract with Sony, the artists again were under contract with Sony (not with Petitioner), and Registrant Berlin actually produced the Sony album, under contract as Producer for Sony, not Petitioner. The physical products were manufactured and released to the public by Sony, not Petitioner.

Simply put, there is no evidence that Petitioner ever controlled the nature and quality of the manufacture of any physical sound recordings sold in the United States (or elsewhere) under the subject mark, never mind the requisite series of sound recordings. To the contrary, the evidence of record shows that Petitioner never manufactured such products, different record companies did. And as Petitioner testifies, those recordings had different names anyway (e.g., Canto, I heard it on the X) (TTABVUE 20, p. 2-3).

Thus, Petitioner never had, and cannot assert or rely upon in this proceeding, any trademark rights in LOS SUPER SEVEN for sound recordings in Class 9.

2. Petitioner cannot assert rights in the mark LOS SUPER SEVEN for services in Class 41, namely, “live performances by a musical group.”

It is Registrant's position, supported by the evidence, that Petitioner never controlled the nature and quality of any live performances by any artist under the name LOS SUPER SEVEN (Registrant's testimony, TTABVUE 22, p. 5).

But that argument aside, Petitioner independently has proven that he has no rights in the mark LOS SUPER SEVEN for services in the nature of live performances by a musical group. Specifically, had any rights been established by Petitioner having controlled the nature and quality of live musical performances conducted in or around the time the sound recordings were produced by the record companies in 1998, or even 2005, such rights were abandoned more than a decade ago due to non-use.

Petitioner presented *no* documentary evidence of *any* specific live performances in association with which the mark LOS SUPER SEVEN had been used.

And even Plaintiff's unsupported allegations about live performances mention only one performance date, and that was in 1998. In his Declaration, Petitioner states - "I first produced a concert in Los Angeles, California on September 14, 1998..." (TTABVUE 20, p. 4) - *this is more than 17 years ago*. No other or more recent dates of actual live performances are mentioned in Petitioner's testimony.

And there is no evidence of record that this more than a decade of nonuse by Petitioner was "excusable". Petitioner's only proffered excuse in his testimony (TTABVUE 20, p. 4) is that:

I have never abandoned the use of the mark. Specifically, the related goods, the three record albums I produced as "Los Super Seven" are still commercially available and I am in the planning stages of the fourth "Los Super Seven" recording which will be supported by a promotional tour.

This as a matter of law is not excusable non-use⁵. First, Petitioner had no rights in the mark LOS SUPER SEVEN for goods in Class 9 to which he refers (the “three record albums”). Second, the completely unsupported statement by Petitioner that after 10 to 17 years of non-use for live performances, he suddenly is “planning” for a “recording” that might be supported by a “promotional tour” is of no evidentiary value supporting excusable nonuse.

TMEP 1604.11, entitled “*Excusable Nonuse*” of Mark, states that:

If the mark has not been in use for three consecutive years and the owner has done nothing to try to resume use of the mark, the USPTO may presume that the owner has abandoned the mark. 15 U.S.C. §1127; see *Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997).

Here, the nonuse of the mark for live performances admittedly lasted far longer than 3 years (Petitioner mentions no activity of any kind after the 2005 album purportedly was released). As a matter of law, non-use for live performances for the 10 to 17 years that Petitioner allowed to pass is *prima facie* evidence of abandonment (15 U.S.C. §1127). There is no evidence to the contrary.

TMEP 1604.11 makes clear that in an attempt to show that there was “no intention to abandon the mark, the owner must show that nonuse is due to *special circumstances* beyond the owner's control that excuse nonuse” (emphasis added).

In the present case, no special circumstances existed (and none are of record). Simply stating that one had no intention to abandon, as did Petitioner, is not “evidence” sufficient to satisfy the standard. As the court noted in *Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 1581, 14 USPQ2d 1390 (Fed. Cir. 1990 – “Nothing in the statute entitles a registrant who

⁵ While Petitioners’ brief slips into claiming that Petitioner “produced” the albums, as is evident from even Petitioner’s submissions, Petitioner never produced any albums - skilled and experienced record producers did, as contractors to the record companies – and Petitioner certainly never manufactured the physical sound recording media sold to the public.

has formerly used a mark to overcome a presumption of abandonment arising from subsequent nonuse by simply averring a subjective affirmative “intent not to abandon.”).

And Petitioner’s self-serving claim (without *any* support whatsoever) to be “planning” to do something new, after all these years of non-use, is not sufficient to satisfy the standard, as the court in *Imperial Standard* made clear (*Id.* at 1582-83).

Separately, and as Registrant testified, the artists retained by the recording companies never performed live under the control of Petitioner in any event. The performance mentioned by Petitioner, coinciding with the release of the albums, were conducted by the artists as ancillary to, and in promotion of, the recordings being manufactured and sold *by the recording companies with which the artists has their contracts* (e.g., RCA). Thus, Petitioner never established any rights to the mark for live music performances in any event.

CONCLUSION

Registrant respectfully submits that In light of the record, The Cancellation Petition is without merit and should be denied and dismissed.

July 11, 2016

_____/tgcarulli/_____

Thomas Carulli
Kaplan Massamillo & Andrews
70 East 55th Street, 25th Floor
New York, NY 10022
Tel. 212-922-0450
Fax 212-922-0530
tcarulli@kmalawfirm.com

Attorney for Registrant

This Opinion is not a
Precedent of the TTAB

Mailed: June 5, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Innertemple Music LLC
—

Serial No. 85810152
—

Thomas Carulli of Kaplan Massamillo & Andrews
for Innertemple Music LLC.

Ellen Awrich, Trademark Examining Attorney, Law Office 116,
Michael W. Baird, Managing Attorney.

—
Before Seeherman, Kuhlke and Wellington,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Innertemple Music LLC has appealed from the Trademark Examining Attorney's final refusal to register the mark SHAKTI THARA (in standard characters) on the Principal Register for services identified as "entertainment services in the nature of live musical performances by a singer of pop music."¹ The application includes the statement that the name "shown in the mark identifies

¹ Application Serial No. 85810152, filed December 24, 2012, asserting first use at least as early as April 1, 2010 and first use in commerce at least as early as August 7, 2012.

Thara Thangavelu dba SHAKTI THARA, whose consent to register is made of record.”

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the mark SHAKTI (typed drawing, equivalent of standard characters), registered for the following goods, that as used in connection with Applicant’s services it is likely to cause confusion or mistake or to deceive:

Compact discs, downloadable audio recordings featuring music and which may be accompanied by printed text and images, namely, booklets, brochures, tray cards, and inserts concerning the music contained in the aforementioned goods sold therewith as a unit. (Class 9).

The registration includes the statement, “The foreign wording in the mark translates into English as ‘the dynamic energy of a Hindu god personified as his female consort or more generally as the active energy force of the universe.’”²

² Registration No. 2633837, issued October 15, 2002; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed. Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark. *See In re Brack*, 114 USPQ2d 1338, 1339 n.2 (TTAB 2015). The registration as originally issued had the identification “pre-recorded phonograph records, audio cassette tapes, video cassette tapes, compact discs, CD-ROMs, downloadable audio and video recordings featuring music and which may be accompanied by printed text and images, namely, booklets, brochures, tray cards, and inserts concerning the music contained in the aforementioned goods sold therewith as a unit.” Pre-recorded phonograph records, audio cassette tapes, video cassette tapes and CD-ROMs were cancelled from the registration either at the time the Section 8 affidavit was filed or the registration was renewed. The deletion explains the somewhat awkward language used to identify the remaining goods, and it is clear that “pre-recorded” still modifies the remaining items.

The Examining Attorney had cited two additional registrations, No. 3224092 for SHAKTI DANCE, issued April 3, 2007, for, inter alia, “entertainment in the nature of dance performances” and “entertainment in the nature of theater productions”; and No. 4313575 for BIG SHAKTI, issued April 2, 2013, for, inter alia, “music recordings; audio recordings about yoga, meditation, health and wellbeing, illness, therapy, mind-body medicine,

Applicant and the Examining Attorney have filed briefs.³

We reverse the refusal to register.

Our determination of the issue of likelihood of confusion 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 & 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).

We first consider the *du Pont* factor of the similarity of the goods and services. The Examining Attorney takes the position that the services and goods are related because musical artists can be the source of both live musical performances and recordings, and has submitted evidence from various musicians' websites to show that they promote both. The Examining Attorney obviously views the recordings promoted on such websites as being the same goods as the compact discs identified

spirituality, Ayurveda.” The registration for SHAKTI DANCE was cancelled for failure to file a Section 8 affidavit, and the Examining Attorney withdrew the refusal based on the registration for BIG SHAKTI.

³ Applicant filed its appeal brief on December 22, 2014, and filed a revised brief on December 23, 2014. We have considered the revised brief. Applicant filed its reply brief on February 11, 2015, although it was due on February 10. Applicant was given time to provide an explanation as to why its brief was late, but it did not do so. Accordingly, in accordance with the Board's March 25, 2015 order, no consideration has been given to the reply brief.

in the cited registration. However, the Office makes a distinction between the performances embodied in a compact disc, and the compact disc itself. An artist may not normally obtain a registration for compact discs because his or her performance is contained in them. Rather, the owner of a registration for compact discs is considered to be the entity that produces or manufactures the physical object. “Any mark consisting of ...the name of a performing artist on a sound recording, must be refused registration under §§ 1, 2, and 45 of the Trademark Act, 15 U.S. C. §§ 1051, 1052, and 1127, if the mark is used solely to identify ... the artist. TMEP § 1202.09(a). The evidence must show that the name serves as more than a designation of the performer. TMEP § 1209.09(a)(ii). Thus, for a mark to be registrable for “sound recordings,”⁴ it must identify the source of the object itself, and not merely the artist who has created the performance embodied on that object. *See In re Arnold*, 105 USPQ2d 1953, 1959-60 (TTAB 2013), in which the Board found that BLATANCY failed to function as a mark because it merely identified the name of a performer featured on the applicant’s musical recordings. *See also*, two registrations owned by The Warner Entertainment Company, L.P. for marks containing the name “Warner Bros.” for, *inter alia*, pre-recorded phonograph records and tapes,⁵ as examples of the Office practice that it is the manufacturers of records, as opposed to the artists whose performances are embodied in the records, that are treated as the source of records, tapes and downloadable audio recordings.

⁴ “[S]ound recordings may be presented in recorded or electronic form.” TMEP § 1202.09(a).

⁵ Response filed October 13, 2014, pp. 81-84.

In view of this practice of the Office, we must regard the cited registration as indicating the source of the physical compact discs and the downloadable audio recordings, as opposed to the source of the performances contained on the compact discs and recordings. The Examining Attorney has not submitted any evidence that entities that are the source of physical compact discs or recordings for downloading also render performing services under the same mark.⁶

There is, of course, an inherent connection between compact discs and the performances that are recorded on them, but that does not mean that performing services and compact discs must automatically be treated as related. We cannot conclude from the record herein that performing services and actual compact discs or downloadable recordings are sold under a single mark, such that consumers would believe that the performers that render performing services also manufacture compact discs or supply downloadable recordings. On the contrary, what we do have as an example of the coexistence of marks for sound recordings and entertainment

⁶ We note some statements in a Billboard Internet article that would suggest that the performing artist Jay Z has a record company (“ever since he founded Roc-a-Fella Records in 1966”), but this would suggest that, to the extent that performing artists also are responsible for the manufacture and distribution of the physical items, they do so under a different trademark from that used in rendering their performance services. *See* “Beyoncé, Jay Z Top Billboard’s Power 100 List,” *billboardbiz*, January 23, 2014, www.billboard.com; April 17, 2014 Office action, p. 19.

In addition, the excerpts from the itunes.apple.com website regarding the downloading of a song performed by Pharrell Williams state that it was released on March 3, 2014, copyright “Columbia Records, a Division of Sony Music Entertainment, 2013 Back Lot Music, under exclusive license to Columbia Records, a Division of Sony Music Entertainment.” April 17, 2014 Office action, p. 32.

services are the two previously discussed WARNER BROS. registrations for sound recordings, and a registration owned by an individual, Gia Warner, for the mark GIA WARNER for, *inter alia*, entertainment services, namely, personal appearances by a music artist, and live music concerts (Reg. No. 3689824).⁷ Although these third-party registrations showing a single instance of the coexistence of marks with a common element has limited probative value, this is an example of the Office finding that there was no likelihood of confusion between such marks when used for records in one case and performance services in the other.

As for the marks, there is no question that SHAKTI in Applicant's mark SHAKTI THARA is identical to the registered mark, SHAKTI. However, Applicant's mark, SHAKTI THARA, used for live musical performances by a pop music singer, would likely be understood to be the name or pseudonym of the singer. Thus, as used in the mark, SHAKTI would be viewed as the performer's first name. The cited registration, on the other hand, contains a translation of SHAKTI as meaning "the dynamic energy of a Hindu god personified as his female consort or more generally as the active energy force of the universe." This translation is confirmed by a dictionary definition submitted by Applicant: "the dynamic energy of a Hindu god personified as his female consort; *broadly*: cosmic energy as conceived in Hindu thought."⁸ In addition, third-party registrations made of record by Applicant contain similar translations, e.g., "sacred force and empowerment" (Reg. No. 4311545); "energy" (Reg. No. 4098693); "power, energy, divine power, divine energy" (Reg. No.

⁷ Response filed April 10, 2014, p. 85.

⁸ *Merriam-Webster*, October 13, 2014 response, p. 86.

4300500); and “power” (Reg. No. 4132391).⁹ The third-party registrations show that this term has been chosen for several marks connected with yoga services, suggesting that SHAKTI has a significance in this area. Practitioners of yoga may therefore be aware of this meaning. Others seeing the registrant’s mark may view it as an invented term. In any event, they are not likely to view it as a woman’s given name, because there is no evidence that it is generally used as a name. In fact, the person who has consented to the use and registration of her name, SHAKTI THARA, is actually named “Thara Thangavelu,” and Shakti Thara is a stage name.¹⁰

Accordingly, the connotations of the two marks are very different, with SHAKTI THARA being understood as a personal name, while SHAKTI would, to some, have the meaning of energy or power, or have a general significance related to yoga, while others would view it as a coined term. In any event, they would not view registrant’s mark SHAKTI as a given name. We find that the differences in the connotations of the marks, and the commercial impressions, outweigh the similarities in the marks due to the common element SHAKTI. Therefore, we find that overall the marks are more dissimilar than similar.

Finally, with respect to the “conditions of purchase” *du Pont* factor, Applicant argues that the purchasers of the relevant goods and services are discerning and sophisticated. We disagree. Purchasers of pre-recorded compact discs, downloadable

⁹ October 13, 2014 response, pp. 42, 44, 51, 58.

¹⁰ “The subject mark is the name under which Applicant’s owner, Thara Thangavelu, performs....” October 10, 2013 response, p. 1.

audio recordings and live musical performance services are the general public, and there is no evidence that would lead us to conclude that they are particularly sophisticated when it comes to buying compact discs or downloading audio recordings or attending musical performances. The record shows that individual songs can be downloaded for as little as \$1.29¹¹ Applicant relies on two federal district court cases in which the court referred to buyers of musical recordings as relatively sophisticated. However, the courts were clearly treating “musical recordings” as the artist’s performance embodied in the recording. Because, as already discussed, the compact discs and the downloadable audio recordings identified in the cited registration are the physical objects rather than the artists’ performances, the statements by the courts are not applicable to the present situation. We therefore treat this *du Pont* factor as neutral, as we do the remaining *du Pont* factors, which have not been discussed and for which no evidence has been submitted.¹²

Because we find that the record does not establish that consumers are likely to assume that a single entity would offer manufactured compact discs and

¹¹ April 17, 2014 Office action, p. 32.

¹² Applicant has also argued that the scope of protection to be accorded the cited registration should be limited. We note that several third-party registrations for marks containing the word SHAKTI for the same or very similar goods and services to those of the registrant or Applicant were registered despite the presence of the cited registration on the register. The goods in the cited registration include compact discs; Registration No. 4313575 for BIG SHAKTI includes “music recordings”; Registration No. 3379506 for SHAKTI WARRIORS includes live performances by costumed characters; and Registration No. 3224092 for SHAKTI DANCE includes entertainment in the nature of dance performances and entertainment in the nature of theater productions. Although we do not base our decision on this, these third-party registrations indicate that in several instances examining attorneys have not treated the cited registrant’s mark SHAKTI as a strong mark that is entitled to a broad scope of protection.

downloadable audio recordings and also render entertainment services in the nature of live musical performances by a singer of pop music, let alone under a single mark, and because of the differences in connotation and commercial impression of the marks, we cannot find that Applicant's mark for its services is likely to cause confusion with the registrant's mark for its goods. Accordingly, we must reverse the refusal of registration.¹³

Decision: The refusal to register Applicant's mark SHAKTI THARA is reversed.

¹³ On a different record, such as might be adduced in an opposition proceeding, we might reach a different result.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Registrant's Brief been sent by email to Sawnie Aldridge, Esq. attorney for Petitioner at trip@aldredgelaw.com, this the 11th day of July 2016.

_____/tcarulli/_____
Thomas Carulli