

Oral Hearing:
October 24, 2007

**THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB**

Decision Mailed:
February 25, 2008
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bose Corp.
v.
GoldWave Inc.

Opposition No. 91165449 to application Serial No. 78413775
filed on May 5, 2004

Amy L. Brosius, Charles Hieken and Cynthia Johnson Walden of Fish
& Richardson P.C. for Bose Corp.

Marsha G. Gentner of Jacobson Holman PLLC for GoldWave Inc.

Before Hohein, Taylor and Mermelstein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

GoldWave Inc. has filed an application to register the
mark "GoldWave" in standard character form on the Principal
Register for "computer software for audio editing" in
International Class 9.¹

Bose Corp. has opposed registration on the ground that
it is the owner of valid and subsisting registrations for the

¹ Ser. No. 781413775, filed on May 5, 2004, which is based on an
allegation of a date of first use anywhere and in commerce of May 1,
1993.

following marks and goods which it "uses and/or has used, since long prior to May 1, 1993":

(i) the mark "WAVE," which is registered for "radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players" in International Class 9;²

(ii) the mark "ACOUSTIC WAVE," which is registered for "loudspeaker systems" in International Class 9³ and "loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape player" in International Class 9;⁴

(iii) the mark "WAVESYNC," which is registered for "radio controllers, namely, controllers for remotely establishing predetermined settings in radios in rooms having occupants frequently changed, such as hotel rooms, sold through channels including those selling to renters of such rooms, such as hotels for the purpose of clearing settings in radios set by occupants who have vacated the rooms" in International Class 9;⁵ and

² Reg. No. 1,633,789, issued on the Principal Register on February 5, 1991, which sets forth a date of first use anywhere and in commerce of September 25, 1989; renewed. However, in accordance with TBMP §704.03(b)(1)(A) (2d ed. rev. 2004), it is noted that on January 3, 2008, opposer filed a request pursuant to Section 7(e) of the Trademark Act to amend the registration to restrict the goods identified therein to: "radios, clock radios, compact stereo systems and portable compact disc players."

³ Reg. No. 1,338,571, issued on the Supplemental Register, on May 28, 1985, which sets forth a date of first use anywhere and in commerce of February 1, 1984; renewed.

⁴ Reg. No. 1,764,183, issued on the Principal Register, under the provisions of Section 2(f) of the Trademark Act, on April 13, 1993, which sets forth a date of first use anywhere and in commerce of February 1, 1984; renewed.

⁵ Reg. No. 2,493,186, issued on the Principal Register on September 25, 2001, which sets forth a date of first use anywhere and in commerce of September 1999; affidavit §8 filed.

(iv) the mark "WAVE/PC," which is registered for a "sound reproducing system comprised of a radio, electronic interface for coupling the radio to a computer, and computer software for controlling the signal transmission between the radio and the computer" in International Class 9;⁶

and that applicant's "GOLDWAVE mark, as applied to '[c]omputer software for audio editing[,]'" so resembles the previously used and registered WAVE, ACOUSTIC WAVE, WAVESYNC and WAVE/PC marks of Opposer, as used in connection with Opposer's goods, as to be likely to cause confusion or cause mistake, or to deceive."

Applicant, in its answer, has admitted that, as shown by the certified copies thereof which accompany the opposition, opposer is the owner of its pleaded registrations and that such registrations are valid and subsisting. Applicant has denied, however, the remaining salient allegations of the opposition.⁷

The record consists of the pleadings, including the above-noted certified copies of opposer's pleaded registrations; the file of the involved application; the testimony with exhibits of opposer's Category Business Manager for its "WAVE" product line, Mr. Santiago Carvajal; and the testimony with exhibits of applicant's president, Mr. Christopher Craig. While only opposer

⁶ Reg. No. 2,552,385, issued on the Principal Register on March 26, 2002, which sets forth a date of first use anywhere and in commerce of November 9, 2000.

⁷ While, under the rubric of "AFFIRMATIVE DEFENSES," applicant has also pleaded that the opposition "fails to state a claim upon which relief can be granted" and "is barred by the doctrines of laches, waiver and/or estoppel," no further consideration will be given to such allegations inasmuch as they are not only insufficiently pleaded but, in any event, are lacking in any evidentiary support in the record.

filed a brief, both parties were represented by counsel at the oral hearing.

With the exception of its "WAVE/PC" mark, priority of use is not in issue in this proceeding since, as shown by the certified copies of opposer's pleaded registrations on the Principal Register for its other three marks and as admitted by applicant in its answer, such registrations are subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Opposer's ownership thereof, moreover, serves to establish its standing to bring this proceeding. Id.

However, as to opposer's "WAVE/PC" mark, while its pleaded registration on the Principal Register for such mark, based upon the certified copy thereof and as admitted by applicant in its answer, is likewise shown to be subsisting and owned by opposer, the prima facie presumptions otherwise afforded the registration⁸ have been rebutted inasmuch as the following testimony of opposer's witness on cross-examination conclusively establishes, as of the August 18, 2006 date of his deposition, a prima facie case of opposer's abandonment⁹ of the "WAVE/PC" mark:

⁸ Under Section 7(b) of the Trademark Act, "[a] certificate of registration of a mark upon the principal register ... shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate."

⁹ Section 45 of the Trademark Act defines "abandonment of mark" in relevant part as follows (emphasis added):

A mark shall be deemed to be "abandoned" if ... the following occurs:

Q. Now, Mr. Carvajal, are the Wave/PC devices sold in the U.S.?

A. Currently?

Q. Yes.

A. No. We don't sell that product at this time.

Q. Again, you said it is not sold any longer at this time?

A. That is correct.

Q. Since when was it no longer sold in the U.S. marketplace?

A. We discontinued the product in 2002.

Q. And when was the Wave/PC product last manufactured for market consumption by Bose Corporation?

A. Also 2002.

(Carvajal Dep. at 60-61.) In view thereof, we have given no evidentiary value to opposer's pleaded registration for its "WAVE/PC" mark and have given no further consideration to such mark with respect to the claim of priority of use and likelihood of confusion. See, e.g., Reed Tool Co. v. Litton Industrial Products, Inc., 225 USPQ 880, 881 (TTAB 1985) ["[s]ince opposer's testimony reveals that opposer is no longer making or selling these products, ... the prima facie presumption of use of the mark on these goods listed in opposer's registration is

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. **Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.** "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

considered rebutted and no evidentiary value is accorded to that registration with respect to those goods"]; Airport Canteen Services, Inc. v. Farmer's Daughter, Inc., 184 USPQ 622, 626 (TTAB 1974) [while a party may not challenge the validity of an adverse party's registration absent a petition to cancel such registration, "Board can, when there is conclusive evidence that the registered mark has not been used at time the application was filed or for a number of years thereafter on or in connection with the goods ... recited in the registration, refuse to accord any evidentiary value to the registration in determining the question of likelihood of confusion or even the question of prior rights"]; and Gates Rubber Co. v. Western Coupling Corp., 179 USPQ 186, 190 (TTAB 1973) [section 7(b) presumptions "are prima facie presumptions and are therefore rebuttable" and thus "it has been held that while a party may not challenge the validity of a registration in the absence of a petition to cancel, he may introduce evidence or rely on evidence adduced by the registrant to rebut the presumption of broad use of the registered mark and thereby to restrict use of the mark to those goods in connection with which it has actually been used," but "the evidence to be effective must be conclusive in character"]. In any event, it is additionally noted that opposer in its brief does not even mention its "WAVE/PC" mark in connection with its claim of priority of use and likelihood of confusion and, thus, plainly appears to be no longer relying thereon.

Moreover, with respect to its "WAVESYNC" mark, opposer not only likewise makes no mention thereof in its brief, but it

did not present any testimony at trial concerning the products associated with such mark so as even to attempt to establish any relatedness, in a commercial sense, between those goods and applicant's goods. Specifically, it is clear in this regard that, on their face, opposer's "radio controllers, namely, controllers for remotely establishing predetermined settings in radios in rooms having occupants frequently changed, such as hotel rooms, sold through channels including those selling to renters of such rooms, such as hotels for the purpose of clearing settings in radios set by occupants who have vacated the rooms" are distinctively different from and unrelated to applicant's "computer software for audio editing." In view thereof, we find that there is no likelihood of confusion from contemporaneous use by the parties of their respective "WAVESYNC" and "GoldWave" marks, thereby leaving consideration of opposer's "ACOUSTIC WAVE" and "WAVE" marks and the goods associated therewith as the focus of whether there is a likelihood of confusion with applicant's "GoldWave" mark for its goods.

According to the record, Mr. Carvajal is the "Category Business Manager" for opposer's "Wave" line of products, which consists of the following three major products: The "Acoustic Wave Music System," the "Wave Music System" and the "Wave Radio." (Carvajal dep. at 7-8.) The "Acoustic Wave Music System," which opposer markets under the mark "ACOUSTIC WAVE," was first marketed in 1984 and "is basically a self-contained music system" which currently "has a CD player," "an AM/FM tuner" and "a connection for external components." (Id. at 9.) Such product

is described in a press release issued by opposer for the latest version thereof as "an elegant, all-in-one stereo system that produces deep, rich base from a very small enclosure, thanks to patented, award-winning waveguide speaker technology" that "is based on controlled interaction of acoustical waves with a moving surface." (Carvajal dep. Exh. 3.) Consisting of a unit "[m]easuring about 10 inches high (18" wide and 6" deep)," such press release further states that the latest version of "the Acoustic Wave music system includes a full-featured CD player, AM/FM stereo tuner with 10 presets, and all the speaker, amplification and equalization technology to fill a room with sound" and "options [which] include a pedestal with inputs for VCR, cassette deck or other music source and [a] microphone for use as a portable public address system." (Id.) The original version of the "ACOUSTIC WAVE" product, Mr. Carvajal testified, "had a tape deck on top" because, back then, "there were no CDs." (Id. at 15.) He also noted that it was an update thereof known as the "Series II [which] had a CD player on top" and that the current version known as the "Series III ... added a remote control." (Id.)

According to Mr. Carvajal, the consumers for opposer's "ACOUSTIC WAVE" product are "anyone who loves music." (Id. at 13.) He also maintains, in his testimony about such product, that "[p]eople refer to it as the Wave machine, the Wave, Acoustic Wave," although "Wave is what people know the most about the product" due to "the Acoustic Wave Guide Technology ... [that] makes the product possible." (Id. at 10.) While the

exact sales figures for the "ACOUSTIC WAVE" product have been designated as confidential, suffice it to say that since 1984 opposer has sold over half a million units thereof, reflecting a sales volume of over half a billion dollars.¹⁰ Opposer sells its "ACOUSTIC WAVE" music system primarily through such consumer sales channels as its own website and catalog, its toll-free telephone number, and its factory direct retail stores, of which it has over 100 such outlets. It also sells the product through other catalog retailers, such as consumer audio and video equipment dealers like Crutchfield and in-flight airline gift catalogs like SkyMall. Still other sales are made through premium incentive channels in which opposer "sell[s] to large companies who use these products as ... [sales incentives for] their employees." (Id. at 14.)

Opposer uses print advertising, such as in magazines and newspapers, as its "biggest area" of product promotion. (Id. at 16.) In this regard, opposer favors publications "like U.S.A. Today, Parade where the readership is very, very large." (Id. at 17.) Opposer also utilizes "some broadcast advertising," such as radio ads, as well as direct mail and what it calls "single sheet inserts," which constitute "advertising that gets delivered to you in your mail."¹¹ (Id.) Opposer additionally advertises on

¹⁰ It is noted, however, that instead of submitting a redacted copy of its brief in order to protect the confidentiality of its sales figures as so designated in the deposition transcript, opposer's brief sets forth such amounts, along with the amounts designated in the deposition transcript as its confidential advertising and promotional expenditures, in full. See TBMP §801.03 (2d ed. rev. 2004).

¹¹ According to Mr. Carvajal, direct mail differs from single sheet inserts in that "[d]irect mail is where you have a package that you

its own website and "on what we call an affiliate website" such as Amazon.com. (Id.) Other advertising includes its own full line product catalog and third-party catalogs like the previously mentioned Crutchfield and SkyMall, along with exhibiting at trade shows such as the Consumer Electronics Show in Las Vegas. Promotion of opposer's products also occurs through technical reviews thereof published in a variety of consumer periodicals.

In his testimony, Mr. Carvajal also noted that opposer, as an accessory item, at one time offered "the multi-media pedestal[,] which was a product that let the Acoustic Wave Music System be connected to multiple devices." (Id. at 23.) Among other things, he testified in this regard that:

We ... know that the most popular thing that people connect to our Acoustic Wave Music System is the television. So that [way] people that want to get better sound from their television, they connect it to their Acoustic Wave, and some people connect MP3 players. And we know people that even connect computers to the Acoustic Wave Music System to get better sound from the computer.

(Id.) The multi-media pedestal, he further noted, became "very, very popular for us" following its introduction "probably in late '90s, 1999 or something like that." (Id.) Opposer had such accessory "in the market for a few years until we introduced the CD changer" model of its "ACOUSTIC WAVE" product, which replaced the functionality that had been offered by the multi-media pedestal. (Id.)

send to a targeted person that we have in our database" while "[s]ingle sheet inserts go to large lists that we buy or we obtain [in] different ways." (Carvajal dep. at 17.)

With respect to opposer's "WAVE" radio products, Mr. Carvajal testified that the original "WAVE" radio was introduced in 1993. In 1999, opposer introduced the "Wave Radio CD," which like its original "WAVE" radio, is "basically a much smaller version of the Acoustic Wave Music System that was designed more for smaller rooms ... like bedrooms ... [and] kitchens where you maybe have trouble fitting the large product." (Id. at 29.) Stated in round numbers (due to their nominally confidential nature),¹² opposer has sold since the introduction thereof several million units of its "WAVE" radio products, including the "Wave Radio CD" model, representing a sales volume of over a billion and a half dollars. Like the initial "ACOUSTIC WAVE" music system, the original "WAVE" radio allowed a compact disc player or, as also in the case of the later CD model, a cassette recorder, to be connected thereto as an alternative source of music and both models likewise permitted a television set to be plugged in so as to improve the quality of the TV sound.

Opposer targets essentially the same kind of consumers for its "WAVE" radios as it does with respect to its "ACOUSTIC WAVE" music system products, with the difference being the price of the goods. According to Mr. Carvajal, "[t]he Acoustic Wave Music System sells for [\$]1079, and the Wave Radio/CD sells for [\$]499" or "about half the price" of the former. (Id. at 32.) He also testified that, in selling its "WAVE" radios, opposer "use[s] the exact same channels of trade as [for] the Acoustic Wave Music System," namely, "our website, our phones through the

¹² See footnote 10.

800 number, our factory direct retail stores and catalogs, [and] our premium incentive channel." (Id. at 32-33.) Moreover, he added that "because the volume of sales of this product is so much higher because of the price point [differential], we do considerably more advertising on the Wave Radio and Wave CD than we do on the Acoustic Wave Music System." (Id. at 38.) The various kinds of advertising, however, are basically the same, with advertising of opposer's "WAVE" radios taking place through press reviews and radio programs, broadcast advertising, catalog advertising, advertisements in newspapers and national magazines such as Parade and Sports Illustrated, other print advertising and direct mail advertising. In fact, it appears that both opposer's "ACOUSTIC WAVE" music systems and its "WAVE" radios are frequently advertised together. Again, while stated in round figures (due to their nominally confidential nature),¹³ opposer has expended over several hundred million dollars combined in advertising both its "ACOUSTIC WAVE" music systems and its "WAVE" radios.

Although the "Wave Radio CD" "quickly ... became the most popular product" for opposer following its introduction in 1999, opposer upgraded such product in 2004 by replacing it with its "WAVE" music system. (Id. at 42.) Among other things, opposer "added MP3 CD playback so that customers could burn MP3 CDs and play them through the Wave Music System." (Id.) Its website, in advertising such product feature, specifically invites customers to "[l]isten to CDs created on your computer

¹³ Ibid.

and take full advantage of the new digital MP3 format to enjoy hours of uninterrupted Wave® music system quality sound."

(Carvajal dep. Exh. 20.) In addition, according to Mr. Carvajal:

The Wave Music System went to an entirely new platform which is all digital. Everything is done in the digital domain. So the equalization, the sound processing, everything is ... done in its software instructions as opposed to physical components.

(Carvajal dep. at 44.) He noted, moreover, that "the development of the Wave Music System also developed a new platform for the Wave Radio." (Id.) Known as "the Wave Radio II," such product "had the better sound and all the new features" of the Wave Music System, with "the only difference ... [being] that the Wave Radio [II] does not play CDs." (Id. at 45.) For instance, like the "WAVE" music system, opposer's website advertises among other things that "[a]n auxiliary jack lets you use your Wave® radio II for lifelike sound with your iPod or MP3 player, computer, TV or DVD player." (Carvajal dep. Exh. 16.)

Other than applicant, which he claimed to have learned about from opposer's counsel on the day before his testimony, Mr. Carvajal stated on cross-examination that he was not aware of any companies that use the word "wave" in identifying their products. While applicant's witness, Mr. Christopher Craig, testified to a few third-party uses of terms containing the word "wave," as well as to technical definitions of such word, the extent of the use of the former was not indicated and none of those uses pertains to audio products such as loudspeakers and radios. At best, as to descriptive uses, the record discloses that in the computer

software field certain sound files having the extension ".wav" are known as "wave files."

With respect to applicant, the record shows that it is a Canadian corporation incorporated in Newfoundland and Labrador on January 5, 2001. Applicant is in the audio editing software business and its president, director and principal shareholder is Mr. Christopher Craig, who founded applicant and also develops all the software which applicant sells under the mark "GoldWave." Prior to applicant's incorporation, its predecessor in title to the mark "GoldWave" was Mr. Craig, who owned such mark from its first use on May 1, 1993 until applicant's incorporation in early 2001. In promoting its mark, applicant does not use television, radio or magazine ads; instead, it advertises the goods which it sells thereunder solely on the Internet, including principally its website. Mr. Craig testified that he selected the mark "GoldWave" because the word "wave" refers to the development in the mid 1980s or thereabouts of a standard by Microsoft and IBM for storing audio in files on a computer, which "became known as the RIFF wave standard," and the term "gold" "often represents quality." (Craig dep. at 5.)

Applicant's "GoldWave" software is "a digital audio editor" (id. at 5), which according to Mr. Craig:

It can manipulate audio. It's similar to a word processor, in some respects, where you can copy and paste words around. With this program you can copy and paste sections of audio sound. You can add special effects like echo and reverb and noise reduction, similar things like that. But the program can do much more than that. It can convert audio, it can restore it, it can record it,

analyse [sic] it and do all the things that a typical audio editor wouldn't be able to do.

(Id. at 5-6.) Similarly, the "GoldWave Digital Audio Editor," as stated in the printout from applicant's "main web site," which site also "provides a bunch of links for product purchasing or to download the trial version or customer support" and "mentions that the product has been in use for over 10 years with widespread usage" (id. at 19), is touted as follows (emphasis in original):

GoldWave is a top rated, professional digital audio editor. It contains so many great features, you will be amazed by all the things it can do:

- Play, edit, mix and analyze audio
- Record audio from cassettes, vinyl records, radio, etc. through your computer's line in
-
- Record and edit audio for podcasting
- Apply special effects, such as fade, equalizer, doppler, mechanize, echo, reverse, flanger, and more
- Digitally remaster and restore old recordings with noise reduction and pop/click filters
- Make perfect digital copies of audio CD tracks ... and save them in **wav**, **wma**, **mp3** or **ogg** files
- Edit music for dance programs, figure skating, gymnastics
-
- Convert files to/from different formats, such as **wav**, **wma**, **mp3**, **ogg**, **aiff**, **au**, **vox** and even raw binary data
-

GoldWave is the most advanced and complete audio editor available in its price range. It includes all of the common audio editing commands and effects, plus powerful built-in tools such as a batch processor/converter, a CD reader, and audio restoration filters that

cost extra in other similar programs. Comprehensive, easy to use, and efficiently engineered, GoldWave offers the best value in audio editing software. With over 10 years of development and widespread usage, it has an excellent and unmatched track record.

Try the fully functional evaluation version ... of GoldWave.

(Craig dep. Exh. A-13.)

Applicant, in addition to the "GoldWave Digital Audio Editor," also presently sells the "GoldWave Voice plug-in," although details of the latter product were not provided. (Craig dep. at 9.) Applicant sells its "GoldWave" products "pretty much exclusively through the internet," that is, on-line, and by mail order directly from applicant; it does not sell its software in computer stores, department stores or mass merchandisers like Wal-Mart, on television shopping channels, or at trade shows. (Id. at 10.) As to the cost per unit of its "GoldWave" software, Mr. Craig testified that "[e]ach license costs \$45 U.S." (Id. at 26.) Such software, however, appears to be marketed as a form of shareware in that a download for trial evaluation is free while a license is offered for other usages. Although confidential, in terms of units thereof, the average number of downloads of "GoldWave" software on a monthly basis is in the neighborhood of roughly six figures; however, there is no indication as to the level of actual sales in general or sales in the United States in particular. Finally, Mr. Craig also noted that applicant does not sell loudspeakers, radios or CD systems, and stated that he has never been contacted by anyone searching for opposer's products.

Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether there is a likelihood of confusion herein, we find that confusion is likely inasmuch as each of such factors either favors opposer or is neutral; none favors applicant. In particular, starting with the *du Pont* factor of the fame of the prior marks, the evidence of record establishes that both opposer's "ACOUSTIC WAVE" mark and its "WAVE" mark are famous for their respectively associated audio products. While as shown, for instance, by opposer's registrations for its "ACOUSTIC WAVE" mark on the Supplemental Register and on the Principal Register under the provisions of Section 2(f) of the Trademark Act, as well as the fact that certain sound files having the extension ".wav" are known as "wave files," the terms "acoustic wave" for loudspeakers and "wave" for, *inter alia*, radios, compact stereo systems and portable compact disc players initially had only a merely descriptive significance in relation to the respective goods, such terms have through longstanding extensive use and widespread promotion thereof not only acquired distinctiveness, but the marks "ACOUSTIC WAVE" and "WAVE" have become famous in the marketplace for audio equipment.

As stated by our principal reviewing court in *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305-06 (Fed. Cir. 2002):

Direct evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion. Instead, our cases teach that the

fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.

....

In this case, Bose sought to prove the fame of its marks by reference to the volume of sales and advertising expenses of the products it sells and has sold under the ACOUSTIC WAVE and WAVE marks. It also sought to anchor the significance of those commercial indicia of fame with the record evidence of many widely-distributed critical assessments of the marked products that greeted their arrival in the marketplace and continued thereafter.

Based upon its review of such evidence, the court found that:

In this case, the sales and advertising numbers for ACOUSTIC WAVE and WAVE have to be seen both in the context of how the products are presented in the advertising and sales material (here with sufficient independence from the famous [BOSE] house mark) and in the context of the continuous and extensive critical consideration the marked products have enjoyed. The record, described above, gives evidence that the consuming public has been exposed frequently and nationwide to extensive descriptions of the two products. In these contexts, the sales and advertising numbers, our historic indicia of fame, are bolstered by overwhelming evidence of confirmatory context

When the full record is considered, only one conclusion can be reached regarding the fame of the Bose product marks: they are famous and thus entitled to broad protection.

Likewise, and inasmuch as the record recounted herein contains even more evidence of the extensive public recognition and renown of opposer's "ACOUSTIC WAVE" and "WAVE" marks than that described in detail in *QSC Audio Products*, supra at 63 USPQ2d 1306-07, we

are inexorably lead to the same conclusion, specifically, that such marks are indeed famous.

Furthermore, as noted by our principal reviewing court in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992), "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." The Federal Circuit reiterated these principles in *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), stating that "the fifth *DuPont* factor, fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *DuPont* factors," *citing, inter alia, Kenner Parker Toys, supra* at 22 USPQ2d 1456, and reaffirmed that "[f]amous marks thus enjoy a wide latitude of legal protection." This factor, therefore, weighs heavily in favor of opposer.

Turning next to consideration of the similarity or dissimilarity of the respective marks in their entirety as to appearance, sound, connotation and commercial impression, we find that this *du Pont* factor also favors opposer. Here, due to the shared presence of the word "wave," applicant's "GoldWave" mark incorporates the entirety of opposer's famous "WAVE" mark and a significant portion of its famous "ACOUSTIC WAVE" mark (which according to the record consumers sometimes shorten to just "WAVE"), thereby creating a substantial similarity between the respective marks, especially in view of the suggestiveness

inherent in the terms "gold" and "acoustic." As analogously stated by our principal reviewing court in *QSC Audio Products, supra* at 63 USPQ2d 1311, in finding the mark "POWERWAVE" for amplifiers and power amplifiers confusingly similar to the mark "WAVE" for, *inter alia*, "radios, clock radios, compact stereo systems and portable compact disc players" and the mark "ACOUSTIC WAVE" for loudspeaker systems and music systems consisting of a loudspeaker system, an amplifier and a radio tuner and/or compact disc player:

The presence of the root element WAVE ... introduces a strong similarity in all three marks. Whatever additional distinction may be introduced by the element of POWER in the ... POWERWAVE mark is severely limited by the fact that the mark is applied to acoustic equipment, namely amplifiers. For this reason, the overall commercial impression engendered by the use of the POWERWAVE mark also carries a strong connotation of sound waves, corresponding to the Board's findings with respect to ACOUSTIC WAVE and WAVE. Any examination of the record before the Board reveals that the "wave" portion of the Bose marks refers to sound and the unique way in which it is manipulated in the Bose products to produce the end product, sound. "Wave" thus has meaning, and in this instance the newcomer, QSC, seeks to nestle close to the fame-benefited Bose marks.

....

On the record before us, we conclude that a proper evaluation of the similarities of the QSC and Bose marks in their entirety weighs in favor of a finding of a likelihood of confusion.

The same is likewise true in this case. While the term "gold" adds a laudatory element to applicant's "GoldWave" mark which is absent from opposer's "WAVE" and "ACOUSTIC WAVE" marks, such a difference is nonetheless severely limited by the fact

that applicant's mark is applied to "computer software for audio editing," a product which the record shows can edit, among other things, wave files or sound recordings for transfer to and playback from CDs or compact discs. In view thereof, the overall commercial impression engendered by use of the "GoldWave" mark also carries a strong connotation of sound waves, corresponding to the sound waves suggested by the term "wave" in connection with the sound reproduction products marketed under opposer's "ACOUSTIC WAVE" and "WAVE" marks, including the unique way in which such products manipulate sound waves to produce the end result of high fidelity sound. The word "wave" thus has meaning, in terms of its audio or sound significance, in relation to both applicant's product as well as opposer's goods. In consequence thereof, the marks at issue herein are so substantially similar in overall sound, appearance, connotation and commercial impression that, if used in connection with the same or related goods, confusion as to the source or sponsorship of such products would be likely to occur. The factor of the similarity between the parties' marks accordingly favors opposer.

With respect to the *du Pont* factor of the similarity or dissimilarity and nature of the goods as described in the opposed application or in connection with which a prior mark is in use, it is well settled that the goods at issue in a proceeding such as this need not be identical or directly competitive in order for there to be a likelihood of confusion. It is sufficient, instead, that the goods at issue are related in some manner and/or that the circumstances surrounding their marketing are

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such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984); Dan Robbins & Associates, Inc. v. Questor Corp., 599 F.2d 1009, 202 USPQ 100, 104 (CCPA 1979) ["marks need not be used on directly competing goods, any relation likely to lead purchasers into assuming a common source being sufficient"]; Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, while opposer's goods are audio products used for reproducing sound and applicant's product is computer software for audio editing, the respective goods are nevertheless related in that the record confirms that they are complementary products used in connection with listening to sound, such as music. The record makes clear that both opposer's "ACOUSTIC WAVE" music system and its "WAVE" radio are marketed in versions which can play CDs or compact discs. Although applicant's product does not play compact discs or reproduce sound for listening, its computer software for audio editing allows for music or other sound files, including wave files or MP3 format files, to be collected, manipulated further (if desired) for audio effects and, through the use of a CD burner, copied to a compact disc, which can then be played in opposer's goods in

order for the listener to enjoy the assertedly better sound reproduction quality provided by such goods. Moreover, through the use of a pedestal accessory or an auxiliary jack, opposer's "ACOUSTIC WAVE" music systems and its "WAVE" radios and music systems allow a computer to be connected thereto for more lifelike sound from the audio files created and/or stored on a computer through, for instance, the use of applicant's audio editing software, which among other things allows audio from cassettes, vinyl records and the radio to be converted to files playable directly from the computer. Plainly, in view thereof, applicant's product and opposer's goods are similar in that they are related, complementary products. The *du Pont* factor of the similarity or dissimilarity and nature of the goods therefore favors opposer.

Furthermore, the associated *du Pont* factor of the similarity or dissimilarity of established, likely-to-continue trade channels also favors opposer. In particular, with respect to the Internet, opposer advertises and offers its "ACOUSTIC WAVE" and "WAVE" audio products at its website, while applicant likewise does the same with respect to its "GoldWave" computer software for audio editing, which is available for trial use or purchase from its website as well as certain third-party websites.

Of the relevant *du Pont* factors which remain, such are at best neutral and none favors applicant. In particular, as to the number and nature of similar marks in use on similar goods, opposer's witness testified that he was not aware of any

companies (other than applicant) that use the word "wave" in identifying their products, while applicant's witness testified to only a few third-party uses of terms containing the word "wave." However, as previously noted, the extent of such use was not indicated and none of the third-party uses identified pertains to audio products such as loudspeakers, radios or the like.

Furthermore, as to the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion, applicant stressed at oral hearing that the record shows that there have been no reported incidents of actual confusion during a period of approximately 14 years of contemporaneous use by the parties of the marks at issue. While it is the case that the absence of any instances of actual confusion over a significant period of time may be indicative of no likelihood of confusion, such an absence is meaningful only where the record demonstrates appreciable and continuous use by the defendant of its mark in the same market(s) as those served by the plaintiff under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); and *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 541 (TTAB 1979). Moreover, and in particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

Here, however, the evidence relating to use establishes that, in the case of applicant's "GoldWave" computer software for audio editing, such product is available as a trial version which potential buyers of a license to use the full-featured version can download and use for free. Thus, although the average number of units of "GoldWave" software downloaded on a monthly basis, which as noted previously is in the neighborhood of around six figures according to the most recent confidential information furnished by Mr. Craig, would seem to be substantial, there is no indication as to the percentage of free downloads or level of licensed sales *in the United States*. Moreover, even assuming that most of the downloads of applicant's software are by trial users thereof in the United States and thus involve no licensing fee, if those trial users of the free version of applicant's "GoldWave" audio editing computer software were, for instance, to become dissatisfied with the fact or otherwise learn that opposer was not the source of applicant's product as they had assumed when deciding to try such product or while using it, it seems that they would be unlikely to complain, either to applicant or opposer, inasmuch as the cost of their use thereof was nothing. The absence, therefore, of any reported incidents of actual confusion is of little probative value in this case and does not serve as a mitigating factor which favors applicant. See, e.g., *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 231 USPQ 913, 918 (10th Cir. 1986) [evidence of absence of incidents of actual confusion "does not necessarily support a finding of no likelihood of confusion, especially when the products involved

are inexpensive" because "[p]urchasers are unlikely to bother to inform the trademark owner when they are confused about an inexpensive product" (*italics in original*)]; *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 188 USPQ 623, 639 (7th Cir. 1976) ["when products ... are low value items ... purchasers are unlikely to complain when dissatisfied"]; and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1212 (TTAB 1999) ["given the relatively inexpensive nature of the menu items at applicant's restaurants, and the obviously inexpensive nature of registrant's [Mexican] food products, we wonder if purchasers would even be aware of their confusion, and if they were, whether they would take the trouble to inform either of the trademark owners"].

In view of the above, we conclude that contemporaneous use by applicant of the mark "GoldWave" in connection with its "computer software for audio editing" is likely to cause confusion with opposer's use of the substantially similar marks "ACOUSTIC WAVE" for "loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape player" and "WAVE" for, *inter alia*, "radios, clock radios, ... compact stereo systems and portable compact disc players."

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