

7/6/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 9
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Del Rey Music, Inc.**

Serial No. 75/**634,957**

Michael K. Grace, Gregory J. Sater and Jill M. Abasto of **Grace & Sater, LLP** for **Del Rey Music, Inc.**

Melissa Shella, Trademark Examining Attorney, Law Office 112
(**Janice O'Lear**, Managing Attorney).

Before **Hohein, Bottorff** and **Holtzman**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Del Rey Music, Inc. has filed an application to register the mark "GRAVITY MUSIC LIBRARY" as a trademark for "musical sound recordings" in International Class 9 and as a service mark for "music composition and adaptation for others" in International Class 41.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods and services, so

¹ Ser. No. 75/634,957, filed on February 5, 1999, which is based on an allegation of a bona fide intention to use the mark in commerce. The words "MUSIC LIBRARY" are disclaimed.

resembles the mark "GRAVITY," which is registered for "prerecorded phonograph records, audio cassettes, compact discs, [and] video cassettes, all featuring musical entertainment" in International Class 9 and "entertainment in the nature of a musical performance" in International Class 41,² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³

Turning first to consideration of the respective goods and services, applicant argues, based upon the declaration of record of its general manager, Cindy Rosmann, that unlike registrant's goods and services, which applicant asserts are

² Reg. No. 1,902,431, issued on July 4, 1995, which for the goods and services sets forth in each instance a date of first use anywhere of June 13, 1991 and a date of first use in commerce of April 18, 1992; combined affidavit §§8 and 15.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

targeted to retail consumers, its goods and services are directed exclusively to purchasers of custom background music for audio/video and commercial advertisers. Specifically, as stated in the Rosmann declaration:

Del Rey provides background music for use in films, video and audio productions such as radio and television commercial advertising. Del Rey is not providing any goods in the entertainment market for purchase by the average consumer. Del Rey's goods are not sold at retail but rather to sophisticated members of the trade.

However, as the Examining Attorney correctly points out, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods and/or services as they are set forth in the involved application and cited registration. See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the goods and/or services in the application at issue and in the cited registration are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods and/or services of the nature and type described therein, but that the identified goods and/or services move in all channels of trade which would be normal therefor and

essential characteristics of the goods and [services, and] differences

that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Applying the above principles, it is clear from the broad manner in which the respective goods are identified that applicant's musical sound recordings encompass, and hence are identical to, registrant's prerecorded phonograph records, audio cassettes and compact discs, all of which feature musical entertainment. It is also clear that applicant's goods are closely related to registrant's video cassettes since, like applicant's musical sound recordings, registrant's video cassettes feature musical entertainment. Consequently, because the respective goods are identical in part and are otherwise closely related, they must be regarded as suitable for sale through the same channels of trade, including retail music and video stores, to the identical classes of purchasers, including ordinary consumers. The marketing of such goods under the same or similar marks would therefore be likely to cause confusion concerning the source or sponsorship thereof.

As to the respective services, the Examining Attorney also correctly notes that it is well established that goods and/or services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and/or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give

in the marks."

rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, the Examining Attorney maintains that the respective services are closely related, arguing that:

The registrant's services are "entertainment in the nature of a musical performance." It is common for musical performers to compose and adapt music for their own performances. It is also common for musical performers to employ those same skills to compose and adapt music for others. Furthermore, it may be readily anticipated that one who offers "entertainment in the nature of a musical performance" and who offers musical entertainment recorded on "phonograph records, audio cassettes, compact discs, [and] video cassettes," would also offer musical sound recordings in all available formats and offer those same goods and services to customers similar to those claimed by applicant. Musical performers, such as the registrant, are commonly hired to record music to be used in films, movies, videos and commercials. As a result, it is clear that the applicant's ... services not only overlap the registrant's, but are also within the registrant's normal field of expansion.

Applicant, we observe, has not filed a reply brief or otherwise taken issue with the Examining Attorney's argument. It seems reasonable to us, moreover, that for the reasons indicated by the Examining Attorney, applicant's music composition and adaptation services for others are the kinds of services which persons in the market therefore could expect to be available as an adjunct

or related service from those, such as registrant, who also render musical entertainment performances. Musical entertainers often compose their own songs and/or tunes and adapt them to their particular performances. Such skills similarly lend themselves to composing and adapting music for others for use in films, videos and audio productions, including the background music in radio and television commercials. The contemporaneous use of the same or similar marks in connection with such closely related services would, therefore, be likely to cause confusion as to the origin or affiliation thereof.

Turning, then, to consideration of the respective marks, applicant urges that there are "differences in the total look and feel" of its mark and registrant's "GRAVITY" mark. Applicant also contends that the mere fact that two marks share the same term, in this case the word "GRAVITY," does not necessarily mean that the marks in their entireties engender a similar commercial impression. In particular, applicant urges that the presence of the additional phrase "MUSIC LIBRARY" in its "GRAVITY MUSIC LIBRARY" mark "is significant because it lends a different commercial impression to the [m]ark, namely, that Applicant maintains a library of sounds and music, in this case for commercial use." Applicant consequently concludes that there is no likelihood of confusion.

We agree with the Examining Attorney, however, that "[t]he addition of the term, MUSIC LIBRARY, to the registered mark, GRAVITY, is not sufficient to avoid a likelihood of confusion because it constitutes the mere addition of a

descriptive term to the applicant's mark." Overall, the respective marks are substantially similar in sound, appearance and connotation due to the presence of the term "GRAVITY" in each mark. In particular, as the Examining Attorney properly observes, the dominant and distinguishing portion of applicant's "GRAVITY MUSIC LIBRARY" mark, when considered in its entirety, is the word "GRAVITY," which is not only identical to registrant's mark but, in relation to the respective goods and services, clearly appears to be an arbitrary term which correspondingly entitles registrant to a broad scope of protection for its mark. We note, in this regard, that while marks must be considered in their entireties, including any descriptive matter, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id.

Citing The American Heritage Dictionary of the English Language (4th ed. 2000) at 1009, which defines the word "library" as, inter alia, "4. A collection of recorded data or tapes arranged for ease of use. 5. A set of things similar to a

library in appearance, function, or organization: *a library of computer programs*,"⁴ the Examining Attorney persuasively points out that the phrase "MUSIC LIBRARY" in applicant's mark merely describes applicant's musical sound recordings and its services of music composition and adaptation for others since, as broadly identified in the application, such goods and services "may feature a collection of recorded musical tapes arranged for ease of use" and hence may be said to constitute a music library. Furthermore, as the Examining Attorney points out, "applicant has disclaimed the wording MUSIC LIBRARY, and does not deny that it is descriptive of the applicant's goods and services. Most importantly, we concur with the Examining Attorney that "[t]his additional descriptive matter does not change the connotation of the mark GRAVITY [MUSIC LIBRARY], but rather merely adds informational matter to the mark. The overall commercial impression projected by such mark is substantially identical to that engendered by registrant's "GRAVITY" mark. Contemporaneous use of the marks at issue is therefore likely to cause confusion as to the source or affiliation of the respective goods and services.

Applicant further contends, however, that confusion is not likely because, as mentioned earlier, purchasers of its goods

⁴ The request by the Examining Attorney in his brief that we take judicial notice of such definition is approved inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. *See, e.g.,* Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

and services "are sophisticated members of a trade who are likely to exercise special care and consideration in selecting Applicant's product." Applicant's argument ignores the fact that its musical sound recordings, as noted previously, encompass such goods as phonograph records, audio cassettes and compact discs and that such products would thus be marketed and sold primarily to ordinary consumers rather than to sophisticated purchasers. Moreover, even assuming, in the case of applicant's music composition and adaptation services for others, that such services would be rendered, as applicant argues, mainly to a knowledgeable and discriminating clientele of "Hollywood producers of films, videos, and commercial advertising" and would be utilized to provide "specialized background music and sound effects," the fact that customers may exercise care or thought in choosing the services "does not necessarily preclude their mistaking one trademark [or service mark] for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Here, due to the shared presence of the arbitrary and dominant term "GRAVITY" in the respective marks, the overall commercial impression engendered by applicant's "GRAVITY MUSIC LIBRARY" mark is so similar to that projected by registrant's "GRAVITY" mark that the contemporaneous use thereof in conjunction with music composition and adaptation services for others, on the one hand, and such closely related

services as entertainment in the nature of musical performances, on the other, is likely to cause confusion, even among sophisticated members of the musical entertainment and production trade.

As a final contention, applicant asserts that the respective marks "have been in use concurrently for almost three years with no record of any case of actual confusion."⁵ It is noted, however, that the supporting declaration of Cindy Rosmann, which is dated January 27, 2000, evidences only a period of about two years of contemporaneous use of the respective goods without any incidents of actual confusion and is silent as to applicant's experience, if any, concerning use of the marks at issue in

⁵ Applicant additionally discusses two other *du Pont* factors, contending that because "[t]here is no evidence in the record that the Cited Registration is [for] a famous mark," such factor "weighs against any likelihood of confusion" and that, as to what applicant characterizes as "The Strength of the Mark," the "large number of marks containing the word 'Gravity' in Classes 9 and 41 for a variety of goods and services ... suggests that consumers are able to distinguish between different uses of 'Gravity' for different products, even in related fields," and thus such factor "favors registration here." As to the former, the record simply does not contain any evidence as to whether registrant's mark is famous. Likewise, with respect to the latter, there is no evidence and the Board does not take judicial notice of third-party registrations. See, e.g., *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Moreover, even if applicant had supported its argument with copies of the various third-party registrations upon which it purports to rely, such would not in any event constitute proof of actual use of the registered marks and that the purchasing public, having become conditioned to encountering certain products and service under marks which consist of or include the word "GRAVITY," is therefore able to distinguish the source thereof based upon differences in such marks. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). Accordingly, neither the fame of the cited prior mark nor the number and nature of similar marks in use on similar goods and/or services is a relevant *du Pont* factor in this appeal.

connection with the respective services. In particular, Ms. Rosmann states that:

Del Rey has used the Mark in commerce since at least as early as February, 1998. To my knowledge, there have been no instances of confusion as to the source of the goods bearing GRAVITY MUSIC LIBRARY™ and the goods of Registrant bearing the registered mark.

While the absence of any instances of actual confusion over a significant period of time is indeed a *du Pont* factor which is indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by registrant under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Consequently, the absence of any instances of actual confusion is not a mitigating factor where, as here, the record is devoid of information concerning details of the nature and extent of the sales and marketing activities of applicant and registrant under their respective marks; the asserted period of contemporaneous use thereof has been exceedingly short; and, in the case of the respective goods, the products involved do not appear to be very expensive, such that any incidents of actual confusion would be expected to be reported by consumers and thus would have come to the attention

of applicant and/or registrant. Compare In re General Motors Corp., 23 USPQ2d 1465, 1470-71 (TTAB 1992).

We accordingly conclude that purchasers and prospective customers, familiar with registrant's "GRAVITY" mark for prerecorded phonograph records, audio cassettes, compact discs and video cassettes featuring musical entertainment and for entertainment in the nature of a musical performance, could reasonably believe, upon encountering applicant's substantially similar "GRAVITY MUSIC LIBRARY" mark for musical sound recordings and for music composition and adaptation services for others, that such legally identical and otherwise closely related goods and such commercially related services emanate from, or are otherwise sponsored by or affiliated with, the same source.⁶ For instance, as the Examining Attorney stresses in his brief, even among purchasers and potential customers who happen to notice the descriptive phrase "MUSIC LIBRARY" in applicant's mark, it is still likely that to those acquainted with registrant's mark, such phrase "will be perceived as referring to either the entire collection of the registrant's goods or to a special category, special edition, or special collection of the registrant's goods, or to a division of the registrant's operations."

⁶ Although applicant has suggested, in the alternative to a finding of likelihood of confusion, that it "should be given an opportunity to amend the application to narrow the scope of [its] goods and services," such piecemeal prosecution at this late stage is not warranted. Applicant had ample opportunity to amend the identification of its goods and services prior to filing its notice of appeal and, as noted by the Examining Attorney, it has not even suggested any modifications which would avoid the fact that registrant's goods and services would still encompass any limited channels of trade which applicant might seek to add so as to restrict its goods and services.

Ser. No. 75/634,957

Decision: The refusal under Section 2(d) is affirmed.