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Mailed:
February 23, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Joe J. Alfaro, Jr.

v.

Guy A. Hoffmann

Opposition No. 91155188 to application Serial No. 78110344
filed on February 22, 2002

Richard A. Clegg of Seltzer Caplan McMahon Vitek for Joe J.
Alfaro, Jr.

Leonard H. Mandel for Guy A. Hoffmann.

Before Hairston, Zervas and Cataldo, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Applicant, Guy A. Hoffmann, seeks registration on the
Principal Register of the mark SUPERFREAKS FUNKY DISCO
REVUE¹ (in standard character form) for the following
services, as amended: "Entertainment services namely, live

¹ Application Serial No. 78110344, filed February 22, 2002, is
based on applicant's assertion of a bona fide intention to use
the mark in commerce on the identified services under Section
1(b) of the Trademark Act, 15 U.S.C. §1051(b).

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musical performances by a disco musical band" in International Class 41. Applicant has disclaimed the wording FUNKY DISCO REVUE.

Opposer Joe J. Alfaro, Jr. filed a timely notice of opposition to registration of applicant's mark. In opposer's amended notice of opposition, opposer pleaded that he has used the mark THE SUPERFREAKS in interstate commerce since at least as early as 1999 and continues to use the mark in connection with "entertainment services in the nature of live disco music from the '70s and '80s as performed by live musicians"; that applicant was dismissed from THE SUPERFREAKS band by opposer and then filed his intent-to-use application; and that applicant's mark, as applied to the services identified in the application, so resembles opposer's mark THE SUPERFREAKS as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant further pleads that "Applicant filed a false oath in its [sic] 'intent-to-use' application submitted to the USPTO and knowingly made willful, false material misrepresentations of fact in his application by filing an application to register a mark which it [sic] knew infringed on the superior rights of the Opposer. Applicant had an obligation to disclose the existence of the Opposer's band and rights in the mark." Notice of opposition ¶ 7.

Applicant answered the amended notice of opposition by denying the salient allegations thereof, and asserted an affirmative defense of unclean hands based on the alleged filing by opposer of an application for registration in the State of California for a service mark registration for THE SUPERFREAKS four days after applicant filed the present application.

Preliminary Matters

On February 25, 2006, opposer filed a notice of reliance, submitting the following: (i) applicant's answer to the original notice of opposition, which includes one exhibit, (ii) applicant's response to opposer's motion for summary judgment, (iii) applicant's answer to the amended notice of opposition, and (iv) printouts from www.socalrocks.com. Applicant's answer to the original notice of opposition and applicant's answer to the amended notice of opposition are already in evidence. Pleadings are automatically in evidence. However, the exhibit that accompanied applicant's answer to the original notice of opposition is not in evidence. With the exception of a current status and title copy, prepared by the Patent and Trademark Office, of a plaintiff's pleaded registration, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony,

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properly identified and introduced in evidence as exhibits. Thus, applicant's answers to the original notice of opposition and the amended notice of opposition are in evidence but the exhibit attached to the answer to the original notice of opposition is not in evidence. Trademark Rules 2.122(c) and (d), 37 C.F.R. §§ 2.122(c) and (d); TBMP §§ 317 and 704.05(a) (2d ed. rev. 2004).

Further, the notice of reliance procedure is not available for introducing applicant's response to the motion for summary judgment into evidence. The notice of reliance procedure does not extend to papers filed in the present proceeding. See Trademark Rule 2.122; 37 C.F.R. § 2.122. Thus, applicant's response to the motion for summary judgment is not in evidence. As for the printouts from www.socalrocks.com, it is well settled that Internet printouts are not self-authenticating and are "not proper subject matter for introduction by means of a notice or reliance under Trademark Rule 2.122(e)." *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999). See also *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1134 (TTAB 2000); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). Thus, the

www.socalrocks.com printouts submitted with opposer's notice of reliance are not in evidence.²

Additionally, opposer has sought to enter into evidence through his testimonial deposition a copy of an email purportedly sent by applicant to a part-time member of THE SUPERFREAKS band named Dave Gully. Opposer's Exhibit 11; Alfaro dep. p. 28. Opposer testified that Mr. Gully forwarded the email to opposer. *Id.* at p. 29. Applicant's attorney objected to this exhibit when opposer sought to introduce it during opposer's testimonial deposition, and renewed his objection in his main brief. We sustain applicant's objection to Exhibit 11 on the grounds of hearsay. There is no direct testimony that applicant indeed authored the email. We therefore do not further consider Exhibit 11.

The Record

The record consists of the pleadings; the file of the involved application; the trial testimony taken by opposer of (i) opposer, (ii) Elva Handler, opposer's sister who assists opposer, including with "secretarial type work"; (iii) Danny Alfaro, a former member of opposer's band; and (iv) Eric Handler, opposer's brother-in-law, with related

² Our ruling does not extend to those www.socalrocks.com printouts which are exhibits to opposer's testimonial deposition.

exhibits (except for Exhibit 11 discussed above). Applicant has not introduced any evidence that we may consider.³

The case has been fully briefed.⁴

Factual Findings

Opposer is a professional musician and founded a band named THE SUPERFREAKS in August 1999. Opposer then chose Danny Arroyo to be the lead vocalist and Danny Alfaro to be the drummer. Subsequently, opposer chose applicant to be a member of the band. The band plays disco and funk music from the 1970s, first rehearsed in August 1999 and plays at casinos, nightclubs, wedding receptions, festivals and private parties. Applicant was a member of THE SUPERFREAKS for about two years and participated in approximately 200 performances with THE SUPERFREAKS.

THE SUPERFREAKS first show was in October 15, 1999 at the Olympic Club in San Francisco. Alfaro, Jr. dep. p. 12. On New Year's Eve, 1999, the band performed in Laughlin, Nevada. *Id.* at p. 12 - 13. The band has given about 400 shows in the last five years. *Id.* at p. 13.

³ On July 6, 2005, the Board granted opposer's motion to exclude applicant's responses to applicant's testimonial deposition upon written questions. Thus, there is no testimony from applicant in the trial record.

⁴ Applicant filed his main brief late because he mailed his brief to an old address for the U.S. Patent and Trademark Office. Because opposer has not objected to the late submission of applicant's brief, we have exercised our discretion and have considered applicant's main brief.

Opposer markets THE SUPERFREAKS through a web site, flyers and advertisements, and mails postcards to event coordinators and event planners. He also has business cards and promotional videos. In either late 2001 or 2002, opposer terminated applicant's involvement in the band due to inter alia an incident during a performance of the band.

Priority

The question of priority is an issue in this case because opposer does not own an existing registration upon which he can rely under Section 2(d). C.f., *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To establish his priority under Section 2(d), opposer must prove that, vis-à-vis applicant, he owns "a mark or trade name previously used in the United States ... and not abandoned..."

Opposer has testified in his testimonial deposition that he "came up with the name Superfreaks" for the band; that the band's first show was on October 15, 1999; that the band performed in Laughlin, Nevada on New Year's Eve, 1999; that he has "used the service mark the Superfreaks continuously since October 15, 1999"; and that over the past five years, THE SUPERFREAKS have performed in about 400 shows. Alfaro, Jr. dep. pp. 12 - 13. There is nothing in the record that controverts opposer's testimony. Also, included within Exhibit 7 to opposer's deposition is

Internal Revenue Service Form 1099 for the year 2000 for "Joe J. Alfaro, Jr. [,] DBA SUPER FREAKS." Because opposer's claimed first use date and the date of Form 1099 precede the filing date of applicant's intent-to-use application, and opposer has testified as to the continued use of the mark, opposer has proved his standing to maintain this proceeding and we award priority to opposer. Section 2(d); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) (an opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing."); *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("To establish a reasonable basis for a belief that one is damaged ... a petition may assert a likelihood of confusion which is not wholly without merit.")

Likelihood of Confusion

We next consider the question of likelihood of confusion. Our determination under Section 2(d) 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 considering the evidence of record on these factors, we keep in mind that "[t]he

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fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the [services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Opposer has established that he provides live musical performances featuring disco music. Applicant's services as stated in his application, i.e., "Entertainment services namely, live musical performances by a disco musical band," are identical to opposer's services. Because applicant's services are identical to opposer's services, we presume that the parties' services travel in at least overlapping trade channels to at least overlapping classes of consumers. Therefore, the second, third and fourth *du Pont* factors concerning the similarities of the services, trade channels and conditions of purchase are resolved in opposer's favor.

We next consider the first *du Pont* factor concerning the similarities between the marks, looking to whether the marks in their entirety 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). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial

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impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing wrong 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 a consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751. For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" *Id.* In this case, applicant's mark is SUPERFREAKS FUNKY DISCO REVUE. The wording FUNKY DISCO REVUE is descriptive of applicant's services, i.e., that he provides a "funky disco revue." Applicant has disclaimed this descriptive matter in his mark. We therefore find that SUPERFREAKS is the dominant portion of applicant's mark. SUPERFREAKS is also the dominant portion of opposer's mark - the word "the" does not serve as an indication of origin.

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See *Conde Nast Publications v. The Redbook Publishing Co.*, 217 USPQ 356 (TTAB 1983). Thus, while the marks in their entirety have obvious differences in appearances and pronunciations due to the inclusion of the other wording in the marks, these differences are not as significant as the similarities created by the identical common dominant term. In view of the shared dominant term, we find that the meanings of the marks and their commercial impressions are not dissimilar - the additional wording in the marks does not alter the overall meaning and commercial impression of the marks and the differences in the meanings and commercial impressions of the marks are not very significant. We conclude that, when we consider these marks in their entirety, the differences in appearance, pronunciation, meaning, and commercial impression are eclipsed by the similarities of the marks. The first *du Pont* factor hence is resolved in opposer's favor.

Opposer has argued that applicant adopted his mark in bad faith. According to opposer, "[i]t is clear that Applicant chose a name virtually identical to the Opposer's mark, in an intentional effort to 'payback' Opposer and cause confusion." Brief at p. 11. Opposer's proofs fall short of proving bad faith adoption of applicant's mark and, thus, this factor is neutral in our analysis. However, in view of the manner in which we have resolved the *du Pont*

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factors listed above, opposer hardly needs to rely on applicant's intent in support of his allegation that there is a likelihood of confusion between the two marks.

Thus, as demonstrated above, opposer's and applicant's services are identical, their trade channels and classes of consumers overlap and the marks are similar. When marks appear on identical services, the degree of similarity necessary to support a conclusion of likely confusion declines. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Accordingly, we find that applicant's mark SUPERFREAKS FUNKY DISCO REVIEW, when used on "Entertainment services namely, live musical performances by a disco musical band," is likely to cause confusion with opposer's mark THE SUPERFREAKS used on identical services.

As mentioned above, applicant has asserted an affirmative defense of unclean hands based on opposer's filing in California for a state registration for THE SUPERFREAKS four days after applicant filed his application with the Office. Because applicant's affirmative defense is unrelated to opposer's claim of likelihood of confusion, and has no bearing on whether the consuming public would be confused by the registration of applicant's mark, we reject applicant's unclean hands defense.

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Finally, in light of our finding for opposer on the likelihood of confusion claim, to the extent that opposer also pleaded a claim of fraud, we need not reach such claim.

DECISION: The opposition is sustained on the ground of likelihood of confusion and registration to applicant is refused.