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**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 Hayashi

Serial No. 75/444,349

I. Morley Drucker and John M. Kim of Fulwider Patton Lee &
Utecht, LLP for Japan Music Agency Co., Ltd.

Raul F. Cordova, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Seeherman, Hohein and Rogers, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Yoshiki Hayashi, the assignee and president of the
original applicant, Japan Music Agency Co., Ltd., is currently
the owner of an application to register the mark "EXTASY RECORDS
INTERNATIONAL" for "a series of sound recordings, namely,
phonograph records, prerecorded compact discs, and videos
featuring music and entertainment."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 the goods listed in the

¹ Ser. No. 75/444,349, filed on March 4, 1998, which alleges a bona
fide intention to use the mark in commerce.

application, so resembles the mark "EAR X-TACY," which is registered in the format shown below

for "prerecorded cassette tapes, video tapes, compact discs, laser discs and records featuring music and entertainment and blank cassette tapes and blank video tapes and compact disc and cassette tape storage cases,"² as to be likely to cause confusion, mistake or deception.³

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

The 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,

² Reg. No. 1,717,667, issued on September 22, 1992, which sets forth dates of first use of August 1985; combined affidavit §§8 and 15 accepted. The word "EAR" is disclaimed.

³ While, in his initial Office Action, the Examining Attorney also imposed a requirement for a disclaimer, pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), of the words "RECORDS INTERNATIONAL," neither applicant nor the Examining Attorney made any further reference thereto until the Examining Attorney's appeal brief, in which it is stated in a footnote that "[a] disclaimer requirement was also issued and met by the applicant." It is noted, however, that the application does not contain a disclaimer of such words and we consider the requirement therefor to have been waived. Nevertheless, it obviously is still the case that the absence of a disclaimer would not preclude others engaged in the production and/or marketing of sound recordings from using the words "records" and/or "international" descriptively in connection with such goods.

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."⁴ Here, inasmuch as applicant's goods are identical in part to registrant's goods and are otherwise closely related thereto,⁵ the focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entirety. Moreover, as pointed out in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ... , the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

⁴ The court, in particular, pointed out that: "The 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."

⁵ Applicant, referring to a "Dunn [sic] and Bradstreet Identifier Report" which it has made of record, argues that registrant's mark "is, in fact, used as the name of a retail store located in Louisville, Kentucky which sells compact discs, audio tapes, and the like" and that it "thus appears" that registrant's mark "is a mark applied to CDs, etc., not as a producer of such goods, but as a retailer of such goods." Applicant's attempt, however, to characterize registrant's mark as a service mark for the retail sale of sound recordings rather than as a trademark for such goods ("i.e., as a record label for prerecorded records, tapes, CDs, etc.") is unavailing inasmuch as it is well settled that the issue of likelihood of confusion must be decided on the basis of the goods and/or services as respectively identified in the application and cited registration, regardless of what extrinsic evidence may reveal or suggest concerning the particular nature of the goods and/or services, their actual channels of trade, or the class of purchasers to which they are in fact directed and sold. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Therefore, notwithstanding that registrant may indeed be a retailer of sound recordings, instead of a producer

Turning, therefore, to consideration of the respective marks, applicant argues among other things that, when considered in their entirety, the marks are dissimilar in appearance, sound and commercial impression. In particular, applicant observes that the marks "are not identical in spelling and appearance" and that "the shared term between the marks is only phonetically similar ('X-tacy' and 'Extasy')." Consequently, applicant asserts that, "[a]lthough the examining attorney discounts the addition of the words 'Records' and 'International' in Applicant's mark as descriptive, these are two additional words which comprise seven syllables and serve to further differentiate Applicant's mark from the cited mark"

Applicant also contends that "[i]t is appropriate to compare the typefaces of the two marks," claiming that "the cited mark is displayed in a distinctive, stylized, format and thus presents an entirely different look than the three[-]word mark of applicant." Specifically, applicant points out that:

[T]he cited mark contains a large stylized "X" as the prefix of "X-tacy", which sets it apart from the "Extasy" contained within Applicant's mark. When considering this, along with the distinctive, stylized script of the cited mark in assessing likelihood of confusion, it is an inevitable conclusion that the two marks are not confusingly similar.

Furthermore, applicant maintains that due to the differences in spelling of the phonetically similar terms "X-TASY" and "EXTACY," the respective marks overall "are visually

thereof, its registration must be treated as covering a trademark for such goods.

quite different." Applicant therefore "submits that the phonetic similarity of one word in the respective multi-word composite marks will not lead to a likelihood of confusion, if the marks are assessed in their totality, especially given that wholesalers, retailers and consumers of sound recordings purchase recordings from catalogue sheets, advertisements, and promotional material and/or listening to the recordings, and thus see the marks in print rather than making the purchase via phone."

Lastly, applicant urges that the marks at issue "present different overall commercial impressions" due to their "vastly different meanings." Applicant, in this regard, insists that there is no likelihood of confusion because:

The cited mark, "Ear-X-Tacy" [sic] (stylized) is suggestive of something delightful to the ear and conveys a commercial impression of a delightful listening experience. (The dictionary definition of "ecstasy" is "rapturous delight"). The applicant's mark, EXTASY RECORDS INTERNATIONAL, emphasizes the international recording aspect of the mark, and the commercial impression conveyed is one of a conglomerate record label that represents numerous international recording artists.

The Examining Attorney, on the other hand, argues that when used in connection with identical goods, "[t]here is a likelihood of confusion between the applicant's and registrant's marks because the prominent portion of each [of] the marks are [sic] phonetically identical" and visually quite similar. Specifically, and citing a definition from The American Heritage Dictionary of the English Language (3rd ed. 1992) which lists the word "ecstasy" as meaning, inter alia, "1. Intense joy or

delight,"⁶ the Examining Attorney maintains that the prominent terms of the marks are "EXTASY" and "X-TACY," given the descriptiveness of the words "RECORDS INTERNATIONAL" in applicant's mark and the disclaimer of the word "EAR" in registrant's mark. According to the Examining Attorney, the terms "EXTASY" and "X-TACY" in the respective marks are "phonetically identical and graphically very similar" because (footnote omitted):

These two terms are misspellings of "ecstasy" and constitute arbitrary terms as used in relation to the goods. The meaning of each particular term in both instances is the same and this meaning is maintained after the addition of the descriptive and disclaimed terminology. Both marks identify their music product as providing "intense joy or delight." Each mark must be compared in [its] ... entirety to the other to sense the overall commercial impression of them, but [descriptive and] disclaimed terms help diagnosed [sic] what are the prominent portions of the marks. *In re [El] Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988).

We agree with the Examining Attorney that confusion is likely from the contemporaneous use of the respective marks in connection with such identical sound recordings as phonograph records, compact discs and video tapes. While both applicant and the Examining Attorney are indeed correct that the marks at issue must be compared in their entireties, it is nevertheless the

⁶ While the reference to such definition for the first time in the Examining Attorney's brief is untimely under Trademark Rule 2.142(d), we have nonetheless considered the evidence 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).

case, as 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.

Here, because of the obvious descriptiveness of the words "RECORDS INTERNATIONAL" in applicant's "EXTASY RECORDS INTERNATIONAL" mark and the descriptiveness, as evidenced by the disclaimer thereof, of the word "EAR" in registrant's "EAR X-TACY" mark, we concur with the Examining Attorney that, when considered in their entireties, the dominant and source-distinguishing portions of the respective marks are the terms "EXTASY" and "X-TACY," both of which are mere misspellings and hence are phonetic equivalents of the word "ECSTASY." As a result, and because the descriptive matter in applicant's and registrant's marks does not meaningfully change the readily perceived significance of either the terms "EXTASY" or "X-TACY" therein, the respective marks overall are substantially similar in connotation.

Nevertheless, we acknowledge that the marks at issue have differences in appearance. Although applicant is simply incorrect in asserting that the respective marks differ in their

typefaces, since a typed drawing of a mark, which is the format selected by applicant, encompasses any reasonable manner of graphical display of a mark, including in this instance the same stylized font utilized by registrant for its mark,⁷ it is still the case that, when viewed in their entireties, applicant's three-word mark looks different from registrant's two-word mark, particularly since the term "EXTASY" forms the first word of applicant's mark while the term "X-TACY" is the last word in registrant's mark. In addition, such terms are not only spelled differently, but registrant's mark contains a hyphen, which is absent from applicant's mark.

The differences in appearance, however, are considered to be outweighed by the substantial similarities, as discussed previously, in sound and connotation of the respective marks, especially since, contrary to applicant's assertions, marks identifying and distinguishing sound recordings are frequently advertised aurally, such as on the radio, rather than just in print media. It is therefore the case, particularly insofar as ordinary consumers are concerned, that they would be exposed to applicant's and registrant's marks by ear as well as by eye. Consequently, and since the respective marks, when considered in

⁷ In legal contemplation, a typed drawing of a mark does not limit the depiction thereof to any special form. See *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Instead, "[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the mark] could be depicted". *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). Here, we see no reason why applicant could not choose to present its entire mark in the same font as is used in the display of registrant's mark.

their entireties, convey substantially the same commercial impression of an intensely delightful or joyous listening experience, confusion as to the source or sponsorship of applicant's and registrant's sound recordings is likely to occur. Finally, to the extent that the differences in appearance between applicant's "EXTASY RECORDS INTERNATIONAL" mark and registrant's "EAR X-TACY" mark may nonetheless serve to raise any doubt as to our conclusion in this regard, we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) and In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Columbes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

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