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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Big Bert Entertainment, LLC

Serial No. 78387062

Laura A. Kees of Lord, Bissell & Brook for Big Bert Entertainment, LLC.

Mark Rademacher, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Quinn, Taylor and Bergsman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Big Bert Entertainment, LLC filed an application to register the mark BIG BERT ENTERTAINMENT ("ENTERTAINMENT" disclaimed), in standard character form, for "CDs, DVDs, and audiocassettes featuring prerecorded music" (in International Class 9), and "record label services, namely audio and music production services; [and] music publishing services" (in International Class 41). The application, filed on March 18, 2004, is based on a bona fide intention to use the mark in commerce.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods and/or services, so resembles the previously registered mark BERT'S and design<sup>1</sup> for

conducting entertainment exhibitions in the nature of fashion shows, shooting of films, of video clips, television broadcasting, of commercials, advertisements and advertising spots; entertainment, namely, live music concerts; electronic publishing services, namely, publication of text and graphic works of others in books, video cassettes, compact discs, digital versatile discs, online, field of cooking (in International Class 41); and

arena services, namely providing facilities for sports, concerts, conventions and exhibitions; providing banquet and social function facilities for special occasions; restaurants; café and bar services; arranging temporary housing accommodations; making hotel reservations for others; consulting services in the field of film locations; [and] making hotel reservations for others (in International Class 43)<sup>2</sup>

as to be likely to cause confusion.

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<sup>1</sup> The image of the special form drawing cannot be adequately reproduced in this opinion. For purposes of our decision, it is sufficient to note that registrant's mark consists of the name "bert's" in green, lower case letters in a gray rectangular background.

<sup>2</sup> Registration No. 2969907, issued on July 19, 2005.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant argues the marks are different, the goods and services are distinguishable, consumers for record label services and music products are sophisticated, and the existence of third-party marks renders registrant's mark weak with a scope of protection that does not extend to applicant's mark. Applicant submitted excerpts from Wikipedia bearing on "nicknames" such as Big Ben and Big Apple.

The examining attorney maintains that the marks are similar with both marks dominated by the name "BERT." The examining attorney also contends that the goods and services are related and, in this connection, he introduced several use-based third-party registrations showing that a single entity has registered a single mark for the types of goods and services involved herein. As to trade channels and classes of purchasers, the examining attorney asserts that they are similar, and that relevant consumers exercise nothing more than ordinary care in their purchasing decisions.

Before turning to the merits of the likelihood of confusion issue, we direct our attention to two preliminary matters.

The first one involves applicant's collateral attack on the cited registration. In its June 7, 2006 response, applicant asserted that registrant was currently using its mark in connection with only restaurant, café and bar services, and not in connection with any of the other services listed in the registration. As pointed out by the examining attorney, however, this constitutes an impermissible collateral attack on the registration. TMEP § 1207.01(d)(iv) (5<sup>th</sup> ed. Sept. 2007). Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services listed in the certificate. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Accordingly, applicant's assertion will not be given any consideration.

The second matter involves an evidentiary point. In connection with its argument that there are numerous third-party registrations incorporating the term "BERT," applicant submitted a printout of various BERT registrations. The examining attorney promptly advised applicant in the final refusal that the third-party

registrations were not properly made of record. Applicant, in its appeal brief, made specific reference to several of the registered marks. In his appeal brief, the examining reiterated his objection to this evidence as being improperly submitted. The examining attorney went on to indicate that, even if this evidence were considered, it was not probative.

We sustain the examining attorney's objection. The mere listing of the registrations, whether by way of the TESS printout or the specific mention in the brief, is insufficient to make the registrations of record. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002). When the examining attorney advised applicant of this deficiency, applicant did not timely follow up with soft copies of the registrations. *In re JT Tobacconists*, 59 USPQ2d 1080, 1081 n.2 (TTAB 2001); and TBMP § 1208.02 (2d ed. rev. 2004). We hasten to add that in the case of the TESS printout, even if considered, it has no probative value since it does not show the goods or services for which the marks are registered. Accordingly, the listings of the registrations do not compel a different result in this case.<sup>3</sup>

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<sup>3</sup> As the examining attorney also has pointed out, third-party registrations are not evidence of use of the marks shown therein.

Our 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, 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).

We first turn to compare the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when

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Thus, they are not proof that consumers familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Even if we were to find, based on applicant's evidence, that registrant's mark is weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of a similar mark for closely related services. See *In re Farah Manufacturing Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.

With respect to comparing applicant's mark BIG BERT ENTERTAINMENT with registrant's mark BERT'S and design, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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 the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."]

Descriptive matter generally is subordinate to source-identifying portions of a mark. For example, in the past merely descriptive matter that is disclaimed has been accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1533-34; and *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) [Disclaimed matter

is often "less significant in creating the mark's commercial impression"]. In the present case, applicant has disclaimed the highly descriptive/generic term "ENTERTAINMENT." See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 224 USPQ at 752 ["Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'"]. Thus, we find that BIG BERT is the dominant portion of applicant's mark.

Although the dominant portion, BIG BERT, of applicant's mark is highly similar to registrant's mark BERT'S in sound, appearance, meaning and commercial impression, we must do more than just compare the individual components of the marks; it is necessary that we compare the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ["When comparing the similarity of marks, a disclaimed term...may be given little weight, but it may not be ignored"]. While we have considered the "ENTERTAINMENT" portion of applicant's mark, purchasers are likely to view this commonly understood and recognized term to describe the nature of applicant's services. As for

registrant's mark, although we have considered the background shading and stylization of BERT'S, it is the literal portion BERT'S that dominates the mark.

We find that the marks, when considered in their entirety, are similar in sound, appearance, meaning and commercial impression. Each of the marks serves to indicate that someone with the name "Bert" is the source of the goods and/or services.

The next issue is whether applicant's goods and services are related to registrant's services. It is not necessary that the respective goods and/or services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or 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 originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The examining attorney has submitted several third-party registrations to establish the relatedness of the involved goods and/or services. These use-based

registrations show that each entity adopted a single mark for the types of goods and/or services involved herein. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783; and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The registrations show that various entities, mostly entertainment groups, have registered the name of their groups for compact discs featuring prerecorded music, music publishing services, and live music concerts. This evidence supports the examining attorney's finding that the goods and/or services are commercially related.

The involved goods and some of the services travel in similar trade channels. Purchasers of the goods and some of the services (e.g., compact discs and live music concerts) would include ordinary consumers who would be expected to use nothing more than ordinary care in their purchases. Further, some of these purchases can be expected to be made on impulse. Other services (e.g., music production services and music publishing services) could be expected to be bought by purchasers who would be more thoughtful in their purchasing decisions.

Nevertheless, as often stated, even knowledgeable purchasers may not be sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Given the similarities between the marks and the commercial relatedness of the goods and/or services, even knowledgeable purchasers would be confused.

We conclude that the similarities between the marks and the commercial relatedness between the goods and/or services make it likely that confusion will occur among purchasers.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register is affirmed.