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January 8, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Solem and King III

Serial No. 78626205

Bryan E. Solem (pro se).

Richard F. White, Trademark Examining Attorney, Law Office  
109 (Dan Vavonese, Managing Attorney).

Before Holtzman, Zervas and Wellington, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On May 10, 2005, Bryan E. Solem and LeRoy King III,  
a partnership, filed an application under Trademark Act  
Section 1(b), 25 U.S.C. § 1051(b), for registration on the  
Principal Register the mark VOLUNTEER MUSE (in standard  
character form) for goods identified as "audio recording  
featuring music" in International Class 9. The application  
recites March 27, 2005 as applicant's dates of first use  
anywhere and first use in commerce.

The examining attorney has refused registration of applicant's mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark MUSE (in typed form) of Registration No. 2322679 (issued February 29, 2000)<sup>1</sup> for, "pre-recorded compact discs and audio cassette tapes featuring music," in International Class 9, that, as used on applicant's identified goods, applicant's mark is likely to cause confusion or mistake or to deceive.<sup>2</sup>

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs.

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

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<sup>1</sup> Section 8 affidavit accepted and Section 15 affidavit acknowledged.

<sup>2</sup> The registration also recites the following International Class 41 services; "entertainment, namely, live performances by a musical band." In his brief, the examining attorney states that registration has been refused on the basis of these entertainment services in addition to the International Class 9 goods. However, nowhere in his three Office actions did the examining attorney state that he was refusing registration in view of such services. Because the examining attorney has not given applicant any notice that he was refusing registration in view of the entertainment services, we do not give any such refusal further consideration. See TMEP § 704.04 ("The examining attorney's first Office action must be complete, so the applicant will be advised of all ... grounds for refusal[.] ... Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application.").

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, although not exclusive, 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the *du Pont* factors regarding the goods, trade channels and classes of purchasers. In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). Because both applicant's and registrant's goods are audio recordings which feature music, we find that applicant's and registrant's goods are legally identical. Further, because the goods are legally identical, they must be deemed to be sold in the same channels of trade and to the same classes of customers, which is the public at large.

Thus, these three *du Pont* factors favor a finding of likelihood of confusion.

Applicant has argued that its music "is rooted in the analysis and exposition of religious themes, specifically the Christian religion, thus significantly distinguishing the music from that of Muse, and thus appealing to a different audience from that of Muse." Brief at p. 2. However, there are no limitations to the type of music in registrant's or applicant's identifications of goods. As noted above, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods recited in applicant's application vis-à-vis the goods recited in registrant's registration. If there are no limitations in an identification of goods, we must presume that the "registration encompasses all goods of the nature and type described, [and] that the identified goods move in all channels of trade that would be normal for such goods." *Elbaum*, 211 USPQ at 640. See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the

particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). Thus, applicant's argument is not persuasive.

With respect to the conditions of purchase, applicant argues that "[t]oday's consumer of music exhibits sophisticated purchasing habits that mitigate possible confusion, aided in part by a marketplace that allows consumers to listen to free samples of music in retail stores and on the internet." Brief at pp. 1 - 2. We are not persuaded that the conditions of purchase are as applicant describes. First, even if free samples of music are available, the prospective purchaser is not required to listen to such free samples prior to making a purchase and indeed may not listen to them at all. Second, applicant, at p. 3 of its request for reconsideration, states that "[i]t seems reasonable to assert that the average consumer buys an audio recording because ... (3) it was recommended to them by someone ...". As to those who are purchasing based on a recommendation, there is no reason to assume based on the record before us that such purchasers would use anything but ordinary care in their purchasing decisions. Third, applicant acknowledges, also at p. 3 of its request for reconsideration, that some of its purchasers may buy

audio recordings on impulse. As to such purchasers, they cannot be said to "exhibit[] sophisticated purchasing habits." Fourth, it is well settled that the fact that consumers may exercise deliberation in choosing goods in a particular field or genre of music does not necessarily preclude their mistaking one 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 (CCPA 1962). See also, *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). In view thereof, and because we must consider those purchasers who are least sophisticated, we resolve the fourth *du Pont* factor against registrant.<sup>3</sup>

This brings us to the similarity of the marks as considered in their entirety. We keep in mind that when marks would appear on virtually identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real*

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<sup>3</sup> In support of its contention that purchasers of its goods are sophisticated, applicant relies in part on records of applicant's sales of individual songs at CDBaby.com, an online retailer of music. According to applicant, 82% of its sales are for one song on its CD "Melancholy High" and the remaining five songs consist of approximately 2% to 6% of sales. This evidence is of limited probative because applicant's identification of goods is not limited to online sales, or sales at locations where purchasers may purchase only one song from a collection of songs, and even CDBaby.com allows for the purchase of entire "albums" and not individual songs.

*Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Our focus is on whether the marks are similar in sound, appearance, meaning, 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). 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 the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The only difference in the wording of the marks is applicant's addition of VOLUNTEER to MUSE of registrant's mark. Nonetheless, applicant maintains that the marks taken as a whole are dissimilar because VOLUNTEER is the dominant portion of the mark due to its position as the initial term in the mark and because MUSE is a weak term.<sup>4</sup> In support of its contention that MUSE is a weak term, applicant has submitted its search results for "muse" on

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<sup>4</sup> Applicant has not disclaimed the term MUSE, although it has offered to do so at p. 9 of its request for reconsideration. In any event, a disclaimer of MUSE would not serve to avoid confusion. See *Cancer Care, Inc. v. American Family Life Assurance Company of Columbus*, 211 USPQ 1005 (TTAB 1981).

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CDBaby.com, which is a website where one may purchase musical recordings. Applicant located the following:

MUSE: flute music by Christopher Caliendo  
World music combined with Latin rhythms meets classical flute to create energetic and seductive melodies played by today's sexiest flute duo.

BLUE MUSE: will I be free  
Blue Muse is a female fronted rock band ...

MELISSA MAJEAU & THE MUSE: the time has come  
With elements of rock, folk, reggae, it's a real mélange.

CELTIC MUSE: VALERIE BLESSLEY & JENNIFER PRATT-WALTER: wind and wood: a sylvan dance  
Celtic Muse - Music to gentle the spirit and gladden the heart.

DARK MUSE: sounds from beyond the silver wheel  
An otherworldly journey that traverses the listener through isolated atmospheres and dimly lit corridors ... this is music for haunted spaces.

SCOOTER MUSE: saddell abbey  
"... a haunting and beautiful piece of music ... just wonderful..."

THE DORIAN MUSE: emily  
Mello contemporary music with a classical influence.

MEEKA MUSE: between you & me  
Soulful, Sultry, Sensual - Meeka's Story-Line Poetry delves into our lives and penetrates your soul.

PLANET MUSE: uncharted talents

An eclectic mix of 17 rock, pop, folk and country flavored, digitally mastered songs from a talented cadre of songwriters who got together through the Muse's Muse message boards.

LORETTA MUSE: raingarden

Poetic and beautifully performed, Loretta seamlessly integrates an adult contemporary pop style ...

THE ADODI MUSE: A GAY NEGRO ENSEMBLE: ain't got sense enuf to be 'shamed

Atlanta's only black gay male performance poets collective bring you an in-your-face collection of performance poetry, songs, revealing interview interludes and more ...

SHAY MUSE: shay muse

This lovely soul-o artist comes from the Boston area and delivers a unique blend of R&B/Soul with a twist of Hip-Hop and Jazz.

Applicant adds at pp. 8 - 9 of its request for reconsideration that "'muse' is commonly used by artists to convey to their audience that they are working within a tradition of inspiration, and that what they offer artistically is meant to inspire," relying on an entry for "muse" from wikipedia.org which provides that in Greek mythology, the Muses were "nine goddesses who embody the right evocation of myth, inspired through remembered and improvised song, traditional music and dances." We have

also located the following definition of "muse" of which we take judicial notice:<sup>5</sup>

- 1 *capitalized* : any of the nine sister goddesses in Greek mythology presiding over song and poetry and the arts and sciences
- 2: a source of inspiration; *especially* : a guiding genius
- 3: POET

Applicant concludes that "muse" is widely used in artistic fields, and should consequently be considered to be a weak term. Request for reconsideration at p. 9.<sup>6</sup>

We have carefully considered applicant's evidence and arguments, but do not find them sufficiently compelling so as to persuade us to resolve the *du Pont* factor regarding the similarity of the marks in applicant's favor. First, applicant has not submitted evidence showing the extent of consumers' exposure to the CDBaby.com website, and we cannot determine the same from what is in the record.

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<sup>5</sup> From Merriam-Webster's Online Dictionary. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>6</sup> Applicant's other evidence in support of its contention that "muse" is a weak term in connection with its goods has no probative value; the advertisement for a music industry conference MUSEXPO is a combination of "mus," ostensibly an abbreviation for "music" and "expo," not "muse expo"; and Muse Research's "Receptor" discussed in the article from "Electronic Musician" magazine is not sufficiently related to the goods at issue in this appeal.

Second, the record does not indicate the extent of consumers' familiarity with the artists whose names contain the term MUSE. Third, even if the CDBaby.com evidence along with the Wikipedia evidence and the dictionary definition show that "muse" is a suggestive term in connection with music, and does have some significance, on this record we do not find that it is so suggestive as to render VOLUNTEER as the dominant term in applicant's mark. VOLUNTEER still modifies MUSE in applicant's mark, identifying a type of MUSE. We therefore find the meaning and commercial impression of the marks to be similar, in that both refer to a muse. Further, as far as sound and appearance of the marks, while there are differences due to the addition of VOLUNTEER to MUSE, the differences are outweighed by the similarities created by the shared common term MUSE.

In view of the foregoing, and because we do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result, *see Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975), we find that the *du Pont* factor

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regarding the similarity of the marks favors a finding of a likelihood of confusion.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, we conclude that, when potential purchasers of applicant's "audio recording featuring music" and registrant's "pre recorded compact discs and audio cassette tapes featuring music" encounter the marks VOLUNTEER MUSE and MUSE, respectively, for these goods, they are likely to believe that the sources of these goods are in some way related or associated. As a result, there is a likelihood of confusion.

**DECISION:** The refusal to register the mark under Section 2(d) of the Trademark Act in view of Registration No. 2322679 is affirmed.