

Hearing:  
November 4, 2003

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Charles C. Tennin, d.b.a. Big Fish Music

Serial No. 76088749

Charles C. Tennin, *pro se*.

Won T. Oh, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

Before Chapman, Bucher and Rogers, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Charles C. Tennin, d.b.a. Big Fish Music, seeks  
registration on the Principal Register of the mark BIG FISH  
MUSIC for services recited as "music publishing services,"  
in International Class 41.<sup>1</sup>

This case is now before the Board on appeal from the  
final refusal to register based upon Section 2(d) of the  
Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining

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<sup>1</sup> Application Serial No. 76088749 was filed on July 14, 2000,  
based upon applicant's allegations of use in commerce since at  
least as early as May 1975. Applicant disclaimed the word MUSIC  
apart from the mark as shown.

Attorney has held that applicant's mark so resembles the mark BIG FISH FILMS, which is registered for "film production services," also in International Class 41,<sup>2</sup> as to be likely to cause confusion, to cause mistake or to deceive, when applicant's mark is used in connection with the identified services.

Applicant and the Trademark Examining Attorney have fully briefed this appeal, and both appeared at an oral hearing held before this panel of the Board.

Applicant is a music publisher who claims to have been doing business as "Big Fish Music" since 1975. Documentary evidence in this record shows that he registered his fictitious business name with Los Angeles County, and that he paid his membership fee to register his company name with Broadcast Music Inc. (BMI), both in November 1977.<sup>3</sup> He represents the public performance copyright interests of music copyright holders. Applicant promotes his services in myriad ways to find songwriters, artists and composers. In addition to representation, he works to help them with

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<sup>2</sup> Registration No. 1675414, issued on February 11, 1992; Section 8 affidavit accepted and section 15 affidavit acknowledged; renewed. The word "FILMS" is disclaimed apart from the mark as shown.

<sup>3</sup> Fictitious Business Name Statement for Big Fish Music (music publishing), #77-49407, filed November 18, 1977; United California Bank draft No. 13143346, payable to BMI, dated November 11, 1977; Billboard newspaper, December 17, 1977.

professional development. Applicant's particular niche is background and instrumental theme music for television programs, inspirational/gospel songs, and country ballads.<sup>4</sup>

Applicant acquires through assignment the rights of these songwriters, musical artists and composers. He in turn publishes their musical creations and develops licensing mechanisms providing the appropriate users of music with the right to use this music.

For registered works involved in public performances, the music users pay royalties to the copyright collective organizations, e.g., BMI, ASCAP (American Society of Composers, Authors and Publishers), and SESAC (the Society of European Stage Authors and Composers), which then pay the music publishers like applicant.<sup>5</sup> Music publishers close the loop by passing the appropriate royalty monies along to the songwriters, musical artists and composers.

In arguing against the Trademark Examining Attorney's contention that there is a likelihood of confusion,

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<sup>4</sup> Cashbox newspaper, August 2, 1975; The American Song Festival's Music Business Directory '83; Tunesmith newspaper, January 26, 1988; Music City Song Festival, news release, August 29, 1988; National Academy of Songwriters (NAS) monthly SongLine newsletter of April 1994; Tunesmith newspaper, June 1, 1997; SongWritersNotes newsletter, May 1997; Music Connection magazine, "19<sup>th</sup> Annual Directory of Music Publishers," October 25 1999 - November 7, 1999.

<sup>5</sup> The record is replete with the periodic payments of such royalty monies to Mr. Tennin, with an accounting of each artist and copyrighted work on which the payment is calculated.

applicant contends that the marks are not "highly similar," as argued by the Trademark Examining Attorney; that the term BIG FISH has been registered by numerous third-party registrants; that the services of registrant are totally different from his services; and that registrant's services would be offered to a totally different group of prospective users from his clients; that the third-party registrations proffered by the Trademark Examining Attorney to show that the same companies offer both services under the same mark are not probative because they do not reflect the realities of the marketplace; that the clients for both registrant's and applicant's services are "sophisticated, discriminatory and knowledgeable"; and that despite a dozen years of contemporaneous usage, there have been no instances of actual confusion between registrant's mark and his mark.

In turn, the Trademark Examining Attorney argues that applicant's mark is highly similar to the registered mark; that applicant's services are related to registrant's services, and are offered in the same channels of trade as are registrant's services; that there is no evidence that prospective users of applicant's services are sophisticated; that applicant's attempts to argue the weakness of the cited mark are based on untimely

submissions of third-party registrations; that even if considered, these third-party registrations are not probative of weakness of the term BIG FISH for services in International Class 41 such as film production services; and that applicant's focus on the lack of actual confusion with registrant's mark is not determinative of a different result herein.

Before considering the substantive issue of likelihood of confusion, we must discuss a preliminary matter. Applicant submitted at oral hearing his computer-designed flow chart on a single piece of 8½" by 14" paper purporting to show the differences in the channels of trade between "music publishing" and "film production." The Trademark Examining Attorney objected to the introduction of this new paper at the beginning of the oral hearing.

Our review of the extensive evidence about the details of applicant's business that he had earlier placed into the record supports the simplified flow chart contained in the top portion of the page, entitled "Music Publishing." In effect, this portion of the chart is not new information, but simply helps to make sense of applicant's voluminous evidence and repeated arguments about his trade channels. On the other hand, upon a review of the entire record, the information as to the channels of trade for "Film

Production" is not in the record. Therefore, the Trademark Examining Attorney's objection is well-taken, and we have not considered this exhibit in reaching our decision herein.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first consider whether applicant's mark and registrant's mark, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions.

Applicant is correct in his contention that, when considered in their entirety, the marks are not identical. However, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749

(Fed. Cir. 1985). As correctly argued by the Trademark Examining Attorney, the BIG FISH element is the dominant feature of both marks. The generic term FILMS is disclaimed in registrant's mark and the generic term MUSIC is disclaimed in applicant's mark. Moreover, there is nothing in the record to suggest that the term BIG FISH is anything but arbitrary matter when used in connection with registrant's services and with applicant's services. Hence, under the trilogy of appearance, sound and connotation, these two marks, when compared in their entireties, are quite similar in their overall commercial impressions.

As to the related du Pont factor focusing on the number and nature of similar marks in use on similar goods or services, based on this record, we cannot conclude that the term BIG FISH is a weak mark as applied to registrant's services. Applicant refers in his appeal brief to several third-party registrations that were neither timely nor properly made of record. It is well established that the Board does not take judicial notice of registrations that reside in the United States Patent and Trademark Office, and that the submission of a list of registrations is insufficient to make them of record. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974). Moreover, Trademark Rule

2.142(d) provides that the record in an application should be complete prior to appeal and that the Board will ordinarily not consider late-filed evidence. Accordingly, the Trademark Examining Attorney has correctly objected to the attempted reference to these registrations on the ground of untimeliness. Because this objection is well taken, the evidence has not been considered in reaching our decision.

In any event, we hasten to add that even if the third-party registrations had been considered, it would not demonstrate any weakness of the term BIG FISH for film production services because these third-party registrations are for goods (e.g., watches and items of clothing) and services (e.g., restaurant services) quite different from the services involved herein. See also AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) [third-party registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks]. Thus, applicant has not shown that the registered mark is entitled to a narrow scope of protection. Furthermore, even weak marks are entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely

related goods or services. See Hollister Incorporated v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976).

Next, we turn to a determination of what we find to be the pivotal du Pont factor in this likelihood of confusion case, namely, the relationship of applicant's services and registrant's services. Although the Trademark Examining Attorney contends that "music publishing services" are related to "film production services," we find that he has failed to sustain his burden of proof on this point.

In support of the Trademark Examining Attorney's position that these services are related, he submitted with the final refusal to register a number of third-party registrations, each showing that one company offers both music publishing services and film production services under the same mark. The Trademark Examining Attorney argues:

... Clearly these registrations show that many companies are engaged in the practice of offering both applicant's services and the registrant's services. Thus, applicant's services are in the same channels of trade as the registrant's services. These third-party registrations show that consumers may believe that applicant and the registrant are in fact one company that is providing both services.

(Final refusal of March 14, 2002, p. 2)

Although the Trademark Examining Attorney contends that "many companies" are offering both of these services, a closer examination of the twelve registrations on which this conclusion is based makes such a proposition somewhat questionable. Of the twelve registrations, five are registrations based upon Section 44 of the Act - not on use in commerce in (or with) the United States, and hence they have very limited persuasive value. See In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Another registration is for educational services, including media company news about music publication and film production.<sup>6</sup> Four of the remaining six registrations, like the five registrations based on Section 44, *supra*, reflect ownership by Europeans, and therefore are less probative, in our view, of commercial realities in the United States.

In weighing the probative value of the remaining third-party registrations, we clearly have discretion (*viz.*, such registrations *may* have probative value in *suggesting* that the goods and services listed therein are of a kind that *may* emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck, *supra*. Hence, we are most

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<sup>6</sup> Reg. No. 2481653, THE DOT TO WATCH, issued on August 28, 2001.

reluctant to draw sweeping conclusions about entire industries from the two remaining registrations - one of which is a registration based on use, although an individual has recited every imaginable service in International Class 41, from symphony orchestras to satellite television broadcasting.<sup>7</sup>

As to registrant's "film production services," applicant has placed information into the record showing that registrant's services are limited to producing national television commercials.<sup>8</sup> However, our principal reviewing court has repeatedly noted that the question of likelihood of confusion in Board proceedings must be determined based upon an analysis of the services as recited in the registration rather than what any extrinsic evidence may reveal about the actual services. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Hence, it would be inappropriate to construe registrant's services, for

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<sup>7</sup> Reg. No. 2535521, MUSIC OF NOTE, issued on February 5, 2002.

<sup>8</sup> According to information applicant located on registrant's webpages, registrant creates cutting-edge spots for large clients such as Bloomingdale's, Capitol One, Daimler Chrysler, Volkswagen, Red Bull, Ikea, the Houston Olympic Games, et al.

example, as involving only "film production services, specifically, the production of commercial advertisements." On the other hand, we do find it somewhat probative that registrant's webpages do not reflect any services in the area of music publishing or licensing.

Hence, we find, based upon this *ex parte* record, that the Trademark Examining Attorney has failed to demonstrate that "music publishing services" are related to "film production services."

Similarly, we note that the Trademark Examining Attorney has relied upon these same third-party registrations to support the conclusion that these services are offered through the same channels of trade. Hence, this attempted showing fails as well, for even if the third-party registrations had more probative value, it does not follow as a matter of course that different services listed in a single registration travel in the same channels of trade merely because they may be marketed under the same mark, and there is no showing of any overlap in registrant's and applicant's respective channels of trade.<sup>9</sup>

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<sup>9</sup> Moreover, if we had reason to conclude that registrant might be a potential client for applicant's licensing activities, this would not force the conclusion logically that these two service providers share the same channels of trade.

As to the du Pont factor focusing on the conditions under which these services are provided to prospective purchasers or users, there is no evidence supporting applicant's argument that applicant's and registrant's respective clients are all "sophisticated, discriminatory and knowledgeable."

As to the du Pont factor focusing on the nature and extent of any actual confusion, applicant asserts that the respective services have been offered under the involved marks contemporaneously since registrant allegedly adopted its mark in February 1991, and that applicant is not aware of any instances of actual confusion.

However, applicant's lack of knowledge of incidents of actual confusion is not particularly probative on the question of likelihood of confusion. We have not been provided with information regarding the geographic extent or the dollar volume of the advertising of applicant's or registrant's services during that time, or of the extent of applicant's business. In addition, we have not heard from registrant as to whether it is aware of any incidents of actual confusion. Finally, while solid evidence of actual confusion is the best evidence of likelihood of confusion, any confusion about mutual sponsorship or affiliation is difficult to obtain and would not necessarily be brought to

the attention of either applicant or registrant. See In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ["The lack of evidence of actual confusion carries little weight ... especially in an *ex parte* context"].

In conclusion, while BIG FISH FILMS and BIG FISH MUSIC are highly similar in overall commercial impression, the Trademark Examining Attorney has not demonstrated that the respective involved services are related, and hence, on this record, we do not find a likelihood of confusion herein.

*Decision:* The refusal of registration is hereby reversed.