

Hearing:
January 13, 2000

**THIS DISPOSITION
IS CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 60
ejs

8/17/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hard Rock Cafe International (USA), Inc.

v.

Thomas D. Elsea

Opposition No. 101,304
to application Serial No. 74/593,528
filed on November 1, 1994

Ralph W. Kalish, Jeffrey J. Kalinowshi and B. Michelle Ward
of Peper, Martin Jensen Maichel & Hetlage for Hard Rock Cafe
International (USA), Inc.

James L. Etheridge and Franklin D. Ubell of Price, Gess &
Ubell for Thomas D. Elsea

Before Cissel, Seeherman and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Hard Rock Cafe International(USA), Inc.¹ has opposed
the application of Thomas D. Elsea to register COUNTRY ROCK
CAFE as a trademark for "clothing, namely T-shirts, jackets,

¹ The notice of opposition was filed by Hard Rock Café Licensing Corporation. This company was subsequently merged into Hard Rock Cafe International (USA), Inc., and the merger was recorded with the Patent and Trademark Office. The Board thereafter granted

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sweatshirts, caps, hats, vests, bandannas, pants and undergarments."² Mr. Elsea seeks registration pursuant to Section 2(f) of the Trademark Act.

As grounds for opposition, opposer alleges that it is the owner of various registrations for the mark HARD ROCK CAFE and other HARD ROCK marks for, inter alia, T-shirts, sweatshirts, polo shirts, sport shirts, jackets and hats, and for restaurant services; that since prior to November 1, 1994, the filing date of the opposed application, opposer has used its marks continuously in connection with the sale of its restaurant services, clothing items, jewelry and glassware items; that opposer's marks have become well known and have acquired distinctiveness; and that, because of the similarities of the marks, applicant's use of the mark COUNTRY ROCK CAFE for his identified services is likely to cause confusion or mistake or deception.

In his answer, applicant has admitted that, for many years, opposer has engaged in the United States in the business of restaurant services and selling clothing, including T-shirts, jackets and sweatshirts, jewelry and beverage glassware. He has denied the remaining salient allegations of the notice of opposition. Applicant also

opposer's motion to substitute, as a result of which Hard Rock Cafe International (USA), Inc. is now referenced as the opposer.
² Application Serial No. 74/593,528, filed November 1, 1994 and asserting first use and first use in commerce as of October 1, 1993.

asserted, as "affirmative defenses," elaborations as to why he believes confusion is not likely.

The case has been fully briefed, and both parties were represented at a hearing before the Board.

Both parties have filed numerous objections to each other's submissions and, indeed, applicant has objected to almost every exhibit, and much of the testimony, submitted by opposer. Therefore, in order to indicate what material has been considered to be of record, we will rule on the various objections.

First, during its main testimony period, opposer took the testimony of Michael Robert Coutu, opposer's Senior Vice President of Business Development. With this testimony opposer identified and sought to have entered 15 exhibits, including 176 sub-exhibits which were identified as exhibits 8 A through D. These 176 exhibits had previously been submitted in connection with a prior proceeding between the same parties, involving the mark COUNTRY ROCK CAFE and design for, inter alia, clothing. See **Hard Rock Cafe Licensing Corp. v. Elsea**, 48 USPQ2d 1400 (TTAB 1998). The 176 exhibits had been submitted under a notice of reliance in the prior proceeding, but in the present case, although opposer identified their submission as being a "Notice of Reliance," in fact they were submitted as exhibits to the Coutu testimony deposition.

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During the course of Mr. Coutu's deposition, applicant objected to virtually all of the exhibits and sub-exhibits, as well as to much of Mr. Coutu's testimony.

Some nine months after the taking of Mr. Coutu's testimony on September 11, 1997, the Board issued its decision in the prior proceeding. That decision made rulings on applicant's objections to the 176 exhibits submitted in that case, and involved an exhaustive discussion as to the bases on which the objections were either sustained or overruled. Three months after that decision, opposer filed its main brief in the present case and, presumably in light of the Board's rulings in the previous decision, opposer specifically withdrew its sub-exhibits 2, 3, 5, 6, 10, 12-16, 21-23, 30-38, 40-44, 46, 48-50, 52, 53, 55, 56, 58-63, 65-73, 75-88, 90-94, 96-99, 102, 104, 105, 112, 114, 115, 117-123, 137-155 and 163. These sub-exhibits, as noted above, had been objected to by applicant during Mr. Coutu's deposition.

Notwithstanding opposer's withdrawal from consideration of these exhibits, or the Board's ruling in the prior proceeding, applicant nevertheless filed on October 16, 1998, at the same time he filed his brief on the case, his "objections to opposer's evidence in its notice of reliance marked at the Coutu deposition." This document objects to all of the sub-exhibits 1-155 and 165-176. It is obvious

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that this document, except for the first page, is the same document applicant submitted in the prior proceeding. It actually bears a signature date of October 14, 1996, which is prior to the date of the Coutu deposition.

The Board regards with great disfavor applicant's apparent disregard of the withdrawal of many of opposer's exhibits, as well as the rulings of the Board on these same objections in the prior proceeding. It is a waste of judicial resources for applicant to raise objections to exhibits which have been withdrawn, or to exhibits which the Board had previously ruled were acceptable where the factual basis for accepting them remains the same in the present case. Because it seems that counsel for applicant has paid no attention to the Board's prior discussions as to why particular exhibits are acceptable, we will not further engage in an attempt to educate applicant's attorney as to why his objections are overruled. Instead, we will make a summary disposition as to the various objections.

Applicant's objections to the main exhibits 1-7 and 9-15 submitted with the Coutu deposition are overruled, as are the objections to the testimony itself. As to sub-exhibits 1-176, submitted as part of main exhibit 8 A-D, the objections to sub-exhibits 1, 7-9, 11, 17-20, 24-29, 39, 45, 47, 51, 54, 57, 64, 89, 95, 100, 101, 103, 106-111, 113,

156-162,³ 164, and 168-175 are overruled.⁴ We sustain the objections to sub-exhibits 74, 116, 125, 126 and 129-136 because the articles are from foreign publications, and to sub-exhibits 4, 124, 127 and 128 because it is not clear whether the articles are from foreign publications, and there is no indication as to whether they have had any exposure in the United States.

In its response to applicant's objections to sub-exhibits 1-176 opposer withdrew sub-exhibits 165-167. Accordingly, we need not rule on the objections to these exhibits. Further, although during the course of Mr. Coutu's deposition and in applicant's objections to the sub-exhibits reference was made to an Exhibit 176, no such exhibit has been submitted to the Board, and in its response to applicant's objections opposer has not discussed the objection to Exhibit 176, and makes no mention of Exhibit 176 in its listing of the exhibits for which applicant's

³ The probative value of these registrations are discussed infra.

⁴ Because the sub-exhibits were submitted as part of the testimony of Mr. Coutu, many of the exhibits which were found, in the prior proceeding, to be incapable of being made of record under a notice of reliance, are acceptable in this case as exhibits to the testimony deposition. For example, certain of the sub-exhibits which are articles would not be acceptable if submitted under Trademark Rule 2.122(e) as printed publications, and were consequently not accepted in the prior proceeding. In this case, however, these sub-exhibits were submitted with the testimony of Mr. Coutu, and he testified that they were provided by clipping services subscribed to by opposer in the regular course of business. See **Polo Fashions, Inc. v. La Loren, Inc.**, 224 USPQ 509 (TTAB 1984).

objections are requested to be overruled. Accordingly, that exhibit has been given no consideration.

In addition to the testimony deposition of Mr. Coutu, opposer took, during the period for its testimony-in-chief, the deposition of applicant. This testimony deposition, with a single exhibit, forms part of the record.

In support of his case, applicant has submitted a copy of his testimony deposition, with exhibits, taken in connection with the prior proceeding.⁵ The Board granted applicant's motion to use such testimony on May 4, 1999. Opposer has objected, in its main trial brief, to Exhibits 2-10 in anticipation of applicant's reliance on these exhibits for the truth of the matters asserted therein, and reiterated such objections to Exhibits 2-7 in its reply brief. Exhibits 2-7 are magazine and newspaper articles and are admissible to show publicity for applicant's services, in the same manner that the various newspaper articles submitted by opposer are admissible, but only for this purpose. They have not been considered as proving the truth of the statements made therein. Exhibits 8, 9 and 10 are, respectively, a jacket bearing applicant's logo, a promotional calendar for applicant's establishment, and a menu for the establishment. We are not entirely sure how

⁵ Although opposer objected during the deposition to Exhibit 11, it did not maintain this objection in its brief on the case, and we therefore deem the objection to have been withdrawn.

opposer's objections pertain to these exhibits, but we have not viewed the calendar as actually proving, for example, that March 1, 1994 was in fact "Swinging with Sebastiani Wines" night at applicant's club, or that applicant actually did sell a C.R.C. Burger for \$3.99.

Applicant also submitted, under a notice of reliance, certain telephone directory listings, a dictionary definition, and copies of papers referencing the companion opposition proceeding we have mentioned above. In connection with the latter documents, Exhibit 27 is acceptable for submission under a notice of reliance because it is a copy of the Board's decision on the parties' cross-motions for summary judgment, and constitutes an official record under Trademark Rule 2.122(e). However, Exhibit 28, which purports to be a copy of applicant's brief in support of its summary judgment motion, does not reflect that it was received by the Patent and Trademark Office. Because it appears to be merely applicant's file copy of the document, it does not constitute an official record, and has not been considered. See **Osage Oil & Transportation, Inc. v.**

Standard Oil Co., 226 USPQ 905 (TTAB 1985); TBMP § 707.

Opposer has objected to the telephone directory listings, exhibits 1-21, on various grounds. Those objections are overruled. Although the businesses are either listed under

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"Restaurants" or appear to be restaurants because of the use of "Cafe" in their business names, third-party usage for restaurant services is not irrelevant because, as discussed below, both opposer and applicant offer restaurant services and sell their apparel within the restaurant establishments. As for opposer's objections that no information has been provided as to the number of customers, trading areas, etc., that goes to the probative weight to be accorded the listings, not whether they may be considered.

Applicant also submitted, under a separate notice of reliance, color copies of certain of the exhibits introduced during the Elsea deposition. These form part of the record because they are exhibits to the Elsea deposition, and need not meet the requirements for submission of materials under a notice of reliance.

During its rebuttal testimony period, opposer submitted the depositions, with exhibits, of Tony Gallo and David Gust and, under a notice of reliance, 205 exhibits consisting of articles taken from various periodicals.

Applicant has objected to each of the exhibits submitted with the notice of reliance. To the extent that the articles have been submitted to show the fame of opposer's mark, applicant's objections are well taken. Fame is an element to be proved as part of opposer's case-in-chief, not during the rebuttal testimony period. However,

to the extent that the articles have been submitted to rebut applicant's evidence that his restaurant and associated services and goods appeal to a different group of customers than do opposer's, they are acceptable rebuttal.

Accordingly, the exhibits identified by opposer in its reply brief as consisting of articles referencing both opposer's establishments and country music entertainers, or articles appearing in country-oriented publications, or articles in publications in which applicant's establishment has been mentioned, have been considered. Applicant's objections as to Exhibits Nos. 21, 32, 35, 42-44, 46-48, 54, 57-60, and 137 are overruled, and his objections to the remaining exhibits submitted with the notice of reliance are sustained.⁶

Applicant has objected to the entire testimony deposition of Mr. Gust as improper rebuttal, and has also objected to much of this testimony and the exhibits submitted therewith as lacking foundation and being hearsay. Applicant's objections are sustained to the extent that evidence as to the numbers of HARD ROCK CAFE establishments,

⁶ Exhibits 37 and 38, although they refer to a country music singer at the Hard Rock Cafe, are not articles, but appear to be transcripts of TV mentions, provided by a clipping service. As such, it does not constitute a printed publication within the meaning of Trademark Rule 2.122(e). Exhibit 39 has not been considered because it is an article from a foreign publication, and there is no indication as to whether it has had any exposure in the United States.

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and opposer's sales and advertising, are elements of opposer's case-in-chief. However, Mr. Gust's testimony, with related exhibits, as to the types of music connected with opposer's establishments, the country music singers who have appeared at or visited opposer's restaurants, and opposer's sponsorship of rodeos, have been considered, since this evidence is in rebuttal to applicant's evidence that the parties' establishments cater to different classes of consumers. Applicant's hearsay objections with respect to this particular testimony, and exhibits related thereto, are overruled.

Applicant has also objected to the entire testimony deposition of Tony Gallo as being beyond the scope of proper rebuttal. This testimony relates to a survey taken by opposer with respect to public awareness of the HARD ROCK CAFE restaurants. Because evidence of such awareness goes to the fame of the mark, it is properly part of opposer's case-in-chief. The objection is sustained.

Finally, on July 14, 1998 opposer submitted, under a notice of reliance, a document submitted to the Patent and Trademark Office requesting recordation of the merger of Hard Rock Cafe Licensing Corporation, the original opposer, into Hard Rock Cafe International (USA), Inc. This document was relied upon by opposer in connection with its motion to substitute Hard Rock Cafe International (USA), Inc. as

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opposer. In its brief, filed October 16, 1998, applicant objected to this document as well. It was not necessary for opposer to even file this document under a notice of reliance, since it serves only to support the motion for substitution. Moreover, the Board previously considered the merger document, and the motion for substitution was granted on August 21, 1998.

Turning to the facts established by the parties in this case, the record shows that opposer is engaged in rendering restaurant services throughout the world under the trademarks HARD ROCK CAFE and HARD ROCK CAFE with various designs. Opposer's classic logo, which is generally used, is shown below.



The HARD ROCK CAFE establishments consist of full service restaurants as well as souvenir retail shops which are attached or included in the restaurant set-up. The shops sell a core line of T-shirts, sweatshirts, baseball caps, polo shirts or golf shirts, jackets, jewelry such as pins and watches, fanny packs, backpacks, and lighters.

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The HARD ROCK CAFE mark was adopted in 1971, and operations began in London. Since that time, operations have expanded throughout the world, and as of 1997 there were 81 establishments worldwide, with 28 located across the United States, in such cities as New York, Chicago, Nashville, Miami, Dallas, Las Vegas, Phoenix, Los Angeles and San Francisco. Revenue from its establishments in the United States were forecast to amount to \$350 million for 1997, of which 52% comes from merchandise sales, and 48% from food and beverage, i.e., restaurant sales. T-shirts sales account for approximately 60% of opposer's merchandise revenue. In its Newport Beach, California establishment alone, opposer's revenue from its merchandise sales is in the \$2-3 million range per year. Many of the customers at opposer's restaurants are from out of town, and it is the sales to such tourists that drive the merchandise sales. The merchandise is specific to the city in which the restaurant is located, e.g., the HARD ROCK CAFE T-shirt sold in the New York establishment will bear the name "New York" below the logo, while the T-shirt sold in the Chicago store will have the name "Chicago." This is a major factor in making the merchandise collectible.

Opposer advertises its establishments in the United States through billboards, radio, television, and print media, including rack cards, magazines in hotel rooms, and

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hotel concierge pamphlets. Opposer's marketing efforts include negotiating contracts with tour groups, and finding local opportunities to bring people into the cafe. Opposer promotes its operations through music celebrity associated events, press releases, live performances in the cafe, and charitable community service. For example, one of the HARD ROCK CAFE establishments may be the site of a launch party for a musical artist's new album, or to announce a new tour by a band. Opposer may also cater the food backstage at a concert; at the Farm Aid fundraising concert, opposer set up a giant tent for three days, and was a prominent presence. In 1994 opposer spent \$1.4 million for its various advertising and promotional efforts; those expenditures increased to \$3.3 million in 1995, \$4.5 million in 1996, and they were projected to reach \$5.4 million in 1997.

The HARD ROCK CAFE operations also receive publicity through newspaper articles and television. Opposer has submitted a large number of articles, appearing in newspapers throughout the United States, which mention the HARD ROCK CAFE restaurants, as well as the apparel sold therein. For example, sub-exhibit 1 to Coutu Exhibit 8 is headlined "Hard Rock Cafe may fit to a T-Shirt" ("Chicago Sun-Times," May 16, 1986); sub-exhibit 20 includes "Hard Rock Cafe T-shirts" in a listing of what's "cool" for girls ("Raleigh Times," August 24, 1989); sub-exhibit 28 has a

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picture titled "Hard Rock Cafes Around the World" with an article mentioning "an \$11 T -shirt that reads: 'Hard Rock Cafe, Washington'" in connection with a Hard Rock Cafe to open in Washington, DC ("The Miami Herald," June 11, 1989); sub-exhibit 51 is an article about the Hard Rock Cafe, headlined "Delicious dishes surprise Hard Rock newcomers" ("The Boston Globe," August 17, 1989); and sub-exhibit 54 is headlined "Hard Rock Cafe eyes hit parade with public offer" ("New York Post," March 26, 1987).

In addition to opposer's core business of restaurants containing merchandise stores, opposer has branched out into a hotel and casino operation, and a VH-1 entertainment program, as well as such products as food and records. In terms of future plans, Mr. Coutu testified that, in order to build on its ability to run restaurants, opposer is looking for another restaurant concept to develop.

Applicant began doing business under the mark COUNTRY ROCK CAFE on October 1, 1993 in connection with a restaurant/nightclub located in Lake Forest, California. He has described his establishment as "a dance hall that serves food and cocktails." November 6, 1996 dep., pp. 16-17. It serves meals, provides live entertainment and recorded and video music, has a dance floor, offers dance lessons, and sells its own merchandise in its gift shop. He classified the entertainers appearing at the club as "country," and the

musical format as that of the new country music, which he said appeals to a more mainstream nightclub clientele.

Some nationally prominent entertainers have performed at the club in connection with promotions done with their record labels and with radio stations.

At the time of applicant's deposition on December 9, 1997, he was selling T-shirts, jackets, caps and hats under the word mark COUNTRY ROCK CAFE. Apparel sales amounted to \$200 per month, although he testified that this was a drop from when he first opened his establishment. T-shirts represent his greatest volume of sales, approximately 10-15 per month.

At his November 6, 1996 testimony deposition,⁷ Mr. Elsea stated that the gross revenues for his operation, which includes the nightclub services, amounted to \$3.4 million, commencing with the opening of the club three years earlier, and that he had spent \$100,000 for advertising, \$75,000 of which was for radio advertising. His primary advertising venue is a country music radio station, and his establishment has also been featured in issues of "Nightclub and Bar" magazine, and is mentioned annually in the "Orange County Register" nightlife section. The remaining advertising expenditures were for calendars for events at

⁷ As indicated above, applicant requested that his testimony from the prior proceeding be accepted in the current opposition, and the Board granted his motion.

the club, flyers, and free passes, all of which were distributed at the establishment.

Applicant's customers are community-based, and Mr. Elsea did not know if tourists have ever visited his establishment.

Before discussing the substantive issues in this case, we feel compelled to make a general comment as to the behavior of both parties' attorneys. The submission of evidence which is clearly improper imposes a strain on the resources of the Board. Similarly, the filing of needless objections also imposes such a strain. Applicant's attorney, in particular, appears to have interposed countless needless objections to testimony and exhibits, and to have maintained those objections in his brief, even though it appears that much of the testimony and exhibits objected to had no negative effect on his case. For example, applicant maintained in his brief an objection to a business organization chart, introduced during Mr. Coutu's deposition, that merely showed the names and titles of the six people who reported to Mr. Coutu. Although parties may feel the need to make an objection during the heat of a deposition, it creates a burden on the Board if they preserve needless objections in their final briefs.

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Further, some of the comments made in applicant's brief, accusing Mr. Coutu of chicanery, go beyond the zealous representation of a client. For example, at p. 9 applicant states, "As the admitted overseer of Hard Rock's trademark enforcement programs and a professional witness for Hard Rock, Mr. Coutu was familiar with this Board's prior adverse decision in Opposition 93,406, which no doubt motivated Coutu to cook up phony exhibits showing Hard Rock's mark in country settings in a misguided effort to support Hard Rock's position." In fact, Mr. Coutu's deposition was taken in September 1997, 9 months before the Board's decision in Opposition No. 93,406 was rendered. This kind of characterization, as well as the pattern of objections, is the sort of lawyering that the courts and this Board have criticized in the past. It serves no useful purpose, yet it unnecessarily complicates the proceeding for all involved with this dispute.

Turning now to the substantive claims in this opposition, we consider first the issue of priority. Opposer has submitted, with the testimony deposition of Mr. Coutu, photocopies of its registrations, prepared by the Patent and Trademark Office, and showing status and title. These are not, as applicant asserts, "plain photocopies"; however, neither can they be deemed to be proper "status and title" copies of the registrations under Trademark Rule

2.122(d). They were prepared on January 11, 1993, and thus cannot be considered to have been issued either subsequent to or at a time reasonably contemporaneous with the filing of the notice of opposition on March 26, 1996. See **Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH**, 14 USPQ2d 1487 (TTAB 1990); TBMP § 703.02(a). Nor did Mr. Coutu testify as to the current status of the registrations when he identified them. His testimony was limited to indicating opposer's ownership of the registrations ("These are copies of the registrations for Hard Rock Cafe, the word mark and the various logos we employ as part of our business." p. 42).

Opposer has tried to remedy the inadequacies of its evidence by submitting, with its reply brief, status and title copies of its registrations which were prepared by the Office on November 9, 1998. However, a brief may not be used as a vehicle for the introduction of evidence. See TBMP § 705.02 and cases cited therein. It was opposer's burden, if it wished to rely on its registrations to establish priority, to provide evidence as to the status as well as the title of those registrations as part of its testimony-in-chief; it cannot remedy such failure by submitting evidence with its reply brief.⁸ Although

⁸ We should point out that opposer's present counsel was not representing it during its main testimony period.

applicant first objected in its trial brief to the staleness of the registrations, he was under no obligation to point out to opposer, during Mr. Coutu's testimony deposition, that opposer had not elicited testimony from Mr. Coutu as to the current status of the registrations, any more than opposer was under an obligation to point out to applicant that his identification of newspaper articles during the course of his testimony was insufficient to demonstrate the truth of the statements made in those articles.

Although opposer cannot rely on its registrations to establish priority, the evidence of record does show that opposer used its marks HARD ROCK CAFE and the HARD ROCK CAFE classic logo prior to applicant's first use of his COUNTRY ROCK CAFE mark. In fact, applicant himself testified that, prior to the opening of his establishment, he had visited two HARD ROCK CAFE restaurants, and that one of his party purchased a HARD ROCK CAFE sweatshirt there. Accordingly, we find that there is sufficient evidence in the record to establish opposer's priority.

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We begin our analysis with the finding that opposer's HARD ROCK CAFE marks (both the word mark and the classic logo) are famous. As our primary reviewing court, the Court of Appeals for the Federal Circuit, has stated on a number of occasions, the fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). This is because a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. Id.

In this case opposer has established the fame of its marks. The number of opposer's establishments throughout the United States; the large amount of money spent in these establishments (a projected \$350 million in revenue in 1997); the extensive advertising and promotion (in excess of \$14 million between 1994 and 1997); and the extensive publicity opposer's HARD ROCK CAFE marks have received, in connection with both restaurant services and apparel, for many years, all support our finding of fame.

Turning next to the goods, applicant's identified goods are identical in part and otherwise closely related to opposer's items of apparel. The goods may also be encountered and purchased by the same classes of customers. Although the channel of trade for opposer's clothing items

is limited to opposer's restaurants (opposer's rights being limited to its common law uses), there is no restriction in applicant's identification on the channels of trade for his apparel, and therefore we must deem the clothing items to be sold in all channels of trade appropriate for such goods.

Sheraton Corp. of America v. Sheffield Watch, Inc., 480 F.2d 1400, 178 USPQ 468 (CCPA 1973). In determining the issue of likelihood of confusion, therefore, we must assume that applicant's clothing may be sold in department stores, mass merchandisers, souvenir shops, and the like.

As for the classes of consumers, applicant asserts that his customers are country western music enthusiasts.

However, people who enjoy country music may visit opposer's restaurants or purchase opposer's merchandise. Opposer has provided evidence that its establishments feature a variety of music, including blues, jazz, country and rock, and that its entertainment is not limited to "hard rock." One wall of its Orlando, Florida cafe is devoted to country music memorabilia. Country singers, including Vince Gill, Johnny Cash and the Judds, have appeared at various events held at its establishments. Moreover, publicity regarding these appearances has circulated throughout the United States.

For example, "Billboard" magazine reported that Tanya Tucker was inducted into the Dallas Hard Rock Cafe's Walk of Fame (July 16, 1994); an article in "Country Weekly" (January 10,

1995) states that Marty Stuart and Diamond Rio attended the opening night performances by Vince Gill, Don Henley and Melissa Etheridge at the opening of Nashville's Hard Rock Cafe; Los Angeles' "Radio & Records" February 21, 1997 issue reports that Vince Gill will be presented a Lifetime Achievement Award during a luncheon at New York's Hard Rock Cafe; and an article in the January 6, 1995 "New York Post" about Grammy nominations for "country rocker" Sheryl Crow reports that a press conference to announce the nominees was held at New York's Hard Rock Cafe.

Accordingly, we find that the parties' goods may be sold to the same classes of consumers.

When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Further, "as a mark's fame increases, the Act's tolerance for similarities in competing marks falls." **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, supra, 22 USPQ2d at 1456. We bear these two principles in mind as we compare the parties' marks.

Applicant's mark is COUNTRY ROCK CAFE per se, while opposer's marks are the word mark HARD ROCK CAFE and HARD ROCK CAFE with a background circular design. As the Board

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said in its decision in the prior proceeding, although the design lends a spare and modern appearance to opposer's mark, it is the words which are the dominant part of the mark.

Applicant has pointed out that the initial words in each mark—HARD and COUNTRY—are different. However, it is well established that marks must be compared in their entireties, and when we compare HARD ROCK CAFE and COUNTRY ROCK CAFE in this manner, we find that they project very similar commercial impressions. Not only do both marks refer to a type of music and a cafe, but the manner of indicating the type of music uses ROCK as the second word. Applicant attempts to differentiate the marks by pointing out the differences in style between "hard rock" and "country rock" music; however, the goods at issue are items of apparel, not music. We recognize that opposer's use of the HARD ROCK CAFE mark on articles of merchandise is collateral to its use of the mark for restaurant services. However, the term "HARD ROCK" in opposer's mark cannot be viewed as merely suggesting the type of music performed in opposer's restaurants, and therefore be entitled to a limited scope of protection. Unlike the prior proceeding, in which the Board found the mark HARD ROCK CAFE to be highly suggestive of opposer's restaurant services and goods, in this case opposer has proved the fame of its mark.

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Accordingly, whatever the suggestive roots of the mark, it must now be considered a strong mark which is deserving of a wide scope of protection. Applicant's mark, which follows the same pattern as opposer's mark, merely substituting another style of music (and using a term which also includes "ROCK" as the second word), simply comes too close to the zone of protection to be accorded opposer's mark.

Consumers familiar with opposer's HARD ROCK CAFE mark used in connection with restaurant services and merchandise such as T-shirts, sweatshirts, and other apparel are likely to assume, upon encountering T-shirts, sweatshirts, and the other apparel items identified in applicant's application bearing the mark COUNTRY ROCK CAFE, that the latter items emanate from, or are sponsored by, opposer. This is so even though such consumers will recognize that one mark refers to HARD ROCK music, and the other mark to COUNTRY ROCK music. The issue is not whether consumers will mistake one mark for another, but whether they are likely to believe that the marks identify goods coming from a single source.

Applicant's evidence of third-party use of "ROCK CAFE" marks does not persuade us that the public is so familiar with such marks that they will differentiate them by their initial elements. As the Board said in the prior proceeding, "there is no evidence that consumers would view ROCK CAFE as a unitary phrase to the exclusion of the word

preceding ROCK in either the parties' marks herein or in the names of the cafes identified in the submitted telephone directories." **Hard Rock Cafe Licensing Corp. v. Elsea**, supra at 1408-09. Usages such as "Flat Rock Cafe," "Red Rock Cafe," "River Rock Cafe" and "Blowing Rock Cafe" convey very different commercial impressions from that of HARD ROCK CAFE or COUNTRY ROCK CAFE. There are only two directory listings that have a connotation of music. "Classic Rock Cafe" is advertised in the Restaurant section of the yellow pages of the Williamsport (Pennsylvania) directory. "Vintage Rock Cafe" is merely listed in the business portion of the "White /Yellow Pages" directory for Racine, Caledonia, Mt. Pleasant, Sturtevant (Wisconsin), between Vintage Jewelers and Visicomm Industries. As opposer has pointed out, there is no evidence as to the number or class of customers of these businesses, or their trading areas. Nor is there any evidence that these names have been used as trademarks for items of apparel. We cannot conclude, on the basis of these two directory listings, that opposer's mark is "weak," or that there has been widespread exposure of third-party ("Music Style") ROCK CAFE marks for restaurant services, let alone collateral goods such as T-shirts.

An additional factor favoring a finding of likelihood of confusion is that many of the items listed in applicant's identification are relatively inexpensive, impulse

purchases, and the class of consumers is the general public, rather than sophisticated purchasers. Applicant argues that opposer's \$15.00 T-shirt is an expensive item, based apparently on opposer's cost to obtain them. However, applicant has not provided any evidence that \$15 is a particularly high sum for a T-shirt; in fact, applicant sells his T-shirts for \$13. Nor can \$13 or \$15, in general, be considered a large amount of money.⁹ We would also point out that both opposer sells caps for \$12, and applicant sells them for \$13.

Finally, applicant asserts that the lack of evidence of actual confusion, despite the fact that applicant's establishment is located within the same county as opposer's Newport Beach, CA restaurant, shows that confusion is not likely. However, applicant has had extremely limited sales of apparel items. At the time of applicant's deposition in December 1997, he was not selling underwear, vests, bandannas or sweatshirts. Gross sales of his apparel were \$200 a month, with sales of his biggest selling items of apparel, T-shirts and caps, amounting to 10 or 15 T-shirts and 7 caps a month. Given the limited sales of applicant's

⁹ Applicant also asserts, in the section of his brief headed "The Buyer's [sic] Exercise Care," that "the apparel items are only available at the respective establishments of the parties, who do not sell each other's goods." Brief, p. 17. We do not understand how this relates to the factor of the care with which the purchase is made. In any event, as we have explained above, applicant's identification of goods is not limited as to channels

apparel items, and the recognition that evidence of actual confusion is notoriously difficult to obtain, we cannot conclude from the lack of such evidence that confusion is not likely to occur.

We recognize that our decision herein, finding likelihood of confusion, differs from that in the prior proceeding. However, there are several differences between the cases. In particular, applicant's present mark, COUNTRY ROCK CAFE in typed drawing form, is different from the COUNTRY ROCK CAFE and design mark which was the subject of applicant's earlier application. The Board stated in the prior opinion that the design element of applicant's other mark was a significant factor in the overall commercial impression of the mark, and discussed at some length the design features and additional wording.

In addition, in the prior case the opposer did not prove fame, as it has here. That factor is significant in connection with the distinctiveness and scope of protection to be accorded opposer's mark. Moreover, since the prior decision issued, our primary reviewing court, the Court of Appeals for the Federal Circuit, has had occasion to reaffirm the importance that fame plays in determining likelihood of confusion. See **Recot, Inc. v. M.C. Becton**, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

of trade, and we therefore must assume that the goods can be sold

It is a well-established principle that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. See **W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.**, 190 USPQ 308 (TTAB 1976). The Court in Recot took this principle even further in the case of a famous mark. "When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a 'long shadow which competitors must avoid.'" **Recot v. Becton**, supra at 214 F.3d 1328. The Court went on to quote **Nina Ricci S.A.R.L. v. E. T. F. Enters.**, 889 F.2d 1070, 1074, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989): "There is no excuse for even approaching the well-known trademark of a competitor."

Decision: The opposition is sustained.

R. F. Cissel

E. J. Seeherman

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board

in all appropriate channels, not just in applicant's nightclub.