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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Petite Four, Inc.

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Serial No. 76280243

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Robert Berliner of Fulbright & Jaworski L.L.P. for Petite Four, Inc.

Tracy Cross, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

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Before Simms, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Petite Four, Inc. (applicant), a California corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark EMPEROR NORTON RECORDS ("RECORDS" disclaimed) for "musical sound recordings" in Class 9, and "promoting the goods and services of others through direct mail advertising and the distribution of printed and audio promotional materials in the field of sound recordings and musical performances;

advertising agency services in the field of sound recordings and musical performances of entertainment personalities; management of musical performers" in Class 35.[1]

Applicant and the Examining Attorney have filed briefs but no oral hearing was requested.[2]

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 2,191,742, issued September 29, 1998, for the mark NORTON RECORDS ("RECORDS" disclaimed) for prerecorded vinyl phonograph records, audio cassettes and compact discs featuring music.

It is the Examining Attorney's position that, in this case, the most important factors are the similarities of the marks, the goods and services, and the trade channels. With respect to the marks, the Examining Attorney maintains that the dominant term in both applicant's and registrant's marks is the word "NORTON" and that the addition of the word "EMPEROR" to the registered mark does not avoid likelihood of confusion. The Examining Attorney argues

[1] Serial No. 76280243, filed July 3, 2001, based on allegations of use since January 15, 1996, and use in commerce since April 15, 1996. In the application, applicant states that Emperor Norton does not identify a living individual.

[2] The material attached to applicant's reply brief is excluded to the extent it was not previously made of record. See Trademark Rule 2.142(d).

that consumers may refer to applicant's goods and services as simply "NORTON RECORDS." Concerning the goods, the Examining Attorney notes that applicant's musical sound recordings are substantially identical to registrant's phonograph records, audio cassettes and compact discs (CDs) featuring music. The Examining Attorney also contends that the same entity may offer sound recordings and render promotional and management services, as does applicant herein. It is the Examining Attorney's position that consumers may encounter the goods and services of applicant and registrant in the same marketplace.

> It appears reasonable to conclude that registrant's goods may be the subject matter of the applicant's services. Consumers are likely to perceive that the applicant's company manages or promotes artists and personalities associated with the registrant. The purchasing public may further believe that the applicant's services are an extension of the registrant's line of goods/services or vice versa.

Examining Attorney's brief, unnumbered page 3. The Examining Attorney has cited a number of cases involving goods and services where likelihood of confusion was found.

Applicant, on the other hand, contends that the marks are different in sound, appearance, meaning and commercial impression. Contrary to the Examining Attorney, applicant maintains that the dominant part of its mark is the first word "EMPEROR," which distinguishes its mark in sound and

appearance. Applicant also notes that "Norton" is a surname, and has submitted a listing of applications and registrations of marks containing this term. Applicant argues, therefore, that the registered mark is entitled to only weak trademark protection. Applicant also contends that the word "RECORDS" is "weak" and that the public is able to distinguish marks containing this term as well. Applicant has submitted a listing of third-party applications and registrations containing this word. Finally, applicant states that Emperor Norton was a well-known historical character and that, therefore, EMPEROR NORTON RECORDS is not likely to be confused with NORTON RECORDS.[3] Applicant contends that this case is analogous to such names as Arthur and King Arthur.

With respect to the goods and services, applicant admits that its goods are similar or related to registrant's goods. However, applicant maintains that registrant's records, cassettes and CDs are different from applicant's promotional, advertising agency and management

[3] According to various articles of record, a man named Joshua Abraham Norton was born in London in 1819. He came to San Francisco in 1849, opening a business selling supplies to gold miners. He later unsuccessfully tried to corner the rice market in San Francisco, but lost his money in so doing. In 1859 he proclaimed himself "Emperor" of the United States and thereafter issued various decrees and proclamations. He died penniless in 1880. There are a number of articles of record concerning Emperor Norton, and Internet evidence of record shows that there are a number of Web sites pertaining to Emperor Norton.

services. In this regard, applicant argues that its services are expensive and not impulsively purchased. The discriminating purchasers of applicant's services take more care in the purchasing decision and are not likely to be confused, according to applicant. Further, applicant contends that these services appeal to and are purchased by different customers than registrant's records, cassettes and CDs, and that applicant's services are offered to a different market.

Finally, applicant notes that it filed applications in 1996 to register the mark EMPEROR NORTON, before the filing of the application which matured into the cited registration. Applicant's marks were published and no oppositions were filed. However, these applications became abandoned when applicant failed to file statements of use. The registered mark was approved during the pendency of applicant's previous applications. Applicant states that not only did the previous Examining Attorneys not refuse registration, but also that the registrant did not oppose applicant's earlier applications.

In response, the Examining Attorney maintains that even weak marks are entitled to protection, and that even sophisticated purchasers are not immune from confusion. As to the allowance of registrant's mark over applicant's

prior then-pending applications, the Examining Attorney contends that prior decisions and actions of other Examining Attorneys are not binding on the USPTO, and that each case must be decided on its own merits.

The 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 Company, 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).

Turning first to the Class 9 goods in the application and registration—musical sound recordings versus phonograph records, audio cassettes and CDs featuring music—these goods are, for our purposes, identical. Applicant's goods are broadly described and may well include (and in fact do include) CDs featuring music. When marks are applied to legally identical goods, as is the

case here, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Turning then to a consideration of the involved marks, it is well settled that marks must be considered in their entireties because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master Manufacturing Co.,* 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). However, the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon a side-by-side comparison, but rather whether the marks, as they are used in connection with the registrant's and applicant's goods, so resemble one another as to be likely to cause confusion. Under actual marketing conditions, consumers do not necessarily have the opportunity to make side-by-side comparisons between marks. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The proper emphasis is therefore on the recollection of the average customer, and the correct legal test requires us to

consider the fallibility of human memory. The average purchaser normally retains a general rather than a specific impression of trademarks. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), affirmed in unpublished opinion, Appeal No. 92-1086 (Fed. Cir. June 5, 1992)(SILVER SPOON CAFÉ and SILVER SPOON BAR & GRILL for restaurant and bar services v. SPOONS, SPOONBURGER, SPOONS with cactus design, and SPOONS within a diamond logo design); and *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981).

Although the marks EMPEROR NORTON RECORDS and NORTON RECORDS are different in sound and appearance to the extent that applicant's mark contains the additional word "EMPEROR," applying the foregoing principles to this case, we believe that these marks are simply so similar that, as applied to identical, relatively inexpensive and casually purchased goods, confusion would be likely. That is to say, a consumer who had purchased a NORTON RECORDS CD and who at some later time sees applicant's EMPEROR NORTON RECORDS CD may believe that the same entity has produced both CDs. Even if the purchaser does realize that these marks are not the same, the purchaser may believe that the new EMPEROR NORTON RECORDS CD is a line of the NORTON RECORDS products.

However, we reach a different conclusion with respect to applicant's services in Class 35, identified as "promoting the goods and services of others through direct mail advertising and the distribution of printed and audio promotional materials in the field of sound recordings and musical performances; advertising agency services in the field of sound recordings and musical performances of entertainment personalities; management of musical performers."

First, we realize that it is not necessary that the respective goods and services be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. Rather, it is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Here, however, we agree with applicant that its promotional services, its advertising agency services and its management services of musical performers

would be offered to rather sophisticated purchasers who are seeking to have their musical recordings or musical performances promoted or advertised, or who are seeking a management agency for themselves. In other words, contrary to records, cassettes and CDs, which would be purchased by the general public, these promotional, advertising agency and management services would be offered to a different class of purchaser, who would be more likely to spend some time and effort in the selection of a company to promote his or her (or its) musical recordings and/or performances, or to manage his or her (or its) musical group. These relatively sophisticated purchasers are in a different class from the ordinary consumers who may buy relatively inexpensive CDs in a music store.

Accordingly, while we find that confusion is likely with respect to the Class 9 goods, we find that confusion with respect to applicant's EMPEROR NORTON RECORDS promotional, advertising agency and management services is not likely as a result of the use and registration of the mark NORTON RECORDS for records, audio cassettes and CDs.

Decision: The refusal to register applicant's mark for its goods in Class 9 is affirmed. The refusal to register applicant's mark for its services in Class 35 is

reversed, and the mark will be published for opposition as to the services in Class 35.