

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: March 22, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Killer Music, Inc. and BMG Songs, Inc., dba Killer Tracks¹
v.
killersound, Inc.

Opposition No. 91152646
to application Serial No. 75702568
filed on May 11, 1999

Mary L. Kevlin of Cowan, Liebowitz & Latman, P.C. for Killer Music, Inc. and BMG Songs, Inc.

Ian K. Boyd of Harvey Siskind Jacobs LLP for killersound, Inc.

Before Chapman, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant, killersound, Inc. (a California corporation), filed an application to register on the Principal Register the mark shown below

¹ The notice of opposition includes two named opposers and opposers' cover letter refers to an enclosed check and a deposit account for any insufficient or additional fees. The Board instituted the opposition with only "Killer Music, Inc." as the opposer. That is hereby corrected and both opposers are listed in the caption of this proceeding. (The additional fee for the



for services identified as "music composition for others" in International Class 41. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

The application has been opposed by Killer Music, Inc. (a California corporation) (hereinafter "Killer Music") and BMG Songs, Inc. (a California corporation) (hereinafter "BMG") on the basis that for many years both opposers have marketed "musical and video recordings, providing music for television, films, videos and multi-media works, music publishing and musical information services, under the marks KILLER MUSIC and/or KILLER TRACKS" (paragraph 1); that Killer Music owns (i) Registration No. 1466219 issued November 24, 1987 for the mark shown below



("music" disclaimed) for "prerecorded audio and video tapes" in International Class 9, and (ii) application Serial No. 76053099 filed May 22, 2000 for the mark KILLER TRACKS

second opposer has been charged to opposers' law firm's deposit account.)

Opposition No. 91152646

("tracks" disclaimed) for "musical sound recordings" in International Class 9 and "providing music for use in production of television shows, television advertisements, motion pictures, video recordings, in-house productions, and multi media applications; music publishing services; providing information about and performances of musical artists by means of a global computer information network" in International Class 41; that BMG is the exclusive licensee of the KILLER TRACKS mark; that since long prior to applicant's application filing date, opposers have extensively advertised and promoted the sale of their goods -- musical sound recordings, and their provision of services -- production music services, music publishing services and music information services under the "KILLER Marks"; that opposers have built up highly valuable goodwill for their "KILLER Marks"; and that applicant's mark, when used in connection with its "music composition for others" services, so resembles opposers' previously used and registered marks, as to be likely to cause confusion, mistake, or deception.

In its answer applicant denies the salient allegations of the notice of opposition and asserts the affirmative defenses of laches, waiver, estoppel and acquiescence (paragraphs 3-6).²

² In its brief (p. 3), applicant stated that the issue before the Board is whether there is a likelihood of confusion when the involved marks are used on or in connection with the involved

Opposition No. 91152646

The record consists of the pleadings; the file of applicant's application; opposers' testimony, with exhibits, of Gary Gross, president of opposer BMG; and opposers' notices of reliance on the following items: (1) a status and title copy of opposers' pleaded Registration No. 1466219, and a certified copy of opposers' pleaded application Serial No. 76053099, (2) applicant's amended responses to opposers' first set of interrogatory Nos. 2, 6, 7, 11, 14 and 16 and the documents identified therein,³ (3) applicant's responses to opposers' requests for admission Nos. 6-9 and the documents identified therein, and (4) copies of numerous publications under Trademark Rule 2.122(e). Applicant submitted the testimony, with exhibits,

goods and services. Applicant made no reference in its brief to any of its pleaded affirmative defenses, except on page 7, applicant argued that opposers sent a cease and desist letter to applicant on May 22, 2000; that applicant responded in a letter dated June 1, 2000; and that, thereafter opposers did not contact applicant for two years when they filed the opposition in July 2002. (See Gelat dep., pp. 93-95, Exh. No. 17.) To whatever extent applicant intends thereby to assert its affirmative defenses, we find that the evidence of record is insufficient to establish any of applicant's pleaded affirmative defenses -- laches, waiver, estoppel and acquiescence. With specific regard to the defense of laches, see *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

We note that applicant's "affirmative defenses" also include an assertion that opposers' pleading fails to state a claim (paragraph 1). Applicant did not pursue this defense either before trial by motion to dismiss or after trial in its brief. Applicant has waived this defense. (Moreover, the notice of opposition states a claim.) Applicant also pleads certain "defenses" which relate more to a further denial of opposers' assertion of a likelihood of confusion (paragraphs 2, 7 and 8). These are not "affirmative defenses" and will not be treated as such.

Opposition No. 91152646

of Frank Gelat, applicant's president and creative director; and a notice of reliance under Trademark Rule 2.122(e) on printouts from the USPTO's Trademark Electronic Search System (TESS) of five third-party registrations and one third-party application.

Both parties filed briefs on the case. Neither party requested an oral hearing.

Gary Gross, BMG's president, explains that opposers are in the business of producing and licensing music and other audio components for customers. This is known as the "production music" business. It involves analyzing the market needs for various types of music/sounds used in various types of productions (e.g., television programming and advertising, films, commercials, company training videos), and then producing the music or sounds needed and licensing them to customers for their needs. In addition to production music, opposers also engage in music publishing, which means they own the copyrights for certain music and act as publisher for those compositions.

Opposers organize the music into several libraries or brands (e.g., KILLER TRACKS, KILLER CLASSICAL, KILLER LATINO, KILLER PROMOS, KILLER FX, KILLER ANIMATION) and within each of the libraries, there are sub categories by genre (e.g., classical, rock, jazz, hip-hop, trip-hop).

³ Applicant's answers to opposers' interrogatory Nos. 6 and 7

Opposition No. 91152646

Opposers distribute the music (or other sounds) to customers primarily via CD but also do so through the Internet. (Gross dep., p. 6.)

Customers can either order from opposers' preexisting catalog of music or opposers will create custom music for customers. Rearrangements of the music/sounds by the customers is not allowed without prior permission, but customers can remix the musical instruments in the compositions. (Gross dep., p. 89.) Opposers' customers include "almost every major film studio," "almost every major television broadcaster," "advertising agencies" and a wide range of companies from Fortune 500 corporations to "mom-and-pop companies." (Gross dep., pp. 10-11.)

Customers pay for opposers' goods and services based on the manner in which they use the music. For example, using the production music in a national television show costs one rate, while using it on a local radio program is another rate.

The mark, KILLER TRACKS, is not only the dba name of opposer BMG, it is the name of a major library of opposers' production music, and has been in use for opposers' production music since 1990. As of 2003, opposer BMG owns both the KILLER MUSIC and design and KILLER TRACKS marks, when BMG purchased the assets of opposer Killer Music, Inc.,

were filed under seal as confidential.

Opposition No. 91152646

including the trademarks, the musical compositions, the archives, etc. (Gross dep., pp. 41-43.)

Opposers' sales of their goods and services offered under the KILLER TRACKS mark from 1997 - 2003 totaled about \$52.5 million, with advertising/promotional expenses during that time of \$300,000 - \$350,000 annually. Opposers' marks, KILLER TRACKS and KILLER MUSIC and design, used in connection with production music services, music entertainment services, music publishing services, music library services and music products, have been the subject of many articles in the relevant publicly circulated media since the late 1980s.

Opposers advertise in trade publications (e.g., "Post Magazine," "TV and Radio Reports," "Hollywood Reporter") and through direct mail, on the Internet, and by exhibiting at trade shows. Opposers generally request or require that they be given a music title credit in the movies and television shows which utilize their goods or services.

Opposers are not aware of any instances of actual confusion.

Applicant, killersound, Inc., was founded in April 1999, following a positive response to the music composed by one of applicant's founders in connection with a colleague's website. Applicant employs two people, Mr. Frank Gelat and Mr. Brett Yokum. Applicant offers a variety of about 500

Opposition No. 91152646

"SoundSets" (i.e., actual compositions) which contain both a pre-made short (about 10-15 seconds long) and a long (generally 40-45 seconds) version; and the "SoundSet" can also be the components or elements or instrument parts whereby the customer can rearrange, remix or recompose the music to fit whatever production they are doing. (For example, a customer might change the pitch or the tempo of the various components or match another piece of music they are doing in their production.) Applicant also offers music loops and sound loops (usually 3 to 20 seconds long), sound effects and sound logos or signatures. Applicant's online music libraries are subdivided by genre (e.g., classical, jazz, mood, pop, rock, techno). Applicant also creates custom-made products for customers.

Applicant's customers include advertising agencies, corporations, multimedia artists, freelance designers and video designers.

The customers may download samples of a composition for a free trial. When purchasing applicant's services, the cost averages around \$375 per license, except the average cost for a custom composition is \$1500 to \$2000.⁴

Applicant markets and delivers its product through its

⁴ These cost figures were filed during trial under seal as confidential. However, applicant included the numbers in its brief (pp. 5 and 12), and its brief was not filed (in relevant part) under seal as confidential. Thus, applicant waived the confidentiality of this information.

Opposition No. 91152646

website. That is, once the customer goes through the purchasing transaction, then the customer downloads the product to their desktop. Although applicant has on very rare occasions (about four or five times) provided a

Opposition No. 91152646

customer with a CD. The general length of time between customer inquiry and customer purchase is a week or week and a half, except for custom orders which would be one to two months, all with much contact with the client. Applicant requires that the customer sign a license agreement, and pay a one-time flat fee, without reporting usage to applicant.

Applicant offers some of its services (excluding its SoundSets) through third-parties, specifically, soundeffects.com, buycreative.com, bigshotmedia.com and mediabakery.com. Also, applicant offers its services bundled in third-party software programs (e.g., Macromedia Flash software and Adobe Live Motion).

Applicant's gross revenues were also filed as confidential and cannot be stated here. Suffice it to say, its accumulated gross revenues for the years 2000 - 2003 do not reach into the millions of dollars; and its advertising expenses are a very small percentage of its revenues.

Mr. Frank Gelat created the word mark "killer sound" inspired by the positive feedback from his first project of music for a colleague's website. The logo portion of the mark was created by his co-founder, Brett Yokum. Frank Gelat did not know Mr. Yokum's inspiration for that design.

Applicant's website receives about 20,000 hits per month. Applicant attends trade shows (e.g., FlashForward, MacWorld), mails out brochure advertisements to customers

and potential customers, and has appeared on third-party websites (e.g., the "Hot News" section of Apple's website).

When Mr. Gelat was asked if applicant had experienced any actual confusion, he testified that he knew of only one instance which occurred in September or October 2003.⁵ Specifically, Mr. Gelat testified that an existing customer of applicant who had licensed a product from applicant, e-mailed a request to try several products, which applicant determined were products from opposers' KILLER TRACKS site. He also testified that he knew of three instances when consumers called applicant inquiring whether applicant was related to or affiliated with opposers. All occurred in the same time frame, September/October 2003. One call was from a distributor of music libraries wondering if applicant was affiliated with KILLER TRACKS and wanting to do business with applicant; the other two callers wanted general information about the products and services. None of applicant's business partners or resellers have ever reported any instance of actual confusion to applicant.

Priority

Opposers made of record a status and title copy of pleaded Registration No. 1466219 for the mark KILLER MUSIC

⁵ According to applicant's answer to opposers' interrogatory No. 11, the incident occurred in October 2003.

Opposition No. 91152646

and design for "prerecorded audio and video tapes."⁶ With regard to the second pleaded mark KILLER TRACKS, after trial, but before the briefing of this case, the pleaded application Serial No. 76053099 issued on August 31, 2004 as Registration No. 2878147. Opposers specifically referred to this second registration in their brief on the case (e.g., brief, pp. 3 and 4). Applicant acknowledged that opposers' pleaded application had registered, referring to it as the "then-pending application for KILLER TRACKS mark" (brief, p. 2). Further, applicant made no objection to opposers' reference to the subsequent registration of the pleaded application for the mark KILLER TRACKS. Moreover, there is clear testimony that BMG purchased the KILLER MUSIC and design mark and the KILLER TRACKS mark in 2003, thus making title to the second (recently issued) registration clear. (Gross, dep., p. 41.)

Based on the above, we conclude that opposers' Registration No. 2878147 (issuing from pleaded application Serial No. 76053099) for "musical sound recordings" and "providing music for use in production of television shows, television advertisements, motion pictures, video recordings, in-house productions, and multi media applications; music publishing services; providing

⁶ Registration No. 1466219 issued November 24, 1987; Section 8 affidavit accepted. The word "music" is disclaimed. The claimed

Opposition No. 91152646

information about and performances of musical artists by means of a global computer information network"⁷ is properly of record.

In view of opposer BMG's ownership of valid and subsisting registrations for its KILLER MUSIC and design and KILLER TRACKS marks, the issue of priority does not arise in this opposition proceeding. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, at footnote 6 (CCPA 1972); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1128 (TTAB 1995). Moreover, opposers' have established use of the marks KILLER MUSIC and design and KILLER TRACKS prior to the filing date of applicant's intent-to-use based application, May 11, 1999. The record shows that applicant commenced use of its mark for "custom audio services" in April 1999. (See, e.g., applicant's answer to opposers' interrogatory No. 2.) Opposers' proven first use of their two pleaded marks is prior to applicant's proven first use date.

dates of first use anywhere and first use in commerce are March 1984 and June 1984, respectively.

⁷ Registration No. 2878147 issued August 31, 2004. The word "tracks" is disclaimed. The claimed dates of first use anywhere and first use in commerce are February 1990 for the goods and November 1995 for the services.

Likelihood of Confusion

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on 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). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities of the marks and the similarities of the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Based on the record before us in this case, we find that confusion is likely.

Turning first to a consideration of the parties' respective goods and services, in Board proceedings "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in opposer's registration,

Opposition No. 91152646

rather than what the evidence shows the goods and/or services to be." *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). That is, the issue of likelihood of confusion must be determined in light of the goods or services as identified in the opposed application and the pleaded registration(s) and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods or services. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Applicant identified its services as "music composition for others." Clearly, this identification is not restricted as to the nature of the music composition, the purchasers, the channels of trade, or in any other way. Opposer BMG's registration identifies the services as "providing music for use in production of television shows, television advertisements, motion pictures, video recordings, in-house productions, and multi media applications; music publishing services; providing information about and performances of musical artists by means of a global computer information network." While there is some language regarding the nature of the services, this identification is not limited as to purchasers, and/or channels of trade. In fact, it

Opposition No. 91152646

encompasses consumers ranging from large corporations to an individual making a movie who seeks production music therefor.

Applicant argues that its services of musical composition are web-based, sold royalty-free on a per-project basis (without usage restrictions), and allowing the customer to rearrange and remix the musical product; whereas with opposers' services the music product purchased is generally packed and shipped in CD form, priced according to type of usage, and customers are prevented from modifying the music. Applicant concludes "there are clear distinctions in [the parties'] products and services, including structure, composition, and delivery." (Brief, p. 12.)

However, in this Board proceeding involving only the question of registrability, applicant has applied for "music composition for others." Thus, applicant's arguments relating to these differences are not relevant. In any event, we note that the argument is unpersuasive because opposers offer their various music services (production, publishing, etc.) primarily via CD, but they also offer their services on the Internet, and applicant offers its music composition services primarily via the Internet, but it also offers its services via CD -- even if only rarely.

Opposition No. 91152646

We find that the parties' respective identified services are similar in nature. Further, we find that applicant's identified services are closely related to the opposers' identified goods in the registrations, specifically, "prerecorded audio and video tapes" and "musical sound recordings."

Inasmuch as there are no limitations on trade channels or purchasers in the identifications of services in applicant's application or the goods and services in opposer BMG's registrations, the parties' respective goods and services must be considered to move in the same channels of trade, and would be offered to similar classes of purchasers. See *Octocom Systems v. Houston Computer Services*, supra; and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). We find that the parties' goods and services move in the same or at least overlapping channels of trade to the same or at least overlapping classes of customers.

Applicant argues that applicant's and opposers' involved services are offered to sophisticated customers who purchase not on impulse but with care and through an extended sales cycle, involving extensive interaction and discussions with the customers, and primarily for commercial use. (Applicant's brief, pp. 14-15.)

Opposition No. 91152646

Purchasers, either corporate/commercial or individual, of applicant's music composition services and of opposers' production music services may make such purchasing decisions with at least some degree of care. However, even if purchased with care, and through in-person discussions by sophisticated purchasers, these purchasers are not immune from confusion as to the source of services, particularly when they are sold under similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Moreover, there is no limitation in either applicant's identification of services or in those of opposers' registrations as to purchases being made by a particular class of purchasers and/or that the services are intended primarily for commercial use. Thus, there could be a mix of potential customers for both applicant's and opposers' services, including sophisticated consumers in the television and movie industries and on the Internet and individuals who choose to obtain music or sounds for their personal use, such as home movies or websites. That is, one segment of potential purchasers of these services is the general public. Where both professionals and members of the general public are relevant consumers, the standard is equal to that of the least sophisticated consumer. See e.g., *In*

re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992); and In re Artic Electronics Co., Ltd., 220 USPQ 836 (TTAB 1983).

We turn next to consideration of the similarities or dissimilarities of the marks, and our initial determination relates to opposers' assertion of a "family" of KILLER marks. (See, e.g., opposers' brief, p. 5).⁸ The "family" of marks doctrine has applicability in those situations where, prior to a defendant's first use of its challenged mark containing a particular feature, the plaintiff had established a family of marks characterized by that feature, so that the defendant's subsequent use of its mark containing the feature for goods or services which are similar or related to plaintiff's will cause the relevant purchasing public to assume that defendant's mark is yet another member of plaintiff's family. See *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); and *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307, 311-312 (TTAB 1978).

⁸ Opposers did not plead a "family" of KILLER marks, mentioning only the two individual KILLER MUSIC and design and KILLER TRACKS marks, and referring throughout the pleading only to those two marks as opposers' "KILLER Marks." Applicant made no objection on the basis that the issue was not pleaded. It is clear from the record that opposers' asserted "family" of KILLER marks was tried by the parties. Accordingly, opposers' notice of opposition is hereby deemed amended to conform to the evidence in accordance with Fed. R. Civ. P. 15(b) to include a claim of a "family" of several KILLER marks.

Opposition No. 91152646

It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar or related goods or services is insufficient to establish, as against a defendant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to defendant's first use of its challenged mark, the various marks said to constitute the plaintiff's family, or at least a good number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 403, 164 USPQ 43 (CCPA 1969); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); and *Dan River, Inc. v. Apparel Unlimited, Inc.*, 226 USPQ 186 (TTAB 1985).

The problem with opposers' claim of a "family" of KILLER marks is that there is insufficient evidence showing use of these marks together as a "family" of marks prior to applicant's use of its KILLER SOUND and design mark in April 1999. The record shows that opposers have used the marks KILLER MUSIC since 1990, KILLER TRACKS since 1989, and KILLER LATINO since 1997. However, the dates of first use of several of opposers' other asserted "KILLER" marks are

Opposition No. 91152646

subsequent to applicant's proven first use of its mark. For example, KILLER EDGE was first used in 1999, KILLER PROMOS in 2000, KILLER ANIMATION in 2000, KILLER SCORES around 2001, KILLER FX in 2001 or early 2002 and KILLER SONIFER in 2002. (Gross dep., pp. 25, and 67-69.) While there is some evidence of opposers' use of two or more "KILLER" marks together, it is insufficient to establish a "family" of KILLER marks recognized by the purchasing public as all indicating source in opposers. In addition, as explained above, much of opposers' evidence of use of a "family" of KILLER marks involves use subsequent to applicant's first use of its mark. Thus, we find that opposers have not established a "family" of KILLER marks.

Although opposers have otherwise relied on two registered marks, in considering the similarities/dissimilarities between applicant's mark KILLER SOUND and design and opposers' KILLER MUSIC (and design) and KILLER TRACKS (in typed form) marks, we will focus on opposers' KILLER TRACKS mark.

Our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more

Opposition No. 91152646

significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, the word portion of applicant's mark is KILLER SOUND, and opposers' mark is KILLER TRACKS. Thus, these marks share the dominant term KILLER. Importantly, both applicant's mark and opposers' mark begin with the same first word, and it is often the first word that is most memorable to consumers. See *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1981).

We acknowledge that the term "killer" may have a very broad, general suggestive connotation in that it has a dictionary meaning. Specifically, we take judicial notice of the following dictionary definitions of "killer":⁹

- (i) "adjective: ... 2. Slang Having impressive or effective power or impact; formidable: had a killer smile; made killer profits" The American Heritage Dictionary (Fourth Edition 2000); and
- (ii) "adjective. 1. strikingly impressive or effective <a killer smile> <a killer resumé>"

⁹ See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12 (2d ed. rev. 2004).

Merriam-Webster's Online
Dictionary.

This general connotation would be applicable to both applicant's and opposer BMG's marks. Thus, applicant's mark connotes that its services (music composition) will result in the customer obtaining very impressive or "killer" sound. Likewise, with regard to opposers' mark, it connotes very

impressive or "killer" soundtracks. The second word in the respective marks, "sound" and "tracks" have a similar meaning in the context of the involved goods and services. That is, the underscore of sound or music for a film, a television show or a website, is generally known as a "soundtrack." We take judicial notice of the following definition of the term "track" from The Random House Dictionary (1987): "...**14. Recording. a.** a band of recorded sound laid along the length of a magnetic tape. ... **d.** a discrete, separate recording that is combined with other parts of a musical recording to produce the final aural version: *a special rhythm track added to the basic track. ...* **18. soundtrack.**" Applicant's argument regarding the many meanings of the terms "sound" and "track" are not persuasive because we must consider the connotations of words and perceptions thereof by purchasers in the context of the involved goods and services. These marks, KILLER SOUND and KILLER TRACKS, connote very similar meanings.

Clearly, we recognize that applicant's mark includes a black and white circular or spiral design around the words "killer·sound," while opposers' KILLER TRACKS mark is in typed form only. The design feature of applicant's mark is not sufficient to obviate a finding of likelihood of confusion. The proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks,

Opposition No. 91152646

but rather must be on the recollection of the average purchaser, who normally retains a general rather than specific impression of the many trademarks encountered; that is, a purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrision, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992). Importantly, when spoken, the design feature of applicant's mark is not necessarily seen by the purchasers. Even when seen by purchasers and potential purchasers, they may mistakenly believe that applicant's mark is another revised version of opposers' KILLER MUSIC and design and KILLER TRACKS marks, with both parties' marks serving to indicate origin in the same source.

Although the parties' marks are certainly not identical, when considered in their entirety, we find that applicant's mark and opposers' registered KILLER TRACKS mark are somewhat similar in appearance, and that they are particularly similar in sound, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). Their contemporaneous use, on and in connection with the related goods and similar services, would be likely to cause confusion as to the

source or sponsorship of such goods and services. See *Cunningham v. Laser Golf Corp.*, supra.

Another du Pont factor we consider in this case is the fame of opposers' mark KILLER TRACKS. "Fame of an opposer's mark or marks, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors.'" *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002), quoting *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). See also, *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Opposers have used this mark for over ten years. They have experienced "steady growth" (Gross dep., p 34), generating over \$52.5 million in sales for the goods and services sold under the KILLER TRACKS mark in the last ten years. Advertising for these goods and services under the KILLER TRACKS mark amounted to over \$300,000 - \$350,000 per year during that time frame. The record shows that opposers have received extensive media coverage, including stories about opposers and their mark KILLER TRACKS, reviews which include the music credit to KILLER TRACKS, etc. This coverage includes extensive coverage in the media production trade and industries, which are one type of relevant consumers of the goods and services involved herein, as well

as in general consumer media. (Opposers' Notice of Reliance under Trademark Rule 2.122(e), exhibit A.)

Based on this record, we conclude that opposers have demonstrated the mark KILLER TRACKS is famous, and is thus entitled to a broad scope of protection. See *Bose Corporation v. QSC Audio Products, Inc.*, 293, F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002).¹⁰

The fame of opposer BMG's KILLER TRACKS mark plays a dominant role in the du Pont factor analysis. Indeed, the fame of this mark increases the likelihood that consumers will believe that applicant's services emanate from or are sponsored by or are associated with opposers.

Applicant argues, under its heading "The Number Of Similar Marks In Use With Similar Goods," that the existence of third-party registrations which include the word "KILLER" in the mark and which are for similar or related goods and services supports a finding of lack of confusion. (Brief, pp. 15-16.) In support thereof, applicant submitted its notice of reliance under Trademark Rule 2.122(e) on five third-party registrations and one third-party application.

¹⁰ Applicant argued that there is no direct evidence of consumer recognition and commented that opposer "failed to submit customer testimony or a single consumer survey to demonstrate the purported strength of their marks." (Brief, p. 9.) This argument is unpersuasive as neither customer testimony nor consumer surveys are necessary to establish fame or the strength of the mark. See *Bose v. QSC*, supra; and *Hilson Research v. Society for Human Resource Management*, 27 USPQ2d 1423, 1435-1436 (TTAB 1993).

Opposition No. 91152646

The third-party application carries no weight as it is evidence only that the application was filed on a particular date. The five third-party registrations submitted by applicant are likewise totally devoid of evidentiary value with regard to this du Pont factor because third-party registrations do not establish that the marks shown therein are in use, or that the public is familiar with them. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). There is no evidence before us of any use by any third-party of any mark including the word "KILLER" for the same or related goods or services.

Regarding the du Pont factor of "the nature and extent of any actual confusion," the only evidence thereon is from applicant, whose witness testified about one instance of actual confusion and three inquiries regarding whether there was an affiliation between applicant and opposers. (Gelat dep., pp. 101-106.) Opposers' witness testified that he was not directly aware of any instance of actual confusion. (Gross dep., pp. 93-94.)

Applicant argues in its brief that there is an absence of any "credible instance of actual confusion"; and that the few instances about which applicant's witness testified are de minimis, particularly in light of applicant's 20,000 hits

per month on its website and its 75-100 telephone and e-mail inquiries each month.

We agree with applicant that there is not evidence of significant numbers of customers or potential customers actually confused regarding the involved marks for the involved goods and services. However, in light of the co-existence of the parties' respective marks for only about five years, we find that this factor is neutral. Moreover, the test is not actual confusion, but likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Even if this factor were found to favor applicant, it is outweighed by the other du Pont factors in this case which favor opposers.¹¹

On balance, and considering all of the evidence on the relevant du Pont factors, and giving each such factor its appropriate weight in the circumstances of this case, we find that there is a likelihood that the purchasing public would be confused when applicant uses KILLER SOUND and design as a mark for its services.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against applicant who is the newcomer, as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d

Opposition No. 91152646

1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The opposition is sustained.

¹¹ We specifically note that we do not find that the evidence establishes that potential confusion would be de minimis.