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Paper No. 33
Bottorff

10/26/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Virgin Enterprises Limited

v.

David DeFeis

Opposition No. **108,967**
to application Serial No. 75/116,208
filed on **June 10, 1996**

James W. Dabney of **Pennie & Edmonds LLP** for **Virgin Enterprises Limited.**

John F. Vodopia of **Scully, Scott, Murphy & Presser** for **David DeFeis**

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

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

Applicant has filed an application by which he seeks registration on the Principal Register of the mark VIRGIN STEELE, in typed form, for goods and services identified in the application, as amended, as "a series of pre-recorded audio and video cassettes, compact disks and records, featuring music," in Class 9; "posters," in

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Class 16; "clothing, namely, t-shirts, hats, headbands, headwear," in Class 25; and "entertainment in the nature of a live musical group," in Class 41.¹ The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and includes an allegation of March 1982 as the date of first use of the mark anywhere and first use of the mark in commerce on or in connection with all of the identified goods and services.

Opposer has filed a timely notice of opposition to registration of applicant's mark, alleging priority and likelihood of confusion under Section 2(d) as its ground of opposition. Specifically, opposer alleges prior use and registration of various VIRGIN marks for a variety of goods and services, including goods and services which are alleged to be identical or closely related to the goods and services identified in applicant's application, and that applicant's use of the mark VIRGIN STEELE on or in connection with the identified goods and services is likely to cause confusion, to cause mistake, or to deceive.²

¹ Serial No. 75/116,208, filed June 10, 1996.

² As will be discussed more fully, *infra* at pp. 20-21, opposer, for the first time in its briefs, argues that its pleading should be deemed to be amended pursuant to Fed. R. Civ. P. 15(b) to include, as an additional ground of opposition, a claim that applicant's allegation in the original application of use of the

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Applicant has filed an answer by which he denies the allegations of the notice of opposition which are essential to opposer's Section 2(d) claim.

Opposer submitted the following evidence: various documents, including status and title copies of its registrations, submitted under notices of reliance filed during its main testimony period and its rebuttal testimony period; transcripts of the testimony depositions of its witnesses David Steel, Lori Levin-Hyams, and Catherine Clayton, with exhibits; and the transcript of the testimony deposition of applicant David DeFeis as an adverse witness, taken by opposer during its main testimony period. Applicant submitted the following evidence: the transcript of the (second) testimony

mark on "headgear" and its allegation in the amended application of use of the mark on "hats, headbands and headwear" were false and fraudulent, and that the application therefore is void ab initio in its entirety. Opposer did not file a separate Rule 15(b) motion requesting such amendment of its pleading prior to or with its main brief on the case. Applicant, in his brief, argues that opposer's fraud claim is unpleaded and untimely, and that it is unfounded as well. Applicant further asserts that if opposer files a Rule 15(b) motion to amend the notice of opposition, applicant also will move to amend his answer to add counterclaims for cancellation of certain of opposer's registrations on the ground that opposer is no longer the owner of those marks or has abandoned those marks by naked licensing. Opposer, in its reply brief, asserts that it has not and will not file a separate Rule 15(b) motion because such a motion is not a prerequisite to the amendment of its pleading under Rule 15(b). Subsequently, applicant did not file any counterclaims.

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deposition of applicant David DeFeis taken by applicant during its case in chief, with exhibits; and various documents submitted under notice of reliance.

Opposer and applicant filed main briefs, and opposer filed a reply brief. No oral hearing was requested. In reaching its decision herein, the Board has carefully considered all of the evidence and arguments offered by the parties, including any evidence or arguments not specifically mentioned in this opinion.

As discussed below, opposer has proven its ownership of registrations of various VIRGIN marks for goods and/or services which are identical and/or related to applicant's identified goods and services, as well as its prior use of VIRGIN as a trade name. In view thereof, we find that opposer has established its real interest in the outcome of this proceeding and a reasonable basis for its belief that it will be damaged by issuance of a registration to applicant, and that it thus has established its standing to oppose. See Trademark Act Section 13; **Ritchie v. Simpson**, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); **Jewelers Vigilance Committee Inc.**

v. **Ullenberg Corp.**, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).³

As noted above, Trademark Act Section 2(d) is the statutory ground of opposition opposer pleaded in the notice of opposition. Section 2(d) provides, in relevant part, that registration of an applicant's mark must be refused if it:

Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Opposer has made of record, by notice of reliance, status and title copies of eleven registrations of various VIRGIN marks, each of which are shown to be subsisting and owned by opposer.⁴ Those registrations are as follows:

³ For the reasons discussed *infra* with regard to Section 2(d) priority, applicant's attacks on the validity of opposer's registrations (based on applicant's asserted priority of use vis-à-vis certain of the registrations and on opposer's alleged abandonment and/or non-ownership of the mark in connection with music-related goods) will not be heard inasmuch as applicant has not asserted any counterclaims against those registrations. Trademark Rule 2.106(b). Opposer's registrations accordingly will be given full effect, and they constitute evidence of opposer's standing.

⁴ In its brief, opposer also refers to an additional registration, Reg. No. 2,237,092. However, opposer has not made

Registration No. 1,039,574, issued May 18, 1976, of the mark VIRGIN in stylized form as depicted below

for "sound records in the form of discs and tapes and cassettes for use therewith" in Class 9. Affidavits under Section 8 and 15 filed and acknowledged; renewed under Section 9 for a term of ten years from May 18, 1996;

Registration No. 1,413,664, issued October 14, 1986, of the mark VIRGIN, in typed form, for "air travel services" in Class 39. Affidavits under Section 8 and 15 filed and acknowledged;

Registration No. 1,469,618, issued December 22, 1987, of the mark VIRGIN, in typed form, for "prerecorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records; photographic and cinematographic films" in Class 9. Affidavits under Section 8 and 15 filed and acknowledged;

Registration No. 1,517,801, issued December 27, 1988, of the mark VIRGIN in stylized form as depicted below

for "prerecorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records; photographic and cinematographic films" in Class 9. Affidavits under Section 8 and 15 filed and acknowledged;

that registration of record, and we have given it no consideration.

Registration No. 1,591,952, issued April 17, 1990, of the mark VIRGIN in the same stylized form depicted in Reg. No. 1,517,801 (immediately above), for "printed sheet music; fictional and non-fictional books, biography and autobiography books, periodicals, namely, paperback books and magazines, all dealing with music, films and entertainment; paper for packaging, paper cases; writing instruments, namely, pens, pencils, ball point pens, and crayons; stationery and office supplies, namely, writing and note paper; playing cards," all in Class 16; and "articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts," in Class 25. Affidavits under Sections 8 and 15 accepted and acknowledged;

Registration No. 1,597,386, issued May 22, 1990, of the mark VIRGIN, in typed form, for "printed sheet music; mounted photographs; posters; fictional and non-fictional books, biography and autobiography books, periodicals, namely, pamphlets, brochures, newsletters, journals, paperback books and magazines, all dealing with music, films and entertainment; paper for packaging, paper cases; stationery and office supplies, namely, writing and note paper, tags for index cards; paper tableware, namely, table mats, coasters, decanter mats, dish mats, table napkins; and playing cards," all in Class 16; and "articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts," in Class 25. Affidavits under Sections 8 and 15 accepted and acknowledged;

Registration No. 1,851,817, issued August 30, 1994, of the mark VIRGIN, in typed form, for "direct mail advertising for others; dissemination of advertising materials for others; preparing advertising, promotions, and public relations materials for others; management of promotional and incentive plans and services for others; business organization promotional consulting for others; demonstration of the goods and services of others and the promotion thereof; promoting and advertising the goods and services of others by aircraft, airships and air balloons; outdoor advertising such as by billboards;

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and distribution of advertising, promotional materials and sample materials of others," in Class 35; "transportation of goods and passengers by road, rail, air and sea; freight transportation services; tourist agency services; travel agency services; arranging travel tours; and transportation reservation services," in Class 39; Clubs, nightclubs; bars; hotels; resorts; hotel reservation services; hotel and resort management for others; carry-out restaurant and restaurant services; catering; computer programming for others; computer software design services for others; artwork and graphic design services for others; and retail store services in the fields of cosmetics and laundry preparations, metal hardware, cameras, records, audio and video tapes, audio and video recorders, computers and electronic apparatus, jewelry, clocks and watches, musical instruments, stationery, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, lace, embroidery, gifts and sewing materials, toys, games, video game machines and video game cartridges, processed foods, jellies and jams, coffee, tea, bakery items and candy, beer, ale, mineral and aerated waters and other non-alcoholic drinks, wines, spirits and liqueurs, and tobacco and smokers' articles," in Class 42;

Registration No. 1,852,776, issued September 6, 1994, of the mark VIRGIN in the stylized form depicted above in Registration No. 1,517,801, for the same services as those recited in Registration No. 1,851,817, immediately above;

Registration No. 1,863,353, issued November 15, 1994, of the mark VIRGIN MEGASTORE (MEGASTORE disclaimed), in typed form, for "retail department store services" in Class 42;

Registration No. 2,094,460, issued September 9, 1997, of the mark VIRGIN, in typed form, for "underwriting life, health and general insurance; administration of employee pension plans; annuity underwriting; estate trust management; funds investment; investment of funds for others; open and close-ended funds investment; financial analysis and

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consultation in the field of securities, personal equity and tax advantaged savings," in Class 36; and

Registration No. 2,151,589, of the mark VIRGIN VODKA (VODKA disclaimed), in typed form, for "vodka" in Class 33.

In view of opposer's ownership of these registrations, priority is not an issue in this proceeding. **King Candy Co., Inc. v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Contrary to applicant's contention, it is irrelevant that the dates of first use alleged by opposer in some of its registrations are subsequent to applicant's alleged date of first use of his mark. Section 2(d) provides that registration must be refused to a mark which is confusingly similar to "a mark registered in the Patent and Trademark Office, or a mark or trade name previously used..." (Emphasis added.) Because opposer has made its registrations of record, and because applicant has not asserted any counterclaims for cancellation of those registrations (such counterclaims being compulsory under Trademark Rule 2.106(b)(2)), actual priority of use is not an issue in this case. **King Candy**, *supra*.

Applicant also argues that opposer, having sold its Virgin Music Group to Thorn EMI in 1992, no longer uses the VIRGIN mark on music-related goods, including the

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music-related goods identified in several of the registrations made of record in this case, and that opposer accordingly is not the owner of the VIRGIN mark as to those goods and/or has abandoned the mark as to those goods by virtue of its naked licensing of the mark to Thorn EMI. To the extent that these arguments are an attack on the validity of those registrations and/or opposer's ownership thereof, such attack is a compulsory counterclaim which should have been pleaded with the original answer or pleaded promptly after the grounds therefor were learned, and it will not be heard in the absence of such counterclaim. See Trademark Rule 2.106(b)(2)(i) and (ii). No counterclaim having been asserted by applicant, the Board shall give applicant's arguments on these issues no consideration, and shall give full effect to opposer's registrations, which, according to the status and title copies opposer has made of record, are owned by opposer.

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 bearing on the likelihood of confusion issue. See **In re E.I. du Pont de Nemours and Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of

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record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to a comparison of the parties' goods and services, their trade channels and their customers. It is not necessary that the parties' respective goods and/or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective goods and/or services. See **In re Melville Corp.**, 18 USPQ2d 1386 (TTAB 1991); **In re International Telephone & Telegraph Corp.**, 197 USPQ 910 (TTAB 1978).

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In this case, the goods identified in applicant's application are legally identical and/or highly similar to the goods identified in one or more of opposer's VIRGIN registrations. That is, applicant's Class 9 goods, i.e., "a series of pre-recorded audio and video cassettes, compact disks and records, featuring music," are legally identical and/or highly similar to the "sound records in the form of discs and tapes and cassettes for use therewith" identified in opposer's Registration No. 1,039,574 and to the "pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records" identified in opposer's Registration Nos. 1,469,618 and 1,517,801. Applicant's Class 16 "posters" are legally identical to the "posters" identified in opposer's Registration No. 1,597,386. Applicant's Class 25 clothing items, "namely, t-shirts, hats, headbands, headwear" are legally identical and/or highly similar to the "shirts, t-shirts, sweat shirts, hats, clothing caps" identified in opposer's Registration Nos. 1,591,952 and 1,597,386. Each of applicant's goods also must be deemed to be related to the retail store services identified in opposer's VIRGIN Registration Nos. 1,851,817 and 1,852,776 and in opposer's VIRGIN MEGASTORE

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Registration No. 1,863,353, inasmuch as they are the types of goods which are sold in opposer's stores.

As for the services recited in applicant's application, i.e., "entertainment in the nature of a live musical group," we find that these services are related to the Class 9 audio and video recordings and discs identified in opposer's registrations as referenced above, as well as to the posters and clothing items identified in certain of opposer's other registrations. The relationship between such goods and applicant's entertainment services is evidenced by the fact that applicant itself offers such goods in conjunction with its entertainment services. We also find that applicant's services are related to various services identified in opposer's registrations. It is common knowledge, for example, that "nightclubs," which are among the services recited in opposer's Registration Nos. 1,851,817 and 1,852,776, often feature live performances by musical groups. Further, opposer's witness Ms. Levin-Hyams testified that opposer frequently sponsors and promotes live performances and other appearances by musical groups at its retail stores.

Thus, we find that applicant's goods and services are identical and closely related to certain of opposer's

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goods and services, as discussed above. Likewise, we find that the parties' identical and closely related goods and services move in the same trade channels and are marketed to the same classes of purchasers. There are no limitations as to trade channels or purchasers in applicant's identification of goods and services or in opposer's registrations. Accordingly, we presume that the parties' identical and closely related goods and services are marketed in all normal trade channels and to all normal classes of purchasers for such goods and services. See **In re Elbaum**, 211 USPQ 639 (TTAB 1981). Moreover, the evidence of record shows that both applicant's and opposer's records, discs and videos are sold at Tower Records, and through the same mail-order catalogs.

Finally, it appears that the goods involved herein are common consumer items which are relatively inexpensive. There is no evidence that the normal purchasers of these goods are especially sophisticated or careful in making their purchasing decisions.

We turn next to the issue of whether applicant's mark VIRGIN STEELE and opposer's VIRGIN mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and overall commercial impression.

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The test to be applied 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. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See **Sealed Air Corp. v. Scott Paper Co.**, 190 USPQ 106 (TTAB 1975).

Furthermore, because applicant's goods and services are closely related and in many respects legally identical to opposer's goods and services, the degree of similarity between the marks that is required to support a finding of likelihood of confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Our analysis of the parties' marks begins with our finding that opposer's VIRGIN mark is a strong mark which is entitled to a relatively broad latitude of protection.⁵

⁵ On this record, however, we cannot conclude that opposer's VIRGIN mark is "famous." The news articles (and the district court order) submitted and relied upon by opposer are insufficient to prove that opposer's mark is famous, in the absence of any direct evidence as to the dollar or unit volume of sales under the mark, or as to the amount of its advertising and promotional expenditures, or as to opposer's market share in

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VIRGIN is an arbitrary term as applied to opposer's goods and services. The record shows that opposer uses VIRGIN both as its trade name and as a house mark on an extremely wide variety of goods and services, and that opposer actively cross-promotes its VIRGIN mark among these various goods and services. There is no evidence of any use by third parties of VIRGIN marks on or in connection with the goods and services involved in this case or, indeed, in connection with any goods or services at all.⁶ The record also shows that opposer diligently polices its rights in the VIRGIN mark and name. Finally, we find that opposer's mark is especially strong in connection with music-related goods and services. The evidence of record establishes that the VIRGIN record label is a highly respected and well-known label, with a roster of famous artists which includes The Rolling

the relevant industries. See **Hard Rock Café Licensing Corp. v. Elsea**, 48 USPQ2d 1400, 1409 (TTAB 1998). Moreover, the district court's findings and conclusions in the context of opposer's lawsuit against a third party are not evidence in this case of the facts said to underlie such findings and conclusions, nor are they entitled to any legally preclusive effect as against applicant, who was not a party to that litigation.

⁶ The third-party registrations made of record by applicant (Exhibits 1-9 of applicant's Notice of Reliance) are not evidence that the marks depicted therein are in actual use, or that the public is accustomed to and capable of making source distinctions among various VIRGIN marks. See **AMF Incorporated v. American Leisure Products, Inc.**, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973).

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Stones, Janet Jackson, David Bowie, Tina Turner and Lenny Kravitz, among others.

Keeping the strength of opposer's mark in mind, we turn to a comparison of opposer's mark and applicant's mark. In terms of appearance and sound, we find that opposer's VIRGIN mark and applicant's VIRGIN STEELE mark obviously are identical to the extent that both marks use the arbitrary word VIRGIN, but are dissimilar to the extent that applicant's mark includes the word STEELE while opposer's mark does not. We are not persuaded by applicant's argument that the stylized lettering and form of certain of opposer's registered marks suffices to visually distinguish them from applicant's mark. We do not believe that opposer's mark is so highly stylized, in either Registration No. 1,039,574 or in Registration Nos. 1,517,801, 1,591,952 and 1,852,776 (see *supra* at footnote 4), as to negate or outweigh the commercial impression created by those marks' use of the term VIRGIN, per se. Moreover, we note that opposer owns registrations of its VIRGIN mark in typed form for the same goods and services covered by its registered stylized marks.

In terms of connotation, we find that the word VIRGIN, as it appears in both marks, carries its normal meaning, i.e., "free of impurity or stain: unsullied" or

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"fresh, unspoiled." Webster's Ninth New Collegiate Dictionary (1990) at 1317. In applicant's mark, the word VIRGIN modifies the word STEELE (or STEEL), whereas in opposer's mark it stands alone. Opposer argues that applicant's VIRGIN STEELE mark merely takes opposer's arbitrary VIRGIN mark and adds the "descriptive" word STEELE thereto.⁷ However, the record does not support opposer's argument that STEELE is a descriptive term as applied to "heavy metal" music such as applicant's. We find, instead, that it is suggestive of such music, at most, and that it cannot be discounted in our comparison of the marks.⁸

⁷ Neither party has argued that STEELE would be perceived as a surname due to the presence of the terminal letter "E." Rather, both parties have treated the word as a mere misspelling of the word STEEL. Based on this record, we do not disagree.

⁸ Opposer (at page 25 of its brief), in support of its argument that STEELE is "descriptive" of heavy metal music, cites to applicant's testimony at page 51 of applicant's August 30, 1999 testimony deposition:

Q. When you say this kind of music, what kind of music are you referring to?

A. It's a certain kind of heavy metal. A very specific kind of heavy metal.

Q. Is the word steel supposed to conjure up metal?

A. It's supposed to conjure up whatever you think. Sure. It's related to steel. Like Iron Maiden, Led Zeppelin. It's a combination of light things and things that are harder or heavier.

(DeFeis depo. (8/30/99) at 51.) We find that this testimony does not establish that STEELE or STEEL is descriptive of heavy metal music.

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Further with respect to the connotation of applicant's mark, and likewise with respect to the mark's overall commercial impression, we find that VIRGIN STEELE would most likely be perceived as a unitary composite term much like "virgin wool," "virgin forest" or "virgin birth." Applicant testified: "Also we play what is called metal music. It's like a sword, virgin metal, torching the fires of adversity, like Excalibur, that kind of thing. It's a gothic kind of music." (*Id.* at 118.) This testimony as to the meaning of VIRGIN STEELE is corroborated by the artwork appearing on applicant's recordings, posters and t-shirts, in which depictions of swords often figure prominently. (See, e.g., DeFeis depo. (2/10/99), Exhibits 3, 9, 10, 12-14, and 18.)

Applicant also testified that it is common for heavy metal rock bands like applicant's to take a name which combines opposite characteristics, such as light and heavy, or light and hard. Applicant cited as examples the bands named IRON MAIDEN, IRON BUTTERFLY, LED ZEPPELIN, and BLACK SABBATH. Applicant testified, persuasively, that the name VIRGIN STEELE creates the same sort of commercial impression when used in connection with applicant's band. (DeFeis depo.

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(8/30/99) at 51; DeFeis depo. (2/10/99), at 4-5 and 117-118.) Opposer's VIRGIN mark does not create this same detailed commercial impression.

In summary, when we compare applicant's and opposer's marks in their entireties as to appearance, sound and connotation, and as to their overall commercial impressions, we find that there certainly are dissimilarities between the marks which result from the presence of the word STEELE in applicant's mark and the absence of that word in opposer's mark. However, we find that those dissimilarities are insufficient to outweigh or negate the basic, underlying similarity between the marks which arises from both marks' use of the arbitrary term VIRGIN. Although we cannot discount the significance of the word STEELE in applicant's mark, as opposer would have us do, we likewise cannot discount the presence of the word VIRGIN in applicant's mark, as applicant would have us do.

As discussed above, opposer's VIRGIN mark is a strong mark which is entitled to a wide scope of protection vis-à-vis other marks. This is especially so where, as in this case, the other mark in question (applicant's mark) is being used on goods and services which are legally identical and/or closely related to

opposer's goods and services. See **Century 21 Real Estate Corp.**, *supra*. In these circumstances, and on this record, we find that applicant's mark is similar, rather than dissimilar, to opposer's mark, under the first **du Pont** evidentiary factor.

The only other **du Pont** factors argued by the parties relate to the issue of actual confusion. After careful consideration of the record, we find no evidence that actual confusion has occurred. The third-party advertisements for applicant's live shows which referred to applicant's band as "EMI recording artists," cited by opposer, do not prove actual confusion the part of the relevant purchasing public. Opposer argues (and opposer's witness Mr. Steel opined) that, because Virgin Records became a subsidiary of EMI in 1992 and because applicant's band's name is VIRGIN STEELE, the third parties responsible for the advertisements mistakenly believed that applicant's band was affiliated with, or under contract to, EMI. However, we find this argument (and Mr. Steel's testimony on this issue) to be highly tenuous and based on nothing but conjecture.⁹

⁹ There is no testimony from the third party advertisers as to why they believed that applicant was an EMI recording artist. It is likely that their quite specific references to applicant's band as "EMI recording artists" were based on specific erroneous

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However, we accord no significant weight to the absence of evidence of actual confusion in this case. The nature and extent of applicant's use of the mark in the United States is not particularly clear from the record. We cannot conclude that the opportunity for actual confusion has been so great that the absence of any evidence of actual confusion is significant. See **Gillette Canada Inc. v. Ranir Corp.**, 23 USPQ2d 1768 (TTAB 1992).

After careful consideration of all of the evidence of record relating to the **du Pont** likelihood of confusion factors, we conclude that a likelihood of confusion exists in this case. The strength of opposer's mark, combined with the legal identity between most of applicant's goods and services and those of opposer's, suffice to make confusion likely. Any doubts as to this conclusion which may have been raised by applicant's arguments or evidence must be resolved in favor of opposer, as the prior registrant. **In re Hyper Shoppes (Ohio) Inc.**, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); **In re Martin's Famous Pastry Shoppe, Inc.**, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

or mistaken information provided to or gathered by them, rather than on the attenuated chain of reasoning suggested by opposer.

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Opposer has requested that the notice of opposition be deemed to have been amended, under Fed. R. Civ. P. 15(b), to include the additional ground of fraud. We find, however, that this ground was not tried by the express or implied consent of the parties, and that, in view of applicant's objection to our consideration of the additional ground, the requested amendment is not warranted.

The issue of applicant's use of the mark on hats and other headwear, which appears to be the focus of opposer's proposed fraud claim, arose only twice during the course of applicant's lengthy depositions, and on those occasions only as part of an extended line of questioning regarding the history of applicant's band and the nature and extent of applicant's use of its mark on the identified goods and services. Such questioning was clearly relevant to opposer's pleaded Section 2(d) claim, e.g., to the issues of the nature of applicant's goods and the trade channels and customers for such goods, and we cannot conclude that applicant was fully apprised that the questioning also was intended to elicit evidence supporting the additional unpleaded ground of fraud. "The purpose of Rule 15(b) is to allow the pleadings to

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conform to issues actually tried, not to extend the pleadings to introduce issues inferentially suggested by incidental evidence in the record." **ABC Moving Company, Inc. v. Brown**, 218 USPQ 336, 339 (TTAB 1983). See also **Auburn Farms Inc. v. McKee Foods Corp.**, 51 USPQ2d 1439 at n.5 (TTAB 1999); **Devries v. NCC Corporation**, 227 USPQ 705 (TTAB 1985); **Color Key Corporation v. Color 1 Associates, Inc.**, 219 USPQ 936 (TTAB 1983).

Accordingly, opposer's request that the notice of opposition be deemed to be amended under Rule 15(b) to include a fraud claim is denied.

Decision: The opposition (based on Section 2(d)) is sustained.

G. D. Hohein

C. M. Bottorff

L. K. McLeod

Administrative Trademark Judges
Trademark Trial and Appeal Board