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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gospel Music Association

Serial No. 76400500

Serial No. 76400501

Reber M. Boulton of Stokes Bartholomew Evans & Petree, P.A.
for Gospel Music Association.

Khanh M. Le, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Seeherman, Quinn and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The two applications involved herein were filed on
April 25, 2002, by Gospel Music Association (a Tennessee
corporation) to register on the Principal Register the
marks GMA and GMA and design (shown below),



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both for services amended to read "educational services, namely, conducting seminars, exhibitions, conferences and workshops in the field of gospel music; entertainment services, namely, organizing and conducting entertainment exhibitions in the nature of gospel music shows; [and] providing incentives to people to demonstrate excellence in the field of gospel music through the issuance of awards" in International Class 41. Application Serial No. 76400500 (for the mark GMA) is based on applicant's claimed date of first use and first use in commerce of 1964. Application Serial No. 76400501 (for the mark GMA and design) is based on applicant's claimed date of first use and first use in commerce of April 15, 2002.

The Examining Attorney has refused registration in each application under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark (GMA or GMA and design), when used in connection with applicant's identified services, would be likely to cause confusion, mistake or deception with the registered mark GMA for "arranging and conducting educational conferences and seminars" in International Class 41 and "association

services, namely, promoting the interests of members of the grocery manufacturers industry" in International Class 42.¹

When the refusal to register was made final, applicant appealed in each application. Applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing.

In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the appeals for purposes of final decision. Thus, we have issued this single opinion.

Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. 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 of the marks and the similarities of the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper

¹ Registration No. 2102786, issued October 7, 1997, to the Grocery Manufacturers of America, Inc.; Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use and first use in commerce for both classes of services is May 28, 1942.

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Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Based on the record before us, we find that confusion is likely.

Turning first to a consideration of the cited mark and each of applicant's marks, applicant acknowledges that its typed mark (GMA) is identical to the cited mark (GMA). This fact "weighs heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

While applicant's second mark includes not only the letters GMA, but also includes a design of a bird, a partial-crescent shape and a rectangle, nonetheless, the letters "GMA" would be the portion spoken by consumers in calling for the services, and must be considered the dominant part of the mark. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). The design element is not sufficient to distinguish the marks. Consumers are not likely to remember this design, or if they do, they will view it as a variation of the registered mark GMA. In fact, applicant apparently does use the GMA and design mark as a variation of its own GMA mark.

Applicant argues that the design in its second mark is that of a dove; and that because a dove is "associated with

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Christian symbolism and the Christian religion generally, applicant's mark suggests a connotation that is closely related to applicant and its gospel music services."

(Brief, p. 7.) However, there is no evidence of record that consumers would either perceive the bird design in applicant's mark to be a dove, or that they would relate a dove design with Christianity. Applicant has also pointed to its ownership of Registration Nos. 2680861 and 2695420 for the marks DOVE AWARDS and the design of a dove, both for, inter alia, an annual award program in the field of gospel music. However, the fact that applicant owns these registrations is not sufficient for us to find that consumers viewing its GMA and design mark would particularly note the dove portion of the design, or would otherwise associate the mark with applicant.

We find that the cited mark and applicant's GMA and design mark are highly similar in sound, appearance, connotation and commercial impression.

Turning next to a consideration of the respective services, it is well settled that services need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that

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they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, supra; *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the services as identified in the application with the services as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As the Court of Appeals for the Federal Circuit stated in *Octocom*, supra, 16 USPQ2d at 1787:

The authority is legion that the question of the registrability of an applicant's mark must be decided on the basis of the identification of goods [services] set forth in the application regardless of what the record may reveal as to the particular nature of applicant's goods [services], the particular channels of trade or the class of purchasers to which sales of the goods [services] are directed.

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And later the Court reiterated in *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000):

But filings before the Board are concerned with registrability and not use of a mark. Accordingly, the identification of goods/services statement in the registration, not the goods/services actually used by the registrant, frames the issue.

Applicant's services are identified as "educational services, namely, conducting seminars, exhibitions, conferences and workshops in the field of gospel music; entertainment services, namely, organizing and conducting entertainment exhibitions in the nature of gospel music shows; [and] providing incentives to people to demonstrate excellence in the field of gospel music through the issuance of awards." Registrant's services are identified as "arranging and conducting educational conferences and seminars" in International Class 41 and "association services, namely, promoting the interests of members of the grocery manufacturers industry" in International Class 42.

Although the Examining Attorney specifically refused registration on the basis of both of the classes of services (educational services and association services) in the cited registration, we find that the registrant's association services, being identified as relating to the grocery manufacturing industry, are different in nature,

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channels of trade and consumers from applicant's services, which are limited to the subject matter of gospel music.

Nevertheless, the International Class 41 services in the cited registration are identified as "arranging and conducting educational conferences and seminars." These services, as identified, encompass the more specific educational services in the field of gospel music offered by applicant. Even if registrant actually offers its educational services only with regard to topics of interest to the grocery manufacturing industry and/or only to people in the grocery manufacturing industry, as applicant argues, its identification of educational services is not so written.² The Board cannot read restrictions into the

² Applicant submitted evidence, including printouts of pages from registrant's website and applicant's website, photocopies of brochures from the respective educational seminars offered by registrant and applicant, and a printout from USPTO's Trademark Electronic Search System (TESS) of registrant's related Registration No. 2104792 for the mark GMA and design for, inter alia, "arranging and conducting educational conferences and seminars relating to the grocery products industry." The Examining Attorney argues that this extrinsic material constitutes a collateral attack on registrant's registration and is "impermissible" to narrow the scope of registrant's educational services. (Final Office action, unnumbered page 2, Brief, p. 1.) Applicant argues that registrant's educational services are so all inclusive as to be meaningless in attempting to ascertain whether the services relate to the same or disparate fields; and that extrinsic evidence is therefore allowed. (Brief, p. 10.) We disagree with applicant that the identification of services in question is unclear or ambiguous, thus compelling us to consider extrinsic evidence on registrant's services. Cf. *In re Trackmobile, Inc.*, 15 USPQ2d 1152 (TTAB 1998). Although we disagree with the Examining Attorney that evidence from the registrant's website and registrant's brochures

identification of services based on the cited registrant's name or because of a restricting phrase appearing in other classes of services in the same registration (or in the same class in registrant's separate registration).

Turning next to the duPont factor of trade channels, applicant contends that its services are advertised in gospel music industry-related magazines and through personal invitations to applicant's association events; and that registrant does not advertise its grocery association services in gospel music publications. Applicant further argues that "even if the trade channels were somewhat related," any initial confusion would be negated by a minimum of effort and the purchasers' determining they are looking at something related to the grocery manufacturing industry or to gospel music. (Brief, p. 15.) The problem with applicant's argument is that, once again, even though its services are restricted to the gospel music field, the cited registrant's are not restricted in any way as to trade channels or purchasers. Therefore, we must presume in this administrative proceeding that registrant's services are offered through all normal channels of trade

are not admissible evidence in an ex parte appeal based on a Section 2(a) refusal, such evidence is of very limited probative value on the issue of the relatedness of the services because we must consider the identification of services as written.

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to all well-to-do classes of purchasers for its general educational services of "arranging and conducting educational conferences and seminars" (which conferences and seminars, because they would encompass the subject matter of gospel music, would include as consumers those interested in gospel music). See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, supra.

Because applicant's and registrant's educational services are legally the same, we find that the channels of trade and the classes of purchasers are, at least in part, the same.

Applicant argues that the purchasers of both applicant's and registrant's services are sophisticated professionals in their respective industries (e.g., food manufacturers such as Chiquita Brands International, Inc., Coca-Cola Enterprises Inc. and Del Monte Foods for registrant; and music industry professionals such as songwriters, musicians, radio stations and music publishers for applicant); that membership in these associations is exclusive and decisions to join are made with care; and that the preparation for seminars and conferences is expensive and consequently requires advance planning for travel and selection of courses.

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Again, the consumers for registrant's services must be deemed to include consumers interested in educational programs related to gospel music, and they would thus be the same consumers for applicant's educational services. Further, there is no limitation in either applicant's or registrant's identified educational services as to the cost of these seminars, conferences, exhibitions or workshops. Thus, both identifications can encompass programs that have a minimal cost. Likewise, both applicant's and registrant's services, as identified, can be offered to the general public.

Even if we assume sophistication of the purchasers of the educational services, "even careful purchasers are not immune from source confusion." In re Total Quality Group, Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also, Wirecard Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); In re Decombe, 9 USPQ2d 1812 (TTAB 1980); and In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1987) ["While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products". That is, even sophisticated purchasers of

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the allegedly identical services are likely to believe that the services emanate from the same source, when offered under the involved identical and highly similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1547, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1990).

With regard to applicant's argument that there has been no actual confusion involving the mark GMA for the relevant services for several decades, that argument is not persuasive.³ It may well be that there has been no confusion because, as applicant has asserted, registrant's educational seminars, etc., have dealt with grocery marketing issues rather than gospel music. However, as we have stated, our determination of likelihood of confusion must be based on the services as identified in the *de jure* registration. The registrant's ownership of its registration gives it the exclusive right to use the registered mark in connection with the services specified

³ The officers/directors of applicant, Frank Breeden and John W. Styer, have filed declarations that there have been no reported instances of actual confusion between applicant's and registrant's GMA marks.

⁴ The declarations did not refer at all to applicant's GMA and design marks, which has claimed dates of first use and first use in commerce of April 15, 2002.

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in the certificate of registration. See Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b).

Applicant did have the option, if it wished to rely on the asserted differences in the actual services with which it and registrant use their marks, to obtain a consent agreement from the registrant. Written consent agreements are highly persuasive in Board proceedings. See *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993).

Also, Section 18 of the Trademark Act, 15 U.S.C. §1058, was amended in 1988 to deal with situations such as the one presented here. Applicant could have filed a petition to partially cancel the cited registration (i.e., request that the registration be amended to include appropriate restrictive language regarding the cited registrant's educational services), but applicant did not do so. See also, Section 14 of the Trademark Act, 15 U.S.C. § 1054.

In view of the fact that applicant's GMA mark is identical to, and applicant's GMA and bird design mark is highly similar to registrant's mark, and the services are legally identical, and therefore legally identical in channels of trade and purchasers, we find that applicant's mark for its identified services are likely to cause

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confusion with the mark in the cited registration, and specifically with the services identified in International Class 41.

Decision: The refusal to register under Section 2(d) is upheld (based on the International Class 41 services in the cited registration) in each application.