

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gibson Brands, Inc.
Serial No: 88022643
Filed: July 2, 2018
Mark: CORVUS

TRADEMARK ACT SECTION 2(d) REFUSAL RESPONSE

On August 20, 2018, the Examining Attorney refused to register the above applied-for mark because of a likelihood of confusion with the mark in U.S. Registration No. 5283926, reproduced below.



The Lanham Act §2(d) prevents registration of a mark on the principal and supplemental register that is likely to be confused or mistaken or deceived, by potential consumers, as to the source of the goods of the applicant and the registrant. 15 U.S.C. §1052(d). Mark 5283926, registered September 12, 2017, is for use in International Class 009 for G & S: Cases for mobile phones; Hands-free kits for phones; Protective cases for smartphones; Smartphones; Batteries and battery chargers; Blank flash memory cards; Blank USB cards; Cases for smartphones; Downloadable ring tones for mobile phones; Earphones and headphones; Loudspeakers; Mobile phone straps. Gibson Brands, Inc. (“Gibson”) argues that the applied-for mark, CORVUS, will not likely confuse consumers as to the origin of the goods in the application; namely, guitars; electric guitars.

No Likelihood of Confusion

There is no likelihood a potential consumer will be confused, mistaken, or deceived between the Applicant’s mark and the Registrant’s marks as to the source of the goods offered in commerce. Federal courts and the Board have consistently held that

likelihood of confusion exists between two marks only if a reasonably prudent purchaser is likely to be confused as to source or sponsorship of the services. *See In re E.I. du Pont de Nemours & Co*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Thirteen principal factors are to be considered in a likelihood of confusion analysis; 1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impressions, 2) the similarity or dissimilarity of and the nature of goods described in an application or registration in connection with which a prior mark is in use, 3) the similarity or dissimilarity of established, likely-to-continue trade channels, 4) the conditions under which potential consumers purchase-impulse versus careful sophisticated purchasing, 5) the fame of the prior mark, 6) the number and nature of similar marks in use on similar goods, 7) the nature and extent of actual confusion, 8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, 9) the variety of goods on which a mark is or is not used, 10) the market interface between the applicant and the owner of the prior mark, 11) the extent to which applicant has a right to exclude others from use of its mark on its goods, 12) the extent of possible confusion-de minimus or substantial, and 13) any other established fact probative to the effect of use. *Id.*

Analysis of the applicable factors illustrates that there is no likelihood of confusion between Gibson's applied for mark and Registrant's mark. The Examining Attorney rejected Gibson's mark based on the similarity of the marks, similarity of the goods, and similarity of the trade channels of the goods. In addition to the three DuPont factors examined by the Examining Attorney, the conditions under which potential consumers purchase-impulse versus careful sophisticated purchasing and the fame of the prior mark are also applicable in this case.

A. Similarity of the Marks

The marks are different in appearance and in sound because the registrants stylized word and design mark includes a distinctive bird design. The Office Action states "Where the word portions of the marks are identical in appearance, sound, connotation, and commercial impression; the presence of a design element in one of the marks does not obviate the similarity of the marks. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP

§1207.01(c)(ii).” See Office Action.

In considering sight, sound and meaning, it is axiomatic that conflicting marks must be compared in their entireties. *See Opryland USA, Inc., v. The Great American Music Show, Inc.*, 23 U.S.P.Q. 2d 1471, 1473-74 (Fed. Cir. 1992). A mark should not be dissected into its component parts and each part then compared with corresponding parts of a conflicting mark to determine confusion – it is the impression the mark as a whole creates that is important. *Id.* As explained by the Court of Appeals for the Federal Circuit:

[M]arks must be considered in the way they are perceived by the relevant public. Although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. Thus it is not dispositive whether...descriptive words are included as parts of the marks; that is simply a factor to be considered when viewing the mark as a whole.

Id.

Additionally, in determining whether a mark will give rise to a likelihood of confusion, an examining entity should note that the fundamental issue is not whether a court, an Examining Attorney, or a lawyer finds confusion between two marks, but whether the relevant buyers would be confused. *Daddys Junky Music v. Big Daddy Family Music*, 109 F.3d 275, 42 U.S.P.Q 1173 (6th Cir. 1997). As observed by the Eighth Circuit in *Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc.*, 815 F. 2d 500, 504 (8th Cir. 1987):

[V]isual inspections by the court are permissible as an aid in determining likely confusion. However, caution should be exercised to avoid putting too much stock in subjective inspection done in-chambers that is devoid of market characteristics. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do.

Applicant respectfully disagrees that the presence of the design element does not obviate the likelihood of confusion in the present case. Marks must be considered on a case-by-case basis. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do. In re Viterra Inc., 671 F.3d 1358, 1362-63 (Fed. Cir. 2012), the Court states, “we also have cautioned that there is no general rule that the letter portion of the mark will form the dominant portion of the mark.”

Applicant believes that the Examiner fails to give adequate weight to the design portion of the Cited Mark. First, regarding the design portion, the design clearly shows a flying bird. This bird is likely a crow or raven as *corvus* is the Latin word for raven and used as the genus name for medium-large birds in the *Corvidae* family. The design of the Cited Mark well captures the background of use of birds to demonstrate mobile type devices. For example, see https://en.wikipedia.org/wiki/Ningbo_Bird (last visited September 4, 2018) and <https://en.wikipedia.org/wiki/Twitter> (last visited September 4, 2018). See Exhibit A. After all, what is more mobile than a bird? It is likely that consumers buying the goods of the Cited Mark are going to associate the mark with something that is highly transportable. Accessories for mobile phones are designed to be mobile; a guitar, not so much.

In evaluating the similarity or dissimilarity of the marks, a particular feature or portion may be accorded more weight if it makes a memorable impression that consumers will remember and rely upon to identify the services at issue. In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987); In re Apparel Ventures, Inc., 229 USPQ 225, 226 (TTAB 1986). In this situation, the design of the bird is significant and arguably the most dominant portion of the mark. It’s unlikely that a consumer buying the goods associated with the Cited Mark would think they could get the same easy mobility out of a guitar.

“If a purchaser would be more likely to remember and use one part of a mark as indicating *origin* of goods, this is the dominant part of the mark.” Price Candy Co. v. Gold Medal Candy Corp., 220 F.2d 759, 761, 105 USPQ 266, 268 (CCPA 1955) (emphasis in original). In comparing marks, the dominant or salient features receive

greater weight than other features. Mktg. Displays v. Traffix Devices, 200 F.3d 929, 53 USPQ2d 1335 (6th Cir. 1999), *rev'd on other grounds*, Traffix Devices v. Mktg. Displays, 532 U.S. 23, 121 S. Ct. 1255, 58 USPQ2d 1001 (2001); Universal Money Ctrs., Inc. v. Am. Tel & Tel. Co., 22 F.3d 1527, 30 USPQ2d 1930, 1933 (10th Cir. 1994); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); Henri's Food Prods. Co. v. Kraft, Inc., 717 F.2d 352, 356, 220 USPQ 386, 389 (7th Cir. 1983); Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 224 USPQ 185, 190 (4th Cir. 1984). Because a consumer of the goods in the Cited Mark is most likely looking for a mobile phone accessory, they will instantly recognize Applicant's goods as coming from a separate source when coming in contact with CORVUS and the Applicant's goods.

This is bolstered by the Applicant's previous use and registration of the CORVUS mark in association with guitars. Applicant's successor in interest first began using the CORVUS mark in association with guitars in 1982. And although Applicant's initial run of the guitars didn't last long, an entire new generation was exposed to the CORVUS guitar when it was a feature of the Guitar Hero video games.

https://en.wikipedia.org/wiki/Gibson_Corvus (last visited September 4, 2018). *See Exhibit A.*

The large size of the design in relation to the word portion of the composite mark also supports the importance of the design. The Examining Attorney points out that the marks are similar because they both contain the term CORVUS. Applicant does not dispute that both marks contain CORVUS but because the logo is dominant in the Cited Mark, it should be given significantly more weight than CORVUS in determining the likelihood of confusion. It is proper to give the dominant portion of the mark more consideration in an analysis of the similarity of the marks. *See Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 163, 23 USPQ2d 1945 (Fed. Cir. 1992) (giving kangaroo design significantly more weight in a likelihood of confusion analysis as the dominant mark); Sweats Fashions, Inc. v. Pannill Knitting Co., Inc., 833 F.2d 1560, 1566, 4 USPQ2d 1793 (Fed. Cir. 1987) (recognizing that some features of a mark are more distinctive than others); and Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 USPQ 390 (Fed. Cir. 1983) (finding it proper to give greater force to

dominant feature). It appears that even the Trademark Office agrees as *the Applicant had an active registration when the USPTO registered the Cited Mark without finding a likelihood of confusion. See Exhibit A.*

A design is viewed, not spoken. However, unlike cases where preference is given to the word portion of a mark because the goods/services are “often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant’s mark which is more likely to be impressed on the consumer’s member,” the music industry consumer exhibits different behavior. See *Dixie Rests., Inc.*, 105 F.3d 1405, 1408 (Fed. Cir 1997). Guitar purchasers will look at the entire guitar when making a selection, by viewing the words and any logo in the same context, as opposed to simply seeing written (or hearing oral) lists of products outside of context. The current situation is like the *Redneck Racegirl* mark, where the TTAB focused on the visual aspects of the marks because consumers would be encountering these marks in the retail settings on hang-tags and labels. See *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods). It is also similar to the *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) case, which held VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause confusion. This DuPont factor weighs towards finding no likelihood of confusion.

B. Differences in the Goods

The second DuPont factor cited by the Examiner concerns the similarity or dissimilarity and nature of the goods or services. The Examiner states that both the existence of third party marks registered for use in connection with the same or similar goods as those of both Applicant and Registrant in this case and the fact that the goods are complementary supports weighing this DuPont factor against the Applicant. If you went to a store and asked for a loudspeaker or ear buds, no one would hand you an electric guitar. Supporting their differences, the trademark office has placed them in different international trademark classes.

Gibson’s application covers guitars and electric guitars, period. There is no evidence that the owner of the Cited Mark will expand their use of the stylized CORVUS

word and design mark to cover guitars, especially as the two products contain vastly different engineering. An examination of the goods in the Cited Mark shows mobile phone accessories. Earphones, headphones, and loudspeakers are mobile phone accessories. Nearly every electronic device that has sound incorporates a type of loudspeaker and a port for headphones. This does not make loudspeakers and headphones complementary with every electronic device with sound. If this were the case, a registration on loudspeakers and/or headphones would bar any manufacturer of an electronic device with sound from using a similar mark. This is simply not reality. The Examiner provided evidence of other guitar manufacturers marketing headphone and loudspeakers under the same mark as their respective guitars. Headphones and loudspeakers made for use with guitars are not complementary to headphones and loudspeakers intended to be used with mobile phones. In fact there is no suggestion, as an intent-to-use mark under 44(d), that the owner of the Cited Mark is actually even selling goods in the United States.

To support the contention of similar goods, the Examiner list owners of marks that list both guitars and loudspeakers in their trademark applications/registrations. However, it is uncommon for one company to manufacture both products at least to the point that it would confuse the consumer. The Examiner lists three companies, i.e. Yamaha, Fender, and Peavy that all provide both guitars and headphones. However, this is a VERY small subset of the group of companies that sell headphones. The Applicant comes up with more than 34,000 trademark listings for headphones as the goods. A sampling of ten marks chosen randomly shows different owners for all. NONE of these owners also have guitars listed as goods. *See Exhibit B.*

Yes, headphones and loudspeakers are used with guitars. However, headphones and loudspeakers are widely divergent and used on a host of other things, nearly every electronic device with sound. It is hard to imagine that the waterproof loudspeaker used for your pool party is somehow complimentary to an electric guitar. But it *is* likely that a customer would think they come from different sources.

Furthermore, guitars and headphones do not appear together in search results on the Internet. When you type in headphones in the Yamaha search engine, only headphones appear not guitars.

<https://usa.yamaha.com/search/index.html?search=headphones&p=10#> (last visited September 4, 2018). See Exhibit B. The same result is true when you type in headphones in popular reseller websites such as Amazon.

https://www.amazon.com/s/ref=nb_sb_noss_2?url=search-alias%3Daps&field-keywords=headphones (last visited September 4, 2018). See Exhibit B. Another place where they don't appear next to each other is music stores. In Exhibit B, Applicant has provided several pictures of the interior of music stores where guitars are easily recognized but loudspeakers/headphones are not included in the picture. The mere fact that the same products may be found in the same large stores is not sufficient to show the products are related. See Federated Foods Inc. v. Fort Howard Paper Co., 192 USPQ 24 (CCPA 1976) and In re Gelatini Int'l, Inc., S.N. 75/179,289 (October 6, 2000).

It is important to, once again, point out that the Applicant had an active registration for CORVUS with use for guitars (U.S. Reg. No. 4060702, cancelled June 29, 2018) when the USPTO registered the Cited Mark without finding a likelihood of confusion. See Exhibit A. A finding of headphones and loudspeakers being complimentary is directly contrary to the USPTO's previous ruling.

The goods of the Cited Mark and the Applicant's mark are simply not close enough that there would be a likelihood of confusion by a consumer. Therefore, this DuPont factor must also weigh in the Applicant's favor.

C. Consumer Sophistication

The consumer who purchases a guitar containing the Applicant's CORVUS mark is likely to be very sophisticated. "When goods are sold to consumers that exercise care there is less chance that confusion will occur." PC Club v. Primex Technologies, Inc., 32 Fed. Appx. 576, 579 (Fed. Cir. 2002).

In the past, a CORVUS guitar was not entry level and historical versions of the guitar cost upwards of \$1500. https://reverb.com/item/13937132-gibson-corvus-i-1983-natural?gclid=EAIaIQobChMIyKWKzvqD3QIVg7jACh0egAFtEAQYAiABEgJyu_D_BwE&gclsrc=aw.ds&pla=1 (last visited September 4, 2018). See Exhibit C. Any consumer purchasing an electric guitar will not spend this large amount of money on impulse but rather will carefully analyze their options.

Not only does the price point highly dissuade impulse purchasing, the years spent learning to professionally play the guitar show that there will be no likelihood of confusion. The purchaser is most likely to be an artistic professional or serious hobbyist spending a large amount of money on a musical instrument. Applicant (and experts on consumer research) can hardly think of another group of purchasers more likely to pay careful attention to purchases that are both expensive and expected to make a difference in the performance of purchasers' art. *See* Robin A. Higie & Lawrence F. Feick, *Enduring Involvement: Conceptual and Measurement Issues*, in 16 *ADVANCES IN CONSUMER RESEARCH* 690, 693 (Thomas K. Srull ed., 1989) and PIRJO LAAKSONEN, *CONSUMER INVOLVEMENT: CONCEPTS AND RESEARCH* (1994), page 172. It is not only the cost of the goods that makes this consumer particularly likely to exhibit a high degree of care in purchasing (although courts have recognized guitars as an expensive enough purchase for high customer involvement, see *Switchmusic.com, Inc. v. U.S. Music Corp.*, 416 F. Supp. 2d 812, 824–25 (C.D. Cal. 2006)) but also their background as an artist, i.e. special training. *See* JEROME GILSON & ANNE GILSON LALONDE, *TRADEMARK PROTECTION AND PRACTICE* § 5.08 (2004) and RUDOLF CALLMANN, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 21:12 (Louis Altman ed., 2003) (stating that a professional or sophisticated buyer's detailed knowledge of the product and careful examination with respect to its technical requirements are factors of greater significance than the trademarks used.)

“[C]ircumstances suggesting care in purchasing may tend to minimize likelihood of confusion.” T.M.E.P. § 1207.01(d)(viii). *See also* *In re Amsted Industries Inc.*, 972 F.2d 1326, 24 U.S.P.Q.2d 1067 (Fed. Cir. 1992) (considering particularly the sophistication of wire rope purchasers in overturning the TTAB refusal to register). The sophistication of purchasers “is important and often dispositive” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992). *See, e.g.* *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 35 U.S.P.Q.2s 1449 (2nd Cir.1995); *Astra Pharmaceutical, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983). There are also many instances where the TTAB has reversed an Examining Attorney's finding of a likelihood of

confusion between an applicant's mark and the cited mark based, in part, on the sophistication of the consumer. In re Deceuninck N. Am. LLC, Serial No. 77465459 (TTAB May 27, 2009) unpublished; In re Boler Co., Serial No. 77059048 (TTAB Feb. 17, 2009) unpublished; In re Trend Elecs. Int'l, Inc., Serial No. 77003068 (TTAB May 9, 2008) unpublished; In re Bridger Mgmt., LLC, Serial No. 78816349 (TTAB Dec. 28, 2007) unpublished; In re Invivo Corp., Serial No. 78670679 (TTAB Sept. 5, 2007) unpublished; In re Crosswalk, Inc., Serial No. 78424189 (TTAB Aug. 2, 2007) unpublished; In re Frank's Int'l, Inc., Serial No. 76599870 (TTAB Mar. 22, 2007) unpublished; In re Cyberchannel Inc., Serial Nos. 76567272 and 76567273 (TTAB Mar. 15 2007) unpublished. The sophistication of the consumer weighs strongly towards a lack of confusion between the Applicant's mark and the Registrant's mark.

D. Fame of the Marks in Question

The fame or strength of a mark is an important consideration in the likelihood of confusion analysis. In assessing the fame or strength of a mark, it is useful to evaluate two primary criteria: (1) the intrinsic strength or distinctiveness of a mark, and (2) the extent to which the mark has acquired strength through use and promotion in the marketplace. Here, the Cited Mark is not famous. In fact, Applicant cannot find any use at all in the United States.

Therefore, this final relevant DuPont factor also weighs in favor of the Applicant.

CONCLUSION

Applicant believes it has responded to the Examiner's rejection based on a likelihood of confusion. It is clear from a closer analysis of the DuPont factors, incorporating the evidence provided, that there is no likelihood consumers will be confused between Applicant's mark and the Cited Mark.

"In every case turning on the likelihood of confusion, it is the duty of the examiner ... to find, upon consideration of all the evidence, whether or not confusion appears likely." In re E.I. DuPont, 476 F.2d at 1362 (emphasis in original). Here, the strongest consideration should be given to the differences in the marks, the differences in the goods, the sophistication of the purchaser, and the lack of fame of the prior mark.

The Examiner's current finding of a likelihood of confusion between the cited mark and Applicant's Mark is directly contrary to the USPTO previously allowing the registration for the Cited Mark while Applicant had an active registration for CORVUS for use with guitars.

In view of the foregoing, the Applicant respectfully requests that the Examining Attorney retract the refusal to register Applicant's Mark and approve Application No. 88022643 for publication.