

**THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB**

Mailed:
September 29, 2006
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Vibe Media Group LLC
(substituted for Vibe Ventures LLC)

v.

RawVibe Entertainment, Inc.

Opposition No. 91162489 against
Serial No. 78254486

Edward H. Rosenthal, Jean Voutsinas, Christopher R. Chase
and Maura J. Wogan of Frankfurt Kurnit Klein & Selz, PC
for Vibe Media Group LLC (substituted for Vibe Ventures
LLC).

Shanee Y. Williams and Halimah D. DeLaine of Dechert LLP
for RawVibe Entertainment, Inc.

Before Bucher, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

RawVibe Entertainment, Inc. seeks registration on the
Principal Register of the mark **RAWVIBE** (*in standard character
format*) for goods identified in the application, as amended,
as follows:

"pre-recorded audio, visual and audio-visual
performances in analog and digital
configurations and formats contained in
analog magnetic and digital magnetic tapes

and discs, all containing music" in International Class 9.¹

Registration has been opposed by Vibe Ventures LLC.²

As its grounds for opposition, opposer asserted that applicant's mark, when used in connection with applicant's goods, so resembles eight of opposer's previously used and registered marks:

VIBE (in standard character format)

for a "general interest magazine" in International Class 16;³



for "audio and video recordings featuring performances by individual musicians and musical groups" in International Class 9;⁴

VIBE

for a "general interest magazine" in International Class 16;⁵

¹ Application Serial No. 78254486 was filed on May 27, 2003 based upon applicant's allegation of first use anywhere and first use in commerce at least as early as June 21, 2001.

² In a decision dated August 23, 2006, Vibe Media Group LLC was substituted for Vibe Ventures LLC as party plaintiff herein inasmuch as an assignment of the relevant registrations occurred after the discovery and testimony periods had closed. See TBMP § 512.01.

³ Registration No. 1800105 issued on October 19, 1993 claiming first use anywhere and first use in commerce at least as early as September 1992; Section 15 affidavit acknowledged, renewed.

⁴ Registration No. 1819799 issued on February 8, 1994 claiming first use anywhere and first use in commerce at least as early as December 1, 1991; Section 15 affidavit acknowledged, renewed; No claim is made to the word RECORDS apart from the mark as shown.

⁵ Registration No. 2144655 issued on March 17, 1998 claiming first use anywhere and first use in commerce at least as early as September 1992; Section 8 (six-year) affidavit accepted and Section 15 affidavit acknowledged.

VIBE (in standard character format)

for "T-shirts, shorts, baseball caps, chemises, camisoles, panties, boxer shorts, briefs, sweaters, jackets, blazers, shoes, boots, athletic shoes, socks, galoshes, wind-resistant jackets, shirts, blouses, pants, slacks, biker shorts, swimsuits, bras, headbands, hats, slips, girdles, nightgowns, robes, gowns, bodysuits, coats, jeans, blue jeans, underwear, sweatshirts, sweatpants, teddies, dresses, skirts, garter belts, pajamas, petticoats, corsettes, bustiers, gloves, mittens, stockings, tights, pantyhose, scarves, vests, halter tops, tube tops, tank tops, leggings, footies, raincoats, ear muffs, turtlenecks, ties, handkerchiefs, sneakers and bandanas" in Class 25;⁶

VIBE (in standard character format)

for "education services, namely, conducting seminars about the music and entertainment industries" in International Class 41; and "computer services, namely, providing an on-line magazine in the fields of urban culture and entertainment" in International Class 42;⁷

VIBE (in standard character format)

for "entertainment services, namely an ongoing television series; television awards show" in International Class 41;⁸

⁶ Registration No. 2563930 issued on April 23, 2002 claiming first use anywhere and first use in commerce at least as early as September 1, 1992.

⁷ Registration No. 2303664 issued on December 28, 1999 claiming first use anywhere and first use in commerce in International Class 41 at least as early as August 1995, and claiming first use anywhere and first use in commerce in International Class 42 at least as early as May 1994.

⁸ Registration No. 2841002 issued on May 11, 2004 claiming first use anywhere and first use in commerce at least as early as September 15, 2003.

VIBE CONFIDENTIAL
(in standard character
format)

for a "magazine column featuring gossip about people, places and events" in International Class 16;⁹

**VIBE'S 20
QUESTIONS** (in
standard character
format)

for a "magazine column about entertainment, popular culture, music, sports, current events and politics" in International Class 16,¹⁰

as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act. Opposer also alleges in its briefs that the involved application is void *ab initio* inasmuch as applicant failed to make *bona fide* use of the mark in commerce prior to the filing date of this used-based application.

Applicant, in its answer, has denied all the salient allegations in the notice of opposition.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer, as part of its case-in-chief, has made of record the testimonial deposition of Kenard Gibbs, President of Vibe Ventures LLC, taken on July 27, 2005, and the exhibits thereto, including copies (from the TESS records from the

⁹ Registration No. 2922158 issued on February 1, 2005 claiming first use anywhere and first use in commerce at least as early as August 1998.

¹⁰ Registration No. 2907411 issued on the Supplemental Register on November 30, 2004 claiming first use anywhere and first use in commerce at least as early as April 1995.

United States Patent and Trademark Office) of opposer's claimed registrations made of record in the proceeding by appropriate identification and introduction during the taking of Mr. Gibbs' testimony. Applicant has submitted the testimonial deposition of Jeffrey L. Toney, co-President of applicant, taken on February 27, 2006, and the exhibits thereto. The parties have fully briefed the case.

Factual Findings

Applicant RawVibe Entertainment, Inc. is a Subchapter S corporation, founded in June 2001 by Jeffery Toney (a.k.a. **T.H.U.M.P.** and **Big Thump**) and Luis Duran, which company is engaged in creating, recording and distributing rap, hip-hop and R&B music. Toney testimony deposition, p. 5. Mr. Toney testified that he has used the term "RawVibe Entertainment" since at least the year 2000 in connection with live musical performances at his college. Toney testimony deposition, pp. 6, 8 and 18. However, while applicant's use of **RAWVIBE** in connection with pre-recorded musical CDs in International Class 9 clearly does not go back that far, the record is less clear as to exactly when and to what extent, the involved mark was first used for goods in International Class 9. Applicant's brief states that "[s]ince its inception [2001], [applicant] has

distributed a CD entitled "Street Sanitation Vol. 1." The specimen submitted in support of the involved trademark application (received in the United States Patent and Trademark Office on May 27, 2003) included a CD stamped



"Street Sanitation - Thump," having a CD jewel case showing the album as "T.H.U.M.P. presents Street Sanitation Vol. 1" along with the RawVibe mark.

It appears from this entire record that the initially-recited entertainment services in International Class 41 were rendered in commerce prior to the critical date of May 27, 2003, the filing date of this use-based application. However, the record does not support the sale or distribution anytime between June 2001 and May 2003 of the class 9 pre-recorded musical albums bearing the **RAWVIBE** mark - and International Class 9 is the only class of goods

that remained in the application after an amendment during *ex parte* examination.

Opposer is an urban music and lifestyle company that publishes magazines such as the Vibe magazine, founded by Quincy Jones in 1992. Gibbs Testimony deposition, p. 6. In addition to magazine publishing, opposer also develops television and film programming, publishes books about musical artists and the music industry, develops music compilations, produces and distributes pre-recorded audio discs, and develops mobile phone content. *Id.*, p. 5.

According to opposer's testimony, Vibe magazine is the preeminent brand in urban music and culture, focusing primarily on artists and producers involved in urban music. The following summary of the record, taken from opposer's brief is supported by testimony and exhibits in the record, and does not include portions objected to by applicant:

Targeted to young adults aged 18 to 34, Vibe [magazine] is distributed in the United States, Canada, all of the European Union, some South American countries, and Japan. The magazine's audience has grown substantially since inception, with a circulation of 850,000 (as of 2005), while the advertising revenue has increased to approximately \$70 million in sales (as of 2005). Musical artists and personalities are usually featured on the cover of Vibe. Vibe Ventures has been able to translate the hard-copy success of Vibe into the online world as well. Vibe magazine's home on the Internet, www.vibe.com, which has been in

existence since 1996, is one of the most visited websites in the urban music space.

The website features articles and information about urban music artists and personalities, and is updated daily.

In 2005, Vibe Ventures also launched a general interest magazine targeted to women that also focuses on music. This magazine is called Vibe Vixen.

The VIBE brand is not only the magazines though — Vibe Ventures has expanded into numerous music-related areas since 1992, including pre-recorded audio ... Vibe Ventures produces a syndicated television show called Weekend VIBE that is broadcast on numerous stations in roughly 100 markets across the United States. This program, featuring music videos and interviews with musical artists, reaches over one million viewers a week. Vibe Ventures also produces the annual VIBE Awards show, which is broadcast nationally on the [former] UPN network. This awards show, where the majority of awards are given out to hip-hop recording artists has featured performances from some of the most well known artists in urban music, including **Mary J. Blige, Eve, Ludacris, 50 Cent, The Game, Ashanti, OutKast, and R. Kelly.**

Vibe Ventures also produces and organizes the VIBE MUSICFEST, an annual music festival and seminar that spans three days in Atlanta, Georgia. VIBE MUSICFEST is another platform that serves to demonstrate Vibe Ventures' leadership within urban music by bringing the best acts in urban music today together on one stage. Many of the top-selling urban music artists performed at the 2005 VIBE MUSICFEST, including **Kanye West, John Legend, Amerie, OutKast, Sean ["P Diddy"] Combs, and Ludacris.** In addition, Vibe Ventures produced and distributed a VIBE branded compilation audio disc in connection with the VIBE MUSICFEST.

Additionally, Vibe Ventures has sponsored the VIBE Music Seminar. Held in New York City during the mid-1990's, this event drew the influencers and tastemakers of urban music and culture to one central location. The VIBE Music Seminar served to drive home Vibe Ventures' association with urban music and culture.

Further, Vibe Ventures has developed numerous books under the VIBE mark involving urban music and culture. Such books include biographies on **The Notorious B.I.G.**, as well as a book featuring female hip-hop artists, entitled HIP HOP DIVAS. The VIBE HISTORY OF HIP-HOP also reinforced Vibe Ventures' leadership position in the urban music and culture field by chronicling the rise of urban music, particularly in the genre of hip-hop. As the title of this book notes, Vibe Ventures occupies a position of authority on the subject.

In the past few years, Vibe Ventures has also expanded into the wireless business with its MVIBE and MOBILE VIBE brands. Cell phone users can subscribe to VIBE's mobile service, which provides users with downloadable ring tones, music, visual images, and information on musical artists. This service aims to create a wireless community for the VIBE brand.

Opposer's brief, pp. 3 - 5; citations to evidence omitted.

In addition, opposer has elicited testimony about its extensive production and distribution of pre-recorded audio material under the VIBE mark. Gibbs Testimony deposition, pp. 11 - 25.

Under cross-examination, Mr. Toney acknowledges that given his immersion in the rap and hip-hop scene for a decade prior to adopting the RAWVIBE mark, he was familiar

with Vibe magazine as well as the VIBE television awards program. Toney testimony deposition, pp. 15 - 16.

Preliminary matters

Standing:

Applicant has objected to opposer's standing, arguing that opposer no longer has a real interest in the marks asserted by it in these proceedings.

Applicant does not contend that Vibe Ventures LLC lacked standing at the time the Notice of Opposition was filed. Rather, in its brief, applicant raised the standing issue based upon news releases of early-July 2006 about the acquisition of Vibe magazine by a private equity firm. This was after applicant's discovery and testimony periods had closed. In response to applicant's motion to reopen its testimony period, filed on July 12, 2006, opposer submitted evidence of a recent assignment of all of Vibe Ventures LLC's right, title and interest to its trademarks to Vibe Media Group LLC.¹¹ This transfer included the right

¹¹ Applicant had filed this motion to reopen its testimony period in light of its concerns that media reports indicated that Vibe magazine had just been acquired by the *Wicks Group of Companies, L.L.C.* Opposer responded to this motion by noting its June 29, 2006 assignment to *Vibe Media Group LLC*, filed on June 30, 2006 with the Assignment Division of the United States Patent and Trademark Office. See Reel No. 3363, Frame No. 0396. Applicant's final brief on the merits of the case was filed on July 14, 2006, just two days after filing its motion to reopen,

to maintain an adversary proceeding. We reaffirm that the right to continue this action may be transferred to another party given an assignment of the mark with all the associated goodwill. While opposer did not explain the relationship, if any, between the assignment documents of June 29-30, 2006 and the media accounts of July 5, 2006, applicant has not challenged the validity of this executed and recorded transfer of rights. In substituting Vibe Media Group LLC for Vibe Ventures LLC, the Board has already determined that according to the records of the United States Patent and Trademark Office, Vibe Media Group LLC owns all rights to the trademarks previously owned by Vibe Ventures LLC, as set forth in the Notice of Opposition herein, including the right to maintain this trademark opposition proceeding. As such, both Vibe Ventures LLC and its assignee, Vibe Media Group LLC, are persons who believe that they would be damaged by the registration of applicant's mark on the Principal Register, and each has properly had standing to oppose. See TBMP § 512.01 (2d ed. rev. 2004).

days before opposer's response, and weeks before an interlocutory decision denying this motion to reopen was issued on August 23, 2006.

Fraud:

Opposer argues in its brief that applicant knowingly entered a fraudulent date of first use when it filed the involved trademark application. However, we see this allegation merely as further support for opposer's argument that this use-based application should be found to be void *ab initio*. Moreover, if an applicant has made *bona fide* use at some point prior to filing a use-based application, there is no fraud even if applicant knowing makes a fraudulent claim as to the date of first use:

If the mark was in use at that time, then the first use, even if false, does not constitute fraud because the first use date is not material to the decision to approve a mark for publication. See Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 USPQ2d 1917 (TTAB 2006); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73, 76 (TTAB 1983) ["The Examining Attorney gives no consideration to alleged dates of first use in determining whether conflicting marks should be published for opposition."]

In any case, opposer has not pleaded fraud; nor have the parties tried this claim.

Applicant's motion to strike portions of opposer's brief:

Applicant has included in its brief a motion to strike major portions of opposer's brief, alleging that it includes: references to opposer's claimed pending

applications; arguments outside the pleadings; sentences, paragraphs and sections not supported by the evidence; and misstatements of the evidence.

However, opposer's main brief was timely and regularly filed. Any specific objections which applicant may have to the contents of opposer's brief have been considered in our final determination of this case, and any portions of the brief that were found to be improper have been disregarded. Most importantly, while we consider all the evidence in the record and accord to each piece of evidence the appropriate weight, the Board generally will not strike portions of a brief upon motion by an adverse party who simply objects to the contents thereof. See TBMP § 539 (2d ed. rev. 2004).

Analysis: No bona fide use as of filing date

Procedurally, the critical issue of applicant's having filed a fatally-flawed application that should be found to be void *ab initio* was never affirmatively pleaded.¹² Nevertheless, we find that the issue has been tried and briefed by both parties.

Substantively, we find that Mr. Toney's testimony supports the conclusion that this use-based application must be found to be void *ab initio*.

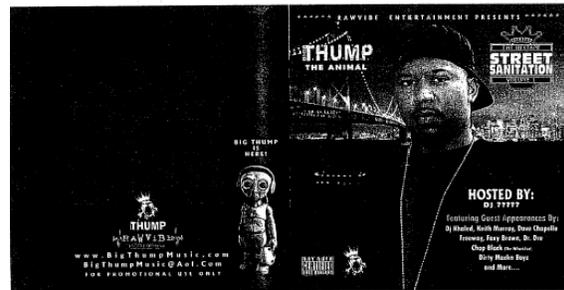
¹² Opposer learned of this during discovery and pursued it intently during trial. As was noted earlier (see p. 4 of this opinion), opposer makes these arguments in its briefs.

It is true that Mr. Toney appears to have adopted the term "RawVibe Entertainment" in connection with "open mic" events in college as early as the year 2000. Then the entity known as RawVibe Entertainment, Inc. came into existence in June 2001. However, the issue before us is what uses of the term **RAWVIBE** in connection with goods in International Class 9 support the involved use-based application that was filed on May 27, 2003. The record contains photographs of three different CD musical albums: ① "Dramacydle" ② "Street Sanitation" and ③ "King of the Concrete Jungle." And of these three, the most critical and confusing evidence seems to surround the marketing of the "Street Sanitation" album.

Applicant's testimony about "Street Sanitation" (Toney testimony deposition, p. 13, Ex. #11) refers to a CD "Mixtape" marked "New for 2006" and "For Promotional Use Only," with accompanying testimony that this involved a future release (e.g., in 2006).¹³ It is clear that the graphics here are quite



Mixtape



¹³ Q [Applicant's counsel, Ms. Williams]: Mr. Toney, can you describe the exhibit marked as Exhibit 11?

different from that of the earlier version of the "Street Sanitation" CD jewel case cover making up the specimen of 2003 (see p. 6 of this decision, *infra*). However, when Mr. Toney was pressed under oath for documentation as to applicant's *bona fide* uses of the mark RAWVIBE, no usage on CDs was ever alleged or supported by documentation in the period between 2001 and 2004.

Based on the relevant portions of applicant's testimony, we can find no support for applicant's claim in its brief that "the term 'RawVibe' has been in continuous use by RawVibe Entertainment since 2000" in connection with goods in International Class 9. To the contrary, Mr. Toney's testimony supports the conclusion that the "Dramacydle" CD (which contained the "RawVibe Entertainment" mark as shown below) was produced in late-2004.



It was this "T.H.U.M.P. Presents Dramacydle" CD that resulted in the sale of five

A [Mr. Toney]: Exhibit 11 is the mixtape ["Street Sanitation"] that RawVibe Entertainment plans to release before the ["King of the Concrete Jungle"] album [*Id.* Ex. 10].
Q: So it will be released in 2006?
A: Yes.
Id. at 13.

copies in Japan through the *CD Baby* site on the Internet.
(Toney testimony dep., p. 11; <http://cdbaby.com/cd/thump>).

Specifically, it seems that the production of the "Dramacydle" CD did not take place until 2004. Although at least a mock-up version of the "Street Sanitation" CD case accompanied the trademark application in May 2003, the only evidence of the "Street Sanitation" CD, as of Mr. Toney's testimony of February 2006, is that this promotional mixtape was a future venture, as was the promised album, "King of the Concrete Jungle." This timeline grows out of Mr. Toney's own testimony:

Q [Applicant's counsel, Ms. Williams]:
[H]as RawVibe distributed any goods or services?

A [Mr. Toney]: To date we distributed one CD, Dramacycle CD, which was intended for promotional use only.

Q: And do you remember approximately when that CD was distributed?

A: Maybe a year and a half ago [deposition on February 26, 2006]

Q: And do you recall where or how it was distributed?

A: The majority of the CDs were distributed hand to hand. There were actually five CDs sold through a website called *CD Baby*.

(Toney testimony deposition, p. 6).

Q [Applicant's counsel, Ms. Williams]:
[H]as RawVibe ever used this mark in connection with any goods or services?

A [Mr. Toney]: Yes, the mark was used on the first promotional item, the Dramacydle CD...

Q: Have there been any other uses of the RawVibe mark on any other goods or services?

A: Nothing that has been published.
(Toney testimony deposition, pp. 8 - 9).

Q [Applicant's counsel, Ms. Williams]: Has RawVibe sold any goods or services using the RawVibe mark?

A [Mr. Toney]: Yes, like I said, previously, five CDs were sold via the Internet from *CD Baby*.

Q: And do you know where these albums were sold?

A: Yes, those albums were sold to someone in Japan.

Q: [A]re you aware of whether RawVibe generated any profit from these sales?

A: Actually, yes ... they sent \$5 for a CD, so I think it was like 25 bucks that they sent me the check for.

Q: Mr. Toney, you testified earlier that RawVibe distributed a promotional CD. Is the exhibit that's been marked as Exhibit 9 a copy of the ["Dramacydle"] CD cover that you were discussing?

A: Yes, it is.

Q: Is this the only product that RawVibe has distributed to date?

A: Yes, it is.

Q: And you also mentioned that RawVibe has some specific plans for future products[.] Can you tell us a little bit more about those future products that are in the works currently?

A: Future products include a mixtape ["Street Sanitation"], which will be created for promotional use and given out. And following the mixtape we will be releasing an album, which we plan on putting in mom and pop stores.

Q: Mr. Toney, can you describe what's [been] marked as Exhibit 10 is?

A: Exhibit 10 ["King of the Concrete Jungle"] is the album that RawVibe plans to release sometime this year.

Q: Mr. Toney, can you describe the exhibit that's been marked as Exhibit 11 ["Street Sanitation"]?

A: Exhibit 11 is the mixtape that RawVibe Entertainment plans to release before the album.

Q: So it will be released in 2006?

A: Yes.

(Toney testimony deposition, pp. 11 - 13).

Q [Cross examination by Ms. Wogan]: In connection with the album that you've testified as being prepared that will carry the RawVibe label, what is your timetable for when that will be released?

A [Mr. Toney]: Well, our timetable for release is that hopefully sometime in 2006. We do not have a set date for that.

Q: Have you recorded the CD for the album?

A: It's not complete. We're in the process of finishing it now.

(Toney testimony deposition, p. 24).

Q [Cross examination by Ms. Wogan]: Mr. Toney, am I correct that the album that you are planning to release in 2006 with the name RawVibe will be the first commercial product that you will be releasing with the name RawVibe?

A [Mr. Toney]: The first commercial product
Ms. Williams: Objection, vague and ambiguous.

A: Although the first one was intended as a promotional item, it was sold through the Internet, five copies, so that would justify it being commercial. But the album that we plan to release in 2006 is our actual

official release for the album under the label.

Q: So apart from the five CD's that were sold on the Internet of the Dramacydle CD, you have never used the RawVibe name in connection with a commercial effort?

A: No.

Q: Correct?

A: Correct.

Q: And apart from the Dramacydle CD and the - your appearances at open mic events, up until this point in time, you have not used ... the RawVibe name in any other way, is that correct?

A: Correct.

(Toney testimony deposition, p. 26 - 27).

Accordingly, applicant has failed to demonstrate any *bona fide* use prior to the filing date of this application. Hence, the application is void *ab initio*,¹⁴ the opposition is sustained, and registration to applicant is denied.

¹⁴ Inasmuch as there was no use of the mark on pre-recorded audio, visual and audio-visual performances contained on tapes or discs and applicant has not sought to amend its application to seek registration under the intent-to-use provisions of the Trademark Act, the application in International Class 9 must be deemed void *ab initio* as the applicant had not made use on any goods in the application. Grand Canyon West Ranch LLC v. Hualapai Tribe, 78 USPQ2d 1696 (TTAB 2006) [Application not void *ab initio* even though use was on less than all the services in the application when applicant moved to amend the application and delete the services without use.] The board has recognized that during an opposition proceeding, an applicant can cure this flaw by amending its basis for applying to Section 1(b) (intent to use) during the prosecution of the application. See e.g., Leeds Technologies Ltd. v. Topaz Communications Ltd., 65 USPQ2d 1303 (TTAB 2002). Applicant has not attempted to do so in this case.

Analysis: Priority and Likelihood of Confusion

Although our determination above that this application is void *ab initio* means that applicant cannot secure a registration herein, in the event that this determination should be reversed on appeal, we proceed, in the alternative, to a decision of the issue of likelihood of confusion.

We turn then to the issue of priority in relation to the goods set forth in opposer's pleaded registrations. As noted above, opposer has established its ownership of valid and subsisting registrations for its **VIBE** mark for magazines, educational and entertainment services, clothing items, and the like. Similarly, opposer has established its ownership of a valid and subsisting registration for its **VIBE RECORDS** & design mark (shown to the right) for audio and video recordings featuring performances by individual



musicians and musical groups. Therefore, there is no issue as to opposer's priority. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

Our determination under Section 2(d) is based upon an analysis of all of the probative 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Goods

We turn first to the similarity of the goods as identified in the application and the claimed registrations. Even though the wording may be slightly different, it is clear that applicant's goods and the goods in opposer's Reg. No. 1819799 for VIBE RECORDS & design are identical - namely, pre-recorded audio or audio-visual musical performances. Moreover, the goods in opposer's other claimed registrations are related to applicant's pre-recorded musical productions. For example, the educational and entertainment services offered under the **VIBE** service mark explicitly mention urban culture, music and award shows for musicians, the record demonstrates that opposer has been involved with a broad range of music-related goods

and services for almost fifteen years, while the testimony depositions of opposer's witness and applicant's witness both demonstrate that distinctive clothing fashions and urban music go hand-in-hand. This factor weighs heavily in favor of opposer's position herein.

The buyers to whom sales are made

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, we note that with identical goods, we can presume that these relatively low-cost items will be directed to the same ordinary consumers. Moreover, the testimony in this case demonstrates that applicant will be seeking out as customers persons from the exact same demographic that has proven to be so critical to opposer's success over the past fifteen years in the area of urban music and culture, namely, persons in their teens to mid-thirties.¹⁵ Accordingly, this factor too weighs in favor of opposer.

Channels of trade

Similarly, as to the du Pont factor focusing on the similarity of established, likely-to-continue trade channels, inasmuch as there are no limitations on the channels of trade in applicant's application or in

¹⁵ Toney testimony deposition, p. 11 ("14 to 34"); Gibbs testimony deposition, p. 9 ("18 to 34").

opposer's registrations, we must assume that the parties' goods would be sold in the same channels of trade and to the same classes of consumers. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) [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-à-vis the goods and/or services recited in an opposer's registration]. Furthermore, the record contains evidence that the goods and services in the field of urban music marketed by opposer and by applicant will be available to hip-hop and rap music fans on the Internet and through retail outlets. Hence, this factor favors opposer.

Family of Marks

While opposer claims to have a family of marks, applicant argues that opposer's marks cannot qualify as a family entitled to a higher level of protection. In fact, to the contrary, applicant points out that opposer has distributed prerecorded audio compilations through record labels other than VIBE RECORDS.

In order for opposer to establish that it is the owner of a family of marks, it must be shown by competent

evidence that prior to applicant's entry into the field, a substantial number of the marks within its claimed "family" were used and promoted together in such a manner as to create public recognition coupled with an association of common origin predicated on the "family" feature, and that the "family" feature is distinctive. See The Land-O-Nod Company v. Paulison, 220 USPQ 61, 65-66 (TTAB 1983).

Given its structure, we find that the formative term "Vibe" appears to be a candidate for the creation of a family of marks. It is clearly used by opposer on a wide variety of goods and services. In a sense, it would seem to be fair to characterize it as being opposer's "house mark." Simply using a series of similar marks or the registration of many marks with a common "surname" does not of itself establish the existence of a family. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). We find that the evidence is insufficient to demonstrate public recognition of a VIBE family of marks in the absence of any "look for" type of advertising, extensive use of the various marks together in advertising campaigns, etc.

Nevertheless, the record shows opposer's common law usage throughout the past fifteen year, of growing variations of this mark by adding matter to it, e.g., VIBE

MUSICFEST, VIBE VIXEN, VIBE RECORDS, MVIBE, MOBILE VIBE, VIBE ON THE STREETS, VIBE REVOLUTIONS, VIBE'S 20 QUESTIONS, etc. This pattern increases the likelihood that RAWVIBE would be perceived as another variation on the same theme. On balance, then, given the manner in which the VIBE house mark is used in its many variations, this factor favors opposer somewhat, even where a family of marks has not been proven. See Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987), citing to Varian Associates, Inc. v. Leybold-Heraeus G.m.B.H., 219 USPQ 829, 833 (TTAB 1983). As we have found that a family has not been established, we will need to decide the question of likelihood of confusion on the basis of individual marks, focusing most intensely on the mark that is most relevant, namely VIBE RECORDS & design.

Strength of opposer's mark

As to the du Pont factor focusing on the number and nature of similar marks in use on similar goods and/or services, applicant argues that "[c]learly, in the industry of pre-recorded music, 'VIBE' is a generic term." Applicant goes on to argue that extensive usage of the word "Vibe" in third-party registrations for various forms of

pre-recorded audio¹⁶ suggests that opposer's **VIBE** mark, and the "Vibe" portion of its **VIBE RECORDS** & design composite mark, is weak and deserving of a narrow scope of protection.

The word "vibe" has etymological derivatives in the English-language words "vibration"¹⁷ or "vibrate."¹⁸ Arguably that means the word "vibe" may be a suggestive term for music. Opposer has various registrations of this term on the Principal Register for music-related goods and services, and applicant has not counterclaimed to have any of them cancelled. In addition to the paucity of third-party registrations in this field where composite marks even included somewhere therein the word "Vibe," such evidence is entitled to little probative value in determining likelihood of confusion. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); and Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995). This is

¹⁶ Applicant cites to at least three registered marks containing the word "Vibe" for music CD's, downloadable ringtones, etc.: **TRUE VIBE**, **SONIC VIBE** and **REGGAE COUNTRY, THE VIBE**.

¹⁷ "... [H]ip-hop is usually bas[s] heavy, and so I came up with the word 'Vibe' from the vibrations from the speakers, and that's where,, on the logo, we have the line that signifies vibrations." Toney testimony deposition, p. 8.



¹⁸ **Vibrate:** ... 2. To produce a sound; resonate. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, 1975.

true because the registrations are not evidence that the marks are in use, much less that purchasers are familiar with them. Accordingly, we find that applicant has failed to show that opposer's mark is weak, and so this du Pont factor is neutral.

Fame of the prior mark

Opposer argues that its promotional efforts have resulted in widespread awareness and recognition of its **VIBE** marks. It argues that inasmuch as it has demonstrated that its registered marks are famous, the **VIBE RECORDS** & design mark should thus be entitled to a broad scope of protection.

On the contrary, applicant argues as follows:

... [A]lthough Opposer offers information about the circulation of Vibe magazine, it provides no factual support for finding **VIBE RECORDS**, **MVIBE**, **MOBILE VIBE**, **VIBE REVOLUTIONS**, **VIBE ON THE STREET**, or **VIBE VIXEN** famous. Opposer's testimonial witness could not even recall if Opposer had ever sold a product or earned a profit using the **VIBE RECORDS** mark. If Opposer's sales and distribution under the mark with goods closest to Applicant's are so small that Opposer itself has no idea the reach of the mark, the mark cannot possibly meet the extremely high requirements for fame.

We find that the mark **VIBE** is certainly well known in the niche market of urban music. Not surprisingly, as an

urban youngster attracted to hip-hop and rap music, Mr. Toney knew well of Vibe magazine and the **VIBE** television awards show. Nonetheless, we agree with applicant that opposer has failed to demonstrate that **VIBE** is famous for pre-recorded music, and this too is a neutral factor.

The marks

We turn then to the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note in discussing this factor, the Court of Appeals for the Federal Circuit has held that when marks 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, 1701 (Fed. Cir. 1992).

In this case, the two marks, **RAWVIBE** and  have some obvious visual dissimilarities. While we compare the marks in their entirety, our primary reviewing Court has held that in articulating reasons for reaching a 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 composite mark may have more significance than others in creating a commercial impression. See 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).

When a mark such as opposer's consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory, and is what will be used to call for the goods. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1596 (TTAB 1999); In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987); and Amoco Oil Co. v. Amerco, Inc., 192 USPQ 729 (TTAB 1976).

Accordingly, although applicant's mark is a single string of seven letters while opposer's mark is a word and design mark having the word "Vibe" in fanciful letters

RAWVIBE



above the word RECORDS, we find that the term "Vibe" is the dominant visual feature of both marks.

Applicant's mark is two syllables, where the second syllable is the word "Vibe," while opposer's mark is three syllables, where the first syllable is "Vibe." Again, we find that the aural similarity of the common word "Vibe" will be the portion consumers are most likely to remember.

Opposer argues that as to connotation, applicant has taken the dominant feature of opposer's mark and simply modified it by adding the word "raw" - a term that opposer argues does not serve to distinguish applicant's mark from opposer's mark.

By contrast, applicant takes the position that these marks, when evaluated in their entireties, are quite *dissimilar*. In fact, applicant goes so far as to argue that the dissimilarity of the marks may well be dispositive in this case such that we need not even consider the other du Pont factors. We disagree.

As to connotation, we turn to the question of where the word "Raw" might be placed on the continuum of distinctiveness. While opposer seems to argue it is descriptive in the context of urban music forms such as rap and hip-hop, we find that it is, at the very least, suggestive. This is supported, in part, by the testimony of applicant's own witness, who noted his thought processes at the time he coined the name, "RawVibe," specifically,

that "... hip-hop is considered a raw form of music ..."
Toney testimony deposition, p. 8 (*emphasis* supplied). We
take judicial notice of the fact that the word "raw" can
connote "crude,"¹⁹ and we may consider "raw" a term that
describes crude or offensive lyrics.²⁰

Hence, while we are aware of the specific differences
in these marks that applicant has pointed out in its brief,
we find the marks to be confusingly similar. That is,
based on a review of the respective marks in their
entireties, with a thorough examination of the entire
record herein, we find that when these respective marks are
used on identical goods, consumers are likely to be
confused as to source or sponsorship.

Conclusion

In conclusion, we find that this application is void
ab initio. In the alternative, we also find that this
application should be barred by Section 2(d) of the Lanham
Act. Hence, the opposition is sustained on both bases, and
registration to applicant is denied.

¹⁹ **raw:** ... 8. Outspoken; crude..., THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, 1975.

²⁰ We do note that all of Mr. Toney's album covers included in this record are stamped with a "Parental Advisory" due to their "Explicit Lyrics."

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