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HRW

12/13/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tai and Adele Aguirre

Serial No. 75/110,696

Tai Aguirre, pro se.

Vivian Micznik First, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Quinn, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Tai and Adele Aguirre have filed an application to register
the mark "YOUR PERSONAL SONG" for "composing, recording and
transcribing songs for others for special occasions."¹

Registration has been finally refused under Section 2(d) of
the Trademark Act on the ground of likelihood of confusion with

¹ Serial No. 75/110,696, filed May 28, 1996. The application as
originally filed claimed first use dates of 1985 but was subsequently
amended to claim first use dates of June 1995. A disclaimer has been
made of the word SONG.

the mark YOURSONGS, which is registered for "music composition for others featuring original songs for special occasions."²

The final refusal has been appealed and both applicant and the Examining Attorney have filed briefs.³ An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*⁴ factors which are relevant under the circumstances at hand. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Insofar as the respective services are concerned, we have no argument from applicants that their song composition services differ from those of registrant. As pointed out by the

² Registration No. 2,077,612, issued July 8, 1997, claiming a first use date of January 1, 1996 and a first use in commerce date of March 1, 1996.

³ Prosecution was suspended in this case on August 18, 1998 pending the disposition of Cancellation No. 28,079 filed by applicants against the cited registration. However, on December 3, 1998, applicants filed a notice of appeal and accompanying remarks which the Board determined should be treated as applicants' brief on the case. On inquiry by the Board, applicants indicated that they wished the appeal to go forward, despite the pending cancellation proceeding. Although the Board allowed applicants time to file a supplement to the original brief, applicants failed to do so. The newly-assigned Examining Attorney submitted her brief and applicant filed no reply brief. Accordingly, the appeal is now ready for final decision.

⁴ See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Examining Attorney, applicants' services, as identified in the application, "incorporate and otherwise are complementary to" the services of registrant. Applicants have acknowledged that the services are "similar." (Response of April 8, 1998).

Thus, we proceed with our analysis on the basis that the respective services are at least identical in part and otherwise closely related. Although applicants argue that their services are designed for businesses, there are no limitations in the recitation of services in the application as to any particular channels of trade or type of purchaser. Accordingly, it must be presumed that the services of both would be offered in the same channels of trade to the same potential purchasers. See *Canadian Imperial Bank of Commerce National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Furthermore, in making our comparison of the respective marks, we are guided by the well-recognized principle that the degree of similarity necessary to support a conclusion of likelihood of confusion decreases when the marks are being used on virtually identical services. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The Examining Attorney has taken the position that applicants' mark YOUR PERSONAL SONG and registrant's mark YOURSONGS are similar in appearance, sound, connotation and commercial impression. She focuses particularly on the argument

that the additional word PERSONAL in applicants' mark does not result in a commercial impression different from that of registrant's mark.⁵

Applicants, on the other hand, insist that the word PERSONAL is the distinguishing element in their mark; that, as a result of the presence of this word, applicants' mark consists of three separate words with five syllables, whereas registrant's mark consists of only one joined two-syllable term. According to applicants, the only distinguishing feature in registrant's mark is this joinder, not the words themselves.

Although there are obvious differences in sound and appearance between the two marks because of the additional word PERSONAL in applicants' mark, we agree with the Examining Attorney that the connotation of the two marks is identical. Both YOURSONGS and YOUR PERSONAL SONG imply a song written specifically for a particular individual or, in other words, a personalized song. Contrary to applicants' argument, the additional word PERSONAL adds no distinguishing feature to their mark. With or without this term, the overall commercial impression created by the two marks is the same. Moreover, as has often been stated, purchasers are not infallible in their recollection of marks and often retain only a general or overall

⁵ Although the brief was written by a newly-assigned Examining Attorney, the arguments are the same.

impression of the marks. See *Interco Inc. v. Acme Boot Company, Inc.*, 181 USPQ 664 (TTAB 1974). Clearly, YOURSONGS and YOUR PERSONAL SONG are marks which could easily be interchanged in purchasers' memories, especially since both are being used in connection with services involving personalized songs or "songs for you."

Applicants argue that registrant's mark is highly suggestive and, as such, is entitled only to a narrow range of protection. Applicants point to several registered third-party marks containing either SONG- or -SONG in a joined term, arguing that these marks are more similar to registrant's mark than applicants' mark. The coexistence of these registrations, applicants contend, constitutes evidence that the Office has determined that the public can in fact distinguish between marks of this nature.

We agree that registrant's mark is highly suggestive of its services. Applicants' mark is also highly suggestive. Nonetheless, even if "weak," registrant's mark is entitled to protection against the subsequent registration of the same or a similar mark for services which might well be assumed to emanate from registrant. See *OPTOmechanisms, Inc. v. Optoelectronics, Inc.* 175 USPQ 246 (TTAB 1972) and the cases cited therein. As previously discussed, applicants' mark is highly similar in commercial impression to registrant's mark and the services with

which applicants' mark is being used are clearly services which might be assumed to originate from registrant. Registrant is at the very least entitled to a scope of protection which would encompass applicants' mark.

Insofar as the third-party marks cited by applicants are concerned, the Examining Attorney specifically pointed out in the final refusal that applicants could not rely upon registrations for these marks without providing copies thereof. Simply listing marks and registration numbers is an unacceptable means of making the registrations of record. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). Furthermore, even if considered, the mere fact that other marks containing the word SONG have been registered for other unspecified goods or services is irrelevant. The significant factor here is the combination of YOUR and SONG in both marks, a combination not found in any of the third-party marks. It is this common use of YOUR and SONG by registrant and applicants that results in the same commercial impression being created by the two marks.

Accordingly, in view of the use of these highly similar marks on services which are in part identical and otherwise closely related, we find confusion likely.⁶

⁶ Although we have considered the remarks made by applicants in their addendum to the appeal brief, we would simply note that normal Office practice was followed in the abandonment of applicants' application. Applicants were not prejudicially treated by not being notified of the

Decision: The refusal to register under Section 2(d) is affirmed.

T. J. Quinn

C. E. Walters

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board

pending abandonment by telephone; in fact, the adoption of such a practice would sorely tax Office resources.

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