

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT
OF THE TTAB

MAY 20, 1998

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *The Selmer Company, Inc.*

Serial No. 74/652,795

Timothy D. Pecsénye of Blank, Rome, Comisky & McCauley for *The Selmer Company, Inc.*

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(*Sidney I. Moskowitz*, Managing Attorney).

Before *Cissel*, *Seeherman* and *Hohein*, Administrative Trademark
Judges.

Opinion by *Hohein*, Administrative Trademark Judge:

The Selmer Company, Inc. has filed an application to register the mark "BLACK BEAUTY" for "percussion instruments; namely, snare drums".¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the

¹ Ser. No. 74/652,795, filed on March 29, 1995, which alleges dates of first use of 1923.

mark "BLACK BEAUTY COWBELL," which is registered for "musical instruments, namely, cowbells,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

Determinative of this appeal is the effect to be given to a consent agreement entered into between applicant and the owner of the cited registration. As the Examining Attorney notes in her brief, it is clear that, except for the generic term "COWBELL" in registrant's mark, the respective marks are identical and create the same commercial impression when used in connection with such musical percussion instruments as cowbells and snare drums. Moreover, the Examining Attorney has demonstrated that cowbells and snare drums are closely related goods by furnishing not only copies of five use-based third-party registrations, but also copies of two use-based registrations respectively owned by applicant and registrant.³ Such registrations, in each instance, show that the owners thereof have adopted and registered the same mark for both cowbells, on the one hand, and drums or drum outfits, on the other hand.

² Reg. No. 1,120,473, issued on June 19, 1979, which sets forth dates of first use of January 1967.

³ Specifically, the record shows that applicant is the owner of a registration for the mark "MATADOR" and design for "percussion musical instruments, namely[,] drums ... [and] cowbells," while registrant is the owner of a registration for the mark "LUDWIG" for "percussion musical instruments and accessories--namely, drum outfits, ... cowbells"

While we note that the registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, it is nevertheless settled that they have some probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6. Moreover, since neither the identification of goods in applicant's application nor that in the cited registration contains any limitations as to the manners of distribution or types of buyers for snare drums and cowbells, it must be presumed that such musical percussion instruments move in all channels of trade which would be normal therefor and that they would be purchased by all potential buyers of those types of products. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

In view thereof, and inasmuch as a cowbell is a common accessory for a drum set, which typically would include a snare drum, it is clear that cowbells and snare drums are likely to be sold in the same channels of trade to the same consumers and may frequently be purchased together. Thus, in the absence of facts which would be reflected, for example, in a sufficiently detailed consent agreement and which establish that marketplace experience has been to the contrary, it is plain that contemporaneous use of essentially the same marks for such closely related percussion musical instruments as snare drums and cowbells would be likely

to cause confusion, mistake or deception as to the origin or sponsorship of those products.

Applicant, in support of its position that confusion is not likely, has submitted a consent agreement, entered into as of March 21, 1996, in which applicant and registrant (respectively referred to therein as "Selmer" and "LP") have provided, inter alia, that:

WHEREAS, LP is the owner of the mark BLACK BEAUTY COWBELL and U.S. Registration No. 1,120,473, which registered on June 16, 1979 for "musical instruments - namely, cowbells" (hereinafter referred to as the "LP Mark"); and

WHEREAS, Selmer is the owner of the common law trademark BLACK BEAUTY when used in connection with snare drums (hereinafter referred to as the "Selmer Mark") and has now filed U.S. Trademark Application Serial No. 74/652,795 for BLACK BEAUTY for "percussion instruments; namely, snare drums"; and

WHEREAS, the parties have not experienced any confusion, wish to avoid any likelihood of confusion, save costs and expense, yet recognize the specific uses each party has made of its own mark and resolve any potential controversy.

NOW, THEREFORE, in order to carry out the purpose and intent of this agreement and in consideration of the agreements and undertakings hereinafter set forth, the parties agree as follows:

1. The parties agree that the above recitals are true, correct, and are hereby incorporated in this Agreement

2. LP agrees that Selmer shall continue to use the Selmer Mark for snare drums, and acknowledges that such use has not lead [sic] to a single instance of actual confusion or alleged confusion.

3. Selmer agrees that LP shall continue to use the LP Mark for musical instruments - namely, cowbells, and acknowledges that such use has not lead [sic] to a single instance of confusion or alleged confusion.

4. This agreement shall not preclude either party from expanding its use of the mark BLACK BEAUTY in other areas, provided that LP does not use the Selmer Mark and Selmer does not use the LP mark.

5. This agreement shall inure to the benefits of and be binding upon the parties and their respective licensees and assigns and all other acting by, through or in privity with them.

6. This Agreement shall not be assignable by either party without the prior written consent of the other party herein.

7. Both parties agree that this Agreement may be submitted to the United States Patent and Trademark Office ("PTO"), if necessary. The parties further agree to assist each other if additional documents or instruments are required for submission to the PTO in order to carry out the purpose and intent of this Agreement.

....

11. This Agreement is the complete and final expression of the parties regarding the LP Mark and the Selmer Mark. There are no other agreements, understandings, representations, or warranties, oral or written, between the parties regarding the subject matter of this Agreement

The Examining Attorney, relying principally upon *In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) and *In re U.S. Shoe Corp.*, 8 USPQ2d 1938 (TTAB 1988), argues that the agreement "is nothing more than a 'naked' consent, entitled to little weight in the likelihood of confusion analysis," "because it fails to address those considerations which should be present

in a well-reasoned consent, i.e., arrangements the parties have undertaken to avoid confusion to the public and agreements to cooperate in the future to eliminate or minimize future confusion." Specifically, while acknowledging that substantial weight should be given a more detailed agreement of the type involved in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the Examining Attorney maintains that the consent agreement in this case "is not 'detailed' in the sense envisioned in *DuPont*" since it "speaks to the rights of the parties, and is silent as to the likelihood of confusion to the purchasing public." This case, the Examining Attorney insists, is thus unlike the consent agreement presented in *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993), which assertedly "had substantially more detail than the Consent Agreement at issue here."

In particular, the Examining Attorney contends in this regard that (footnote omitted):

Well reasoned consent agreements address various consideration, including the reasons the parties believe there is no likelihood of confusion, i.e., differences in goods/services, the marks, the channels of trade and the consuming public. The examining attorney asserts that the applicant's Consent Agreement does not refer to these considerations because the marks at issue are virtually identical and the goods are highly related and travel in the same channels of trade.

A true consent should include a specific plan to avoid future confusion, such as limitations on promotions and manner of distribution, advertising and product packaging, etc., as well as an agreement

between the parties to take further action needed to carry out the intentions of the original consent agreement, namely, executing additional agreements in the future as needed. See, e.g., *In re Donnay International, Societe Anonyme*[,] 31 USPQ2d 1953 (TTAB 1994). Instead, applicant's Consent Agreement states:

This agreement shall not preclude either party from expanding its use of the mark BLACK BEAUTY in other areas, provided that LP does not use the Selmer Mark and Selmer does not use the LP mark.

(emphasis added)

The examining attorney asserts that this language leaves the applicant free to use the mark BLACK BEAUTY on cowbells and the registrant free to use the mark BLACK BEAUTY COWBELLS [sic] on snare drums.

In the instant case, the Consent Agreement cannot persuade because it merely presents the lack of actual confusion in a formal manner, and does nothing to obviate the potential for future confusion. In making decisions regarding likelihood of confusion, the examining attorney and the ... Board should defer to the greater knowledge of actual market participants when it is offered. In this case, the Consent Agreement offers no such knowledge; it provides no information or advice to assist the Board in making a decision regarding likelihood of confusion.

We are constrained to agree with applicant, however, that in light of such background factual considerations as a period of contemporaneous use of the respective marks for over 30 years, the differences in the goods, the fact that their retail costs indicate that the products are not impulse items, and the discrimination and care exercised in the purchase of musical

percussion instruments,⁴ the consent agreement between applicant and registrant is sufficient to support a finding that confusion is not likely. As applicant persuasively points out, *Mastic* "is readily distinguishable on its facts from this case" inasmuch as (i) the application involved therein "was based solely on treaty rights with Canada, and not on a preexisting use in United States commerce," and thus the applicant therein had "no way of knowing whether confusion had or would occur in the American marketplace if it were allowed to register its mark"; (ii) the agreement in such case "consented only to the registration of the mark, and not to its use"; and (iii) the consent agreement therein "did not evidence a 'bilateral agreement' to restrict the parties['] use of the mark involved." Here, by contrast, applicant and registrant, as applicant notes, have been using their respective marks for over 30 years without any reported instances of actual

⁴ We recognize that, aside from the differences in the goods (which are apparent from the very nature of such items), none of the above facts is set forth either in the consent agreement or in an affidavit from an officer or other employee of applicant having personal knowledge thereof. Instead, such facts as there having been a 30-year period of contemporaneous use of the respective marks and that one of applicant's snare drums "would cost at a minimum between \$450-700" are set forth in various statements offered by applicant's counsel in either applicant's request for reconsideration and/or initial brief. However, inasmuch as the Examining Attorney has raised no objections to consideration of such facts and has apparently accepted them, we consequently have treated such facts as being established. As stated in *In re National Distillers & Chemical Corp.*, 297 F.2d 941, 132 USPQ 271, 274-75 (CCPA 1962) (footnote omitted):

When counsel for applicant made allegations of fact in signed responses to the Patent Office actions, he certified, under ... the Trademark Rules of Practice, that "there is good ground to support them". While such statements are not "evidence" of the facts stated, it seems to us that ... [w]here, as here, no objection was made to the statements of counsel and the examiner acted upon them, ... such statements have in legal effect become the equivalent of competent evidence.

confusion; their consent agreement "explicitly covers the use of the marks by their respective holders"; and "the consent agreement in this case specifically envisions that the parties will not use the other's mark for any reason whatsoever and that they will cooperate so that ... [applicant's] mark may be registered."⁵

Moreover, unlike *U.S. Shoe*, in which the marks involved had been in contemporaneous use for no more than a few years at best, this case is closest to *In re Palm Beach Inc.*, 225 USPQ 785, 787-88 (TTAB 1985), in which the Board, in finding that confusion was not reasonably likely to result from use of the mark "ADLER" and design for pants and the mark "ADLER" for knitted socks, reasoned that:

As noted by the Examining Attorney, the letters of consent in the present case do not include any restrictions limiting applicant and registrant to diverse markets, nor do they contain any recitation of steps to be

⁵ We hasten to note, however, that we are not pleased by applicant's failure to include citations to the United States Patents Quarterly, First and Second Series, in those instances where the precedent applicant cites also appears in the Federal Reporter, Second Series. Citation to the former should always be provided. We would be remiss, moreover, if we did not express our displeasure with applicant's counsel's overzealous advocacy in this matter. Specifically, we note that in arguing that "the extent of potential confusion is de minimis," counsel asserts in applicant's initial brief that "[t]his very issue was succinctly discussed by the Court of Customs and Patent Appeals in the case of In re National Distillers & Chem. Corp., 297 F.2d at 949-50 (emphasis added), where the court reasoned that:" (quotation omitted). The quoted language which immediately follows (spanning pages 13 and 14 of applicant's initial brief) is not, however, from the opinion of "the court" in such case; rather, it appears in the concurring opinion of Judge Rich, 132 USPQ at 278. While apparently inadvertent, counsel's reference to such language as being from the majority opinion in *National Distillers* nevertheless gives a distorted and misleading impression, particularly in view of the fact that that case also provoked a dissenting opinion. Counsel is advised, therefore, to exercise greater care and attention to detail in the future.

taken by applicant and registrant to preclude conflict. Nevertheless, considering the letters of consent and the affidavit of Mr. Milton Adler, President and founder of applicant's subsidiary Adler Pants Co., in light of the other facts and circumstances in this case, we are convinced that there is no reasonable likelihood of confusion. In this regard, we note that while the respective marks of applicant and registrant are substantially similar, and their goods are closely related (facts which, taken alone, serve as an indication that confusion may be likely), still, pants and knitted socks are specifically different items of clothing which are normally displayed in different sections of the stores in which they are sold. Added to the specific differences in the goods are certain other, very persuasive, evidentiary factors, namely, the more than forty-five years of contemporaneous use of the respective marks of the parties without any known instances of confusion, the belief of applicant and two successive owners of the cited registration that there is no likelihood of confusion by reason of the continued use of the marks, and the willingness of both of the successive owners of the cited registration to consent to applicant's use and registration of its mark "ADLER" and design for pants.

Having considered the entire record, we can only conclude that there is no real likelihood of confusion. The fact that the parties have used their marks contemporaneously for more than forty-five years without any known instances of confusion is strong evidence that confusion is not likely to occur as a result of continued use of the marks in the future. Cf. *In re American Management Associations*, supra. Certainly, it gives credence to the belief of the parties themselves that there is no likelihood of confusion.

Similarly, while the consent agreement in this case is hardly a model of detail,⁶ it nevertheless is plainly more than a

⁶ Clearly, had applicant and registrant chosen to elaborate upon such facts as the nature of the channels of trade for their respective

mere "naked" consent. Although sketchy in places, the agreement recites each party's ownership of their marks for their respective goods; sets forth the critical facts that the parties have not experienced a single instance of actual confusion resulting from the use of such marks, desire to avoid any likelihood of confusion and wish to resolve any potential controversy; and provides for the parties to assist each other if any further documents or instruments are necessary for submission to the Patent and Trademark Office in order to carry out the intent and purpose of the agreement, which obviously encompasses the securing of a registration by applicant for its "BALCK BEAUTY" mark for snare drums.⁷ Furthermore, the lack of any explicit arrangements to avoid a likelihood of confusion in the future is perhaps understandable, given the absence to date of any incidents of actual confusion, and the agreement plainly contemplates that each party will continue with the marketing methods and distribution channels they have been using to sell their cowbells and snare drums under their respective marks.

products, the circumstances under which their goods have and continue to be sold, the reasons why they believe there have been no known instances of actual confusion over a 30-year period and what specific steps they would take if an incident of actual confusion should arise, the agreement itself would be more persuasive and the prospects for avoiding the delay inherent in an appeal of a refusal to register would have been substantially enhanced.

⁷ Although, as the Examining Attorney accurately observes, the agreement does permit the parties to expand "use of the mark BLACK BEAUTY in other areas," we think it is highly doubtful, due to the presence of the generic term "COWBELL" therein, that registrant would apply its "BLACK BEAUTY COWBELL" mark to snare drums, nor would applicant be motivated to expand the use of its "BLACK BEAUTY" mark to cowbells, given the inherent likelihood of confusion which would result therefrom. We simply do not read the consent agreement as sanctioning use of marks which the parties know or should know would result in a likelihood of confusion, given the provisions that each

Finally, it is clear that the parties are aware of the underlying factual circumstances under which applicant's "BLACK BEAUTY" snare drums and registrant's "BLACK BEAUTY COWBELL" cowbells have been sold for over 30 years. These circumstances, as applicant points out in its brief, include a specialized retailing environment (musical instrument stores rather than department stores or other mass merchandisers) in which individualized attention is paid by store clerks to careful and discriminating consumers seeking to buy relatively expensive musical percussion instruments. The consent agreement, when read in light of this factual background, is sufficiently detailed to be decisive. As set forth in *du Pont*, supra at 568:

The weight to be given more detailed agreements of the type presented here should be substantial. It can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in causing public confusion.

Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

Accordingly, in light of the fact that applicant and registrant have not encountered any incidents of actual confusion in over 30 years of conjoint use of essentially identical marks for closely related musical percussion instruments, their

party is permitted to continue its existing use, but is prohibited

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marketplace experience minimizes any doubt and is compelling evidence that confusion as to source or sponsorship is not likely to occur.

Decision: The refusal under Section 2(d) is reversed.

R. F. Cissel

E. J. Seeherman

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board

from using the other's mark.