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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

BMG Special Products, Inc.
v.
David Anthony Jagosz

Opposition No. 91124387
to application Serial No. 78030406
filed on October 12, 2000

Mary L. Kevlin of Cowan, Liebowitz & Latman, P.C. for BMG
Special Products, Inc.

David Anthony Jagosz, pro se.

Before Cissel, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

BMG Special Products, Inc. (a Delaware corporation)
has opposed the application of David Anthony Jagosz (a
United States citizen) to register on the Principal
Register the mark YOU DA BUDDHA for the following goods and
services:

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sound recordings, namely, phonographic records, prerecorded tape cassettes, prerecorded compact discs & cartridges, prerecorded video cassettes and prerecorded optical discs, all featuring music performances; and music downloadable from a global communications network (International Class 9); and

entertainment services in the nature of live musical performances, and live performances downloadable or broadcast over a computer network, by a musical group and vocal artist(s); and fan club services. (International Class 41).¹

Opposer asserts as grounds for opposition that it is engaged in manufacturing and distributing musical and video sound recordings, and promoting musical artists, under various BUDDAH and BUDDHA marks; that since long prior to the filing date of applicant's involved application for the mark YOU DA BUDDHA, opposer has used its BUDDAH and BUDDHA marks in connection with the sale of musical sound and video recordings and the promotion of musical artists; that opposer owns five registrations, specifically, BUDDAH for "sound recordings, namely, phonograph records, pre-recorded audio tapes, pre-recorded audio cassettes and compact discs featuring words and music" in International Class 9,² BUDDAH

¹ Application Serial No. 78030406, filed October 12, 2000, based on applicant's assertion of "a bona fide intention to use or use through a related company" the mark in commerce.

² Registration No. 1771212, issued May 18, 1993, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

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RECORDS for "music recorded on compact discs, phonograph discs and audio tapes" in International Class 9,³ BUDDHA RECORDS for "musical sound recordings" in International Class 9 and "providing information regarding and performances of musical artists by means of a global computer information network" in International Class 41,⁴ and the two marks shown below



for "music recorded on compact discs, phonograph discs and audio tapes" in International Class 9,⁵ and



for, inter alia, "musical sound recordings and musical video recordings" in International Class 9 and "providing information regarding and performances of musical artists

³ Registration No. 1947891, issued January 16, 1996, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The term "records" is disclaimed.

⁴ Registration No. 2348329, issued May 9, 2000. The term "records" is disclaimed.

⁵ Registration No. 1855590, issued September 27, 1994, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The term "records" is disclaimed.

by means of a global computer information network" in International Class 41;⁶ and that applicant's mark, when used on or in connection with his goods and services, so resembles opposer's previously used and registered marks, as to be likely to cause confusion, mistake, or deception.

In his answer applicant denied the salient allegations of the notice of opposition.⁷

The record consists of the pleadings; the file of applicant's application; the testimony, with exhibits, of Alexander Miller, the head of BMG Heritage, a unit of BMG Music (opposer is also a unit of BMG Music);⁸ and opposer's notices of reliance on the following items: (1) applicant's responses to certain of opposer's first set of interrogatories; (2) photocopies of numerous (almost 200) printed publications; and (3) status and title copies of opposer's five pleaded registrations. Applicant did not offer any testimony or other evidence.⁹

⁶ Registration No. 2480432, issued August 21, 2001. The term "records" is disclaimed.

⁷ Applicant, who is pro se, "admitted" paragraphs 1, 3, 4, 6 and part of 2. However, in the narrative portion of his answer, applicant argued against opposer's position. In opposer's brief on the case (p. 2), it stated that "Applicant answered, denying the allegations." We assume that opposer construed applicant's overall answer as a general denial, and the Board will do likewise.

⁸ Applicant did not attend the Miller deposition and he did not cross-examine the witness.

⁹ Applicant attached Exhibits A-D to his answer to the notice of opposition. Also, with the cover letter to his answer, he

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Only opposer filed a brief on the case. Neither party requested an oral hearing.

BMG Special Products, Inc. primarily "creates opportunities for music in motion pictures and in television advertising in the areas known as synchronization and licensing." (Miller dep., p. 5.) Opposer first used its "BUDDAH" marks in 1967 in the music field for a variety of rock and roll, rhythm and blues, jazz and pop artists, such as Gladys Knight and the Pips and The Lovin' Spoonful. The selection of this mark "was an outgrowth of a production called Kama Sutra." (Miller dep., p. 6.) In August 1998, opposer began using the mark "BUDDHA" (in the conventional spelling) for its goods and services. The music products opposer has produced since 1998 cover a wide variety of music from pop to classical and from new age to country. The artists include Angela Bofill, Petula Clark, Patsy Cline, Perry Como, David Cassidy, Fifth Dimension, Benny Goodman, Woodie Guthrie,

included a printout from the USPTO's Trademark Electronic Search System (TESS) of a third-party registration which included the word "BUDDHA" therein. Applicant is advised that such exhibits to pleadings are not evidence of record. See Trademark Rule 2.122(c); and TBMP §704.05 (2d ed. June 2003). However, inasmuch as opposer submitted a notice of reliance on certain of applicant's answers to interrogatories "and the documents identified therein" (notice of reliance, p. 2), there is some minimal evidence (discussed later in this decision) of record relating to applicant.

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Daryl Hall and John Oates, Millie Jackson, Waylon Jennings, Eartha Kitt, Melissa Manchester, Melanie, Willie Nelson, Harry Nilsson, Dolly Parton, Ray Price, Lou Reed, Frank Sinatra, Dr. Seuss and Fats Waller. Opposer also produces collections of different artists, such as "The Long Road to Freedom: An Anthology of Black Music"; and opposer produces various series of CD collections, such as the "Entertainment Weekly Magazine" Greatest Hits with one volume for each year from 1965 to 1993. Each year's CD in the latter collection included top 40 hits involving all the major competing companies (Sony, Universal, EMI, and Warner). All of these various records, CDs and collections are sold under the "BUDDAH" or "BUDDHA" label.

Opposer advertises and promotes its goods and services in a variety of ways to both the trade or industry and to general consumers. Opposer advertises in "Billboard Magazine," "Parade Magazine," "Time" and on national radio (e.g., National Public Radio) and television programs (e.g., CNN, A&E, NBC). Opposer provides point of purchase displays in stores (e.g., blown up photographs, bin cards); in-store record signings by the artists; distributes posters and flyers at concerts; and promotes artist's tours and concerts. Opposer attends and exhibits at trade shows such as the National Association of Record Merchandisers.

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Also, opposer's Internet web site (which includes descriptions of opposer's releases, press clippings, mini reproductions of album artwork, etc.) is available to those in the industry and the general public.

Sales of opposer's goods and services under the BUDDAH/BUDDHA marks totaled approximately \$20 million from 1998 through the first half of 2002. During the time frame 1998 through 2001, opposer spent about \$2 million on advertising its involved marks.

According to the application file, applicant is an individual citizen living in California, and he averred a bona fide intention to use the mark YOU DA BUDDHA in commerce on and in connection with the sound recordings and entertainment services identified above. Applicant created the mark "to name a collection of original songs written by Applicant," and he received copyrights on the songs in 1999. Also, he made three promotional CDs between May 1999 and October 2001, which "were handed out to supportive friends and relatives and potential fans." (Applicant's answer to opposer's interrogatory No. 2(b).) In April and June 2001, applicant's musical group gave two live performances in the Los Angeles area. (Applicant's answer to opposer's interrogatory No. 3.) His expenditures have totaled around \$1500 (mostly for developing and creating

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his web site), and he has received no yearly revenue with the exception of a Chamber of Commerce "token" payment of \$100 for one of his group's two live performances.

(Applicant's answers to opposer's interrogatory Nos. 4 and 5.)

In view of opposer's ownership of valid and subsisting registrations for its various BUDDAH/BUDDHA marks, the issue of priority does not arise in this opposition proceeding.¹⁰ See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, at footnote 6 (CCPA 1972); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, the record establishes opposer's use of its marks prior to the filing date of applicant's application, October 12, 2000.

We turn now to consideration of the issue of likelihood of confusion. 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

¹⁰ For the benefit of applicant, who is proceeding without an attorney in this opposition, we point out that the Board is an administrative tribunal that determines only the right to register marks. See Section 17 of the Trademark Act, 15 U.S.C. §1067. See also, TBMP §102.01.

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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 Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Based on the record before us in this case, we find that confusion is likely.

Turning first to a consideration of the parties' respective goods and services, in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or services to be." *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d

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1813, 1815 (Fed. Cir. 1987). That is, the issue of likelihood of confusion must be determined in light of the goods or services as identified in the opposed application and the pleaded registration(s) and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods or services. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Applicant's identification of goods includes phonograph records, and prerecorded tape cassettes, compact discs, video cassettes, and optical discs, all featuring music performances; and opposer's registrations include phonograph records, and prerecorded audio tapes, audio cassettes and compact discs, all featuring words and music, as well as musical sound recordings and musical video recordings. We find that these items in the parties' respective goods are legally identical, and the remainder of the parties' identified goods are closely related.

Applicant's identification of services includes live musical performances and live performances downloadable or broadcast over a computer network by a musical group and vocal artist(s); and opposer's registrations include

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providing information regarding and performances of musical artists by means of a global computer network. We find that these specific respective services of the parties are also legally identical, specifically, in that both parties' services, as identified, include providing performances of musical artists over a computer network, and the remainder of the parties' services are related.

Inasmuch as there are no limitations on trade channels or purchasers in the identifications of goods and services in applicant's application or in opposer's registrations, the parties' respective goods and services must be considered to move in the same channels of trade, and would be offered to similar classes of purchasers. See *Octocom Systems v. Houston Computer Services*, supra; and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

"When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We turn next to consideration of the similarities or dissimilarities of the marks. Our primary reviewing Court has held that in articulating reasons for reaching a

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conclusion on the question 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 or portion of a mark. That is, one feature of a mark may have more significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, both applicant's and two of opposer's marks share the dominant term BUDDHA. Opposer's other three marks include the extremely similar term BUDDAH. While applicant has added the words "YOU DA" to the term "BUDDHA," it is generally accepted that when a composite mark incorporates the mark of another for closely related goods or services, the addition of other matter is generally insufficient to avoid a likelihood of confusion as to source. See *The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977). Thus, applicant's addition of the words "YOU DA" to his mark does not serve to distinguish these marks.

Moreover, the slight differences between applicant's mark YOU DA BUDDHA and each of opposer's various

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BUDDAH/BUDDHA marks may not be recalled by purchasers seeing the marks at separate times. The proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than specific impression of the many trademarks encountered; that is, a purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrision, Inc.*, 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992). Potential purchasers may mistakenly believe that applicant's mark is another revised version of opposer's marks, with both parties' marks serving to indicate origin in the same source.

Although the parties' marks are not identical, when considered in their entirety, we find the respective marks are similar in sound, appearance, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). Their contemporaneous use, on and in connection with the same goods and services, would be likely to cause confusion as to the source or sponsorship of such goods and services. See *Cunningham v. Laser Golf Corp.*, supra.

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Another du Pont factor we consider in this case is the fame of opposer's marks. "Fame of an opposer's mark or marks, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors.'" *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002), quoting *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). See also, *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Opposer has generated over \$20 million in sales from 1998 - 2002, and it spent over \$2 million on advertising, nationwide in scope, and including ads on television and in well-known general publications such as "Parade Magazine" and "Time." Opposer has used its BUDDAH marks since 1967, and its BUDDHA marks since August 1998. There is evidence of significant media publicity from 1992 - 2002 regarding opposer's BUDDAH/BUDDHA marks used in connection with music products and music entertainment services. (See opposer's notice of reliance on printed publications, which includes newspapers, entertainment publications, and business publications.)

Based on this record, we conclude that opposer has demonstrated its registered marks are famous, and are thus entitled to a broad scope of protection. The fame of

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opposer's marks increases the likelihood that consumers will believe that applicant's goods and services emanate from or are sponsored by the same source.

Accordingly, because of the similarity of the parties' marks, the fame of opposer's marks, the parties' identical goods and services, as identified, and the similarity of the trade channels and purchasers of the respective identified goods and services, we find that there is a likelihood that the purchasing public would be confused if applicant uses YOU DA BUDDHA as a mark for his goods and services.

Decision: The opposition is sustained and registration to applicant is refused.