

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*UMG Recordings, Inc.*

*v.*

*KG Music Center LLC*

—  
Opposition No. 91267804  
—

David Donahue, Jason D. Jones, and Kimberly B. Frumkin of Fross Zelnick  
Lehrman & Zissu PC, for UMG Recordings, Inc.

William E. OBrien of OBrien Global Law, for KG Music Center LLC.

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Before Lykos, English and Lebow,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the standard-character mark IMPULSE MUSIC COMPANY (MUSIC COMPANY disclaimed) for “on-line retail store services featuring musical instruments; retail store services featuring musical instruments” in International Class 35 and “entertainment services in the

nature of live musical performances; instruction in the field of music; music production services” in International Class 41.<sup>1</sup>

In its notice of opposition, Opposer alleges a claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on prior common law use of the mark IMPULSE and IMPULSE-formative marks through its predecessors-in-interest and licensees for “a wide variety of goods and services, including, without limitation, music- and entertainment-related goods and services, as well as an extensive merchandising program”<sup>2</sup> and ownership of a registration for the standard-character mark IMPULSE on the Principal Register for “pre-recorded audio discs, digital audio discs, CDs, and phonograph records featuring music or entertainment; theatrical and musical sound or video recordings; downloadable ring tones, music, [and] mp3 files, via a global computer network and wireless devices” in International Class 9.<sup>3</sup>

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<sup>1</sup> Application Serial No. 88961421, filed on June 12, 2020 based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>2</sup> 1 TTABVUE 3-5, ¶¶ 1-3, 7, 10.

Citations to the record and the parties’ briefs in this opinion are to the publicly available documents on TTABVUE, the Board’s electronic docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable. Portions of the record have been designated confidential. The citations to the record refer to the redacted, publicly available versions as well as the confidential entries, where applicable.

<sup>3</sup> Registration No. 3356087 issued on December 18, 2007 and has been renewed.

Opposer also pleaded claims of dilution by blurring and tarnishment under Trademark Act Section 43(c), 15 U.S.C. § 1125(c), *see* 1 TTABVUE 6, ¶¶ 17-20, but has expressly withdrawn both claims so we give them no consideration. Opposer’s Brief, 37 TTABVUE 18, n.3.

In its answer, Applicant denies the salient allegations in the notice of opposition.<sup>4</sup>

The opposition is fully briefed. For the reasons explained below, we find that Opposer has established its entitlement to a statutory cause of action and Trademark Act Section 2(d) claim by a preponderance of the evidence with respect to both classes. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). We sustain the opposition.

### **I. Opposer’s Pleading of Prior Common Law Rights**

In its notice of opposition, Opposer broadly alleges common law rights in the mark “IMPULSE and other IMPULSE-formative trademarks and services marks ... in

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<sup>4</sup> 4 TTABVUE. The answer also includes purported “Affirmative Defenses.” Applicant’s assertion that the “Notice of Opposition fails to state a claim upon which relief can be granted” (5 TTABVUE 4) is not an affirmative defense. *See, e.g., Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at \*3 n.5 (TTAB 2022).

Applicant’s allegations that “Opposer does not use” its pleaded mark “on all items listed in its application” and “has abandoned or lost rights” in its mark (5 TTABVUE 5) are collateral attacks against Opposer’s pleaded registration that are the proper subject of a compulsory counterclaim and cannot be pursued because Applicant did not counterclaim to cancel the pleaded registration. *See* Trademark Rule 2.106(b)(3)(ii), 37 C.F.R. § 2.106(b)(3)(ii) (attack on validity of pleaded registration must be made by counterclaim or separate petition to cancel); *see also, e.g., Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007).

Applicant has not pursued the affirmative defenses of laches, estoppel, acquiescence, unclean hands or waiver (5 TTABVUE 5) so these affirmative defenses have been waived or forfeited. *See, e.g., Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422-23 n.7 (TTAB 2014).

Applicant’s allegation that “Opposer cannot claim exclusive rights” in its mark because “the term is a widely used mark that has become diluted by third party uses of the term IMPULSE” (5 TTABVUE 5) is an amplification of Applicant’s denial of Opposer’s allegation that its mark has “developed extensive goodwill and consumer recognition and [has] become famous and well-known in the United States and throughout the world.” 1 TTABVUE 4, ¶ 3. *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*4 n.5 (TTAB 2021) (“Although it is permissible to amplify a denial of, for example, an allegation of a likelihood of confusion in a pleading, such amplification is not, and should not be pled as, a separate ‘defense,’ and we do not treat it as such here.”) (internal citation omitted).

connection with a wide variety of goods and services, including without limitation, music- and entertainment-related goods and services, as well as an extensive merchandising program.”<sup>5</sup> Opposer, however, does not identify the specific IMPULSE-formative marks it uses, the “music- and entertainment-related goods and services” it offers, or the merchandise that it sells as part of its “merchandising program.” As such, the notice of opposition did not place Applicant on sufficient notice of the common law rights on which Opposer seeks to rely. Applicant calls out this deficiency in its brief:<sup>6</sup>

Opposer has not pled that it provides any specific services of the type offered by Applicant. In its notice of opposition it has merely made a broad, general statement that it uses its mark in connection with “a wide variety of goods and services, including without limitation, music- and entertainment related goods as services, as well as an extensive merchandising program.” However, Opposer has provided no specifics that would support use of the mark in connection with any services and certainly none of the services provided by Applicant.

In its brief, however, Applicant acknowledges that “Opposer is in the business of producing and manufacturing jazz records,”<sup>7</sup> citing the trial testimony of Opposer’s witness, James Krents, including his testimony that Opposer, through a predecessor-in-interest, “has used the IMPULSE Mark on the records it produces and manufactures” in the form shown below:<sup>8</sup>

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<sup>5</sup> 1 TTABVUE 3-5, ¶¶ 1-3, 7, 10.

<sup>6</sup> Applicant’s Brief, 38 TTABVUE 18.

<sup>7</sup> *Id.* (citing paragraphs 5, 9 and 15 of the Krents Declaration).

<sup>8</sup> Krents Declaration, 19 TTABVUE 3-4, ¶¶ 5, 9.



Applicant further recognizes that “Opposer has provided ample evidence” that it is a “record label” that “manufacture[s], distribute[s], and promote[s] the recordings of musicians affiliated with the label”<sup>9</sup> and that “Opposer sells jazz music,” including jazz LPs, CDs and boxed sets.<sup>10</sup>


Fed. R. Civ. P. 15(b)(2), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), provides, in pertinent part, that when issues not raised by the pleadings are tried by the express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. *Hole in 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at \*6 (TTAB 2020). “Implied consent to the trial of an unpleaded issue can be found only where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 507.03(b) (2023); *see also Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-21 (TTAB 2008); *Boise Cascade Corp. v. Cascade Coach Co.*, 168 USPQ 795, 797 (TTAB 1970) (“Generally speaking, there is an implied consent to contest an issue if there is no objection to the introduction of evidence on the unpleaded issue, as long as the adverse party was fairly informed that the evidence went to the unpleaded issue.”). “The question of whether an issue

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<sup>9</sup> *Id.* at 20 (citing the Krents Declaration).

<sup>10</sup> *Id.* at 22.

was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter.” *Morgan Creek*, 91 USPQ2d at 1139; *see also* TBMP § 507.03(b).

Applicant has not expressly consented in its brief to the trial of likelihood of confusion based on Opposer’s asserted prior common law rights in the IMPULSE-formative mark  for jazz music recordings and jazz record label services. The Board, however, “has found that an issue was tried by implied consent where the non-offering party raised no objection to the introduction of evidence on the issue and in its brief treated the evidence as being of record, or discussed the issue in its brief as though it were part of the pleading.” *Morgan Creek*, 91 USPQ2d at 1138.


Applicant in its brief has treated the Krents Declaration as part of the record and acknowledged that Opposer “manufacture[s], distribute[s], and promote[s] the recordings of musicians affiliated with the label”<sup>11</sup> and “is in the business of producing and manufacturing jazz records.”<sup>12</sup> Applicant also has argued against a likelihood of confusion on the ground that it “does not offer services of a record company or a record label” as it does not “manufacture, distribute, or promote recordings of musicians.”<sup>13</sup>

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<sup>11</sup> *Id.* at 10.

<sup>12</sup> *Id.* at 18 (citing paragraphs 5, 9 and 15 of the Krents Declaration).

<sup>13</sup> *Id.* at 18, 20; *see also* Gonzales-Lancharro Declaration, 25 TTABVUE 9, ¶¶ 18, 21 (testifying that Applicant “is not in the business of music production, recording, composition, or any other field that IMPULSE! Records [is] engaged with. ... In my experience working with record labels, recording, and producing music, [Applicant] has never overlapped with any goods or services provided by [Opposer].”).

We find that a claim of likelihood of confusion based on Opposer's prior common law use of the mark  for jazz music recordings and record label services, namely, the production, manufacture, distribution and promotion of jazz music recordings, has been tried by implied consent.

## II. Evidentiary Objections and Issues

### A. Opposer's Objection to Collin Hockenbury's Testimony

Opposer objects to the testimony in paragraphs 10-13 of Collin Hockenbury's declaration:<sup>14</sup>

10. Record companies do not sell musical instruments.
11. Record companies do not repair musical instruments.
12. Record companies do not provide music lessons, seminars, master classes and the like.
13. Record companies do not organize open mic sessions.

Opposer argues that this testimony is based on "facts and information beyond [Mr. Hockenbury's] personal knowledge"<sup>15</sup> and to the extent "Mr. Hockenbury has expertise as to the industry practice and/or behavior of record companies, [Applicant] has failed to identify Mr. Hockenbury as an expert or provide [Opposer] with an expert report and, thus, this testimony must be stricken as improper expert testimony."<sup>16</sup>

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<sup>14</sup> 25 TTABVUE 4. Mr. Hockenbury is Applicant's co-owner and manager. *Id.* at 2, ¶ 2.

<sup>15</sup> Opposer's Evidentiary Appendix, 37 TTABVUE 45.

<sup>16</sup> *Id.* at 46.

Applicant does not contend that Mr. Hockenbury is an expert nor do we treat his testimony as expert testimony. We find that paragraphs 10-13 of the Hockenbury Declaration consist of lay witness testimony. Federal Rule of Evidence 701 provides: “If a witness is not testifying as an expert, testimony in the form of an opinion is limited to one that is: (a) rationally based on the witness’s perception; (b) helpful to clearly understanding the witness’s testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702.”

Mr. Hockenbury testified that he has been working in the music industry for ten years in retail stores, music academies and playing live music in private and public venues.<sup>17</sup> He also testified that he manages Applicant’s business of renting and repairing musical instruments, providing music lessons, seminars and master classes, and hosting open mic nights.<sup>18</sup> On cross-examination, Mr. Hockenbury testified that he “works with record labels” to the extent Applicant sells and repairs musicians instruments.<sup>19</sup>

This testimony is not sufficient to demonstrate that Mr. Hockenbury has a rational basis to testify as to his perceptions about the record label business in paragraphs 10-13 of his declaration. We therefore sustain Opposer’s objection and

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<sup>17</sup> Hockenbury Declaration, 25 TTABVUE 2, ¶ 1.

<sup>18</sup> *Id.* at 2, ¶ 2.

<sup>19</sup> Hockenbury Cross-Examination, 35 TTABVUE 30.



have not considered the testimony in paragraphs 10-13 of the Hockenbury Declaration.<sup>20</sup>

### **B. Other Evidentiary Issues**

Some of the evidence Applicant introduced under notice of reliance is only partially legible and difficult to read. We have considered this evidence to the extent we can read it. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758, n.16 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.) (“[T]he onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board.”); *see also RxD Media, LLC v. IP Applicant Dev. LLC*, 125 USPQ2d 1801, 1802 (TTAB 2018) (“It is the responsibility of the party making submissions to the Board via the electronic database to ensure that the testimony or evidence has, in fact, been properly made of record.”).

In addition, there are Internet links in the parties’ briefs and testimony declarations. The Board does not access links to websites. *In re Future Ads LLC*, 103 USPQ2d 1571, 1572, n.3 (TTAB 2012) (“[T]he Board will not utilize a link or reference to a website’s internet address to access the site to consider whatever content may appear therein.”); *In re HSB Solomon Associates, LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012). We have considered the evidence corresponding to the links only to the extent printouts of the webpages have been properly introduced into the record.

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<sup>20</sup> This determination, however, has no effect on the outcome of this proceeding.

### III. The Record

The record includes the pleadings, and by operation of law, the file of the involved application. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). In addition, the parties introduced the evidence listed below.

#### A. Opposer's Trial Evidence

- Trial Declaration, and accompanying exhibits, of James Krents, "Executive Vice President of the Verve, Verve Forecast, and Impulse record labels at Verve Label Group, an unincorporated division of Opposer UMG Recordings, Inc.;"<sup>21</sup>
- First Notice of Reliance on printouts from the Office's Trademark Status and Document Retrieval (TSDR) database of Opposer's pleaded registration<sup>22</sup> and other registrations owned by Opposer;<sup>23</sup>
- Second Notice of Reliance on TSDR printouts of third-party registrations;<sup>24</sup>
- Third Notice of Reliance on certain printed publications;<sup>25</sup> and
- Fourth Notice of Reliance on printouts from third-party websites.<sup>26</sup>

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<sup>21</sup> 17 TTABVUE (confidential); 19 TTABVUE (redacted).

<sup>22</sup> It was unnecessary for Opposer to introduce its pleaded registration under notice of reliance because it introduced the registration when it filed the opposition by attaching to its complaint a printout from the Office's Trademark Electronic Search System (TESS) database showing the current status of the registration and Opposer's ownership thereof, 1 TTABVUE 9-10. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

<sup>23</sup> 20 TTABVUE.

<sup>24</sup> 21 TTABVUE.

<sup>25</sup> 23 TTABVUE. We give no consideration to the duplicate copy of this filing at 22 TTABVUE.

<sup>26</sup> 24 TTABVUE.

### **B. Applicant's Trial Evidence**

- Trial Declaration of Collin Hockenbury, manager and co-owner of Applicant;<sup>27</sup>
- Trial Declaration of Augstin Gonzalez-Lancharro, co-owner of Applicant; and<sup>28</sup>
- Notice of Reliance on TSDR printouts of third-party certificates of registration and printouts from various third-party websites.<sup>29</sup>

### **C. Opposer's Rebuttal Trial Evidence**

- Cross-Examination Testimony of Collin Hockenbury;<sup>30</sup>
- First Rebuttal Notice of Reliance on TSDR printouts of a third-party registration and an application owned by Opposer;<sup>31</sup> and
- Second Rebuttal Notice of Reliance on printouts from a third-party webpage.<sup>32</sup>

## **IV. Entitlement to a Statutory Cause of Action**

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 U.S. 82 (2021)

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<sup>27</sup> 25 TTABVUE 2-5.

<sup>28</sup> 25 TTABVUE 6-9.


<sup>29</sup> 26 and 27 TTABVUE.

<sup>30</sup> 35 TTABVUE.

<sup>31</sup> 33 TTABVUE.

<sup>32</sup> 34 TTABVUE.

(citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark*, 572 U.S. at 129, 132); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020).

As discussed in Section V.B. below, Opposer has proven prior common law use of the mark  for jazz music recordings and record label services, namely, the production, manufacture, distribution and promotion of jazz music recordings. Accordingly, Opposer has established its entitlement to a statutory cause of action. *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*4 (TTAB 2019) (standing established by testimony, with exhibits, of use of a confusingly similar mark); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (where opposer alleged likelihood of confusion, testimony that it uses its mark “is sufficient to support [opposer’s] allegations of a reasonable belief that it would be damaged ....”); *Grand Canyon W. Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1502 (TTAB 2008) (standing established by testimony as to prior use of similar mark).

In addition, Opposer introduced printouts from the Office’s TESS and TSDR databases showing that its pleaded registration is active and owned by Opposer.<sup>1</sup> This

evidence also demonstrates Opposer's entitlement to a statutory cause of action. *Made in Nature, LLC v. Pharmavite, LLC*, 2022 USPQ2d 557, at \*7 (TTAB 2022) (pleaded registrations demonstrated entitlement to bring a statutory cause of action for likelihood of confusion); *New Era Cap Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at \*6 (TTAB 2020) (same).

## **V. Priority**

### **A. Priority Based on the Pleadings Registration**

Because Opposer has made its pleaded registration of record and Applicant has not counterclaimed to cancel it, priority is not an issue as to Opposer's registered standard-character mark IMPULSE for the registered goods. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Nkanginieme v. Appleton*, 2023 USPQ2d 277, at \*4 (TTAB 2023) ("Opposer's registration removed priority as an issue."); *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*19 ("In a likelihood of confusion proceeding where the opposer relies on registrations, the applicant can claim priority only if it files a counterclaim or separately petitions to cancel the opposer's registrations[.]").

### **B. Priority Based on Alleged Common Law Rights**

"A claim under Section 2(d) of the Trademark Act may be based on ownership of prior common law rights, but because unregistered marks are not entitled to the presumptions established by statute, *see* Trademark Act § 7(b)-(c), it is Opposer's burden to demonstrate prior common law rights." *Syngenta Crop Prot.*, 90 USPQ2d at 1119.

Mr. Krents, Executive Vice President of the Impulse record label, testified that:

(1) “Impulse was launched in the spring of 1961 as a separate jazz division of Opposer’s predecessor-in-interest ABC-Paramount Records, Inc.”;

(2) “[f]rom the outset, Impulse has used the IMPLUSE mark on the records it produces and manufactures”;

(3) “[t]hese record often feature Impulse’s iconic logo for the IMPULSE Mark”:



(4) the IMPULSE “label gained an immediate audience” with the release in 1961 of Ray Charles’ album *Genius + Soul = Jazz* followed by the 1961 release of John Coltrane’s album *Africa/Brass*;

(5) the “goods and services offered by Impulse under the IMPULSE Mark include the production and sale of recorded music”; and

(6) “Impulse continues to sign and advertise new artists, release new albums, [and] reissue classic albums[.]”<sup>33</sup>

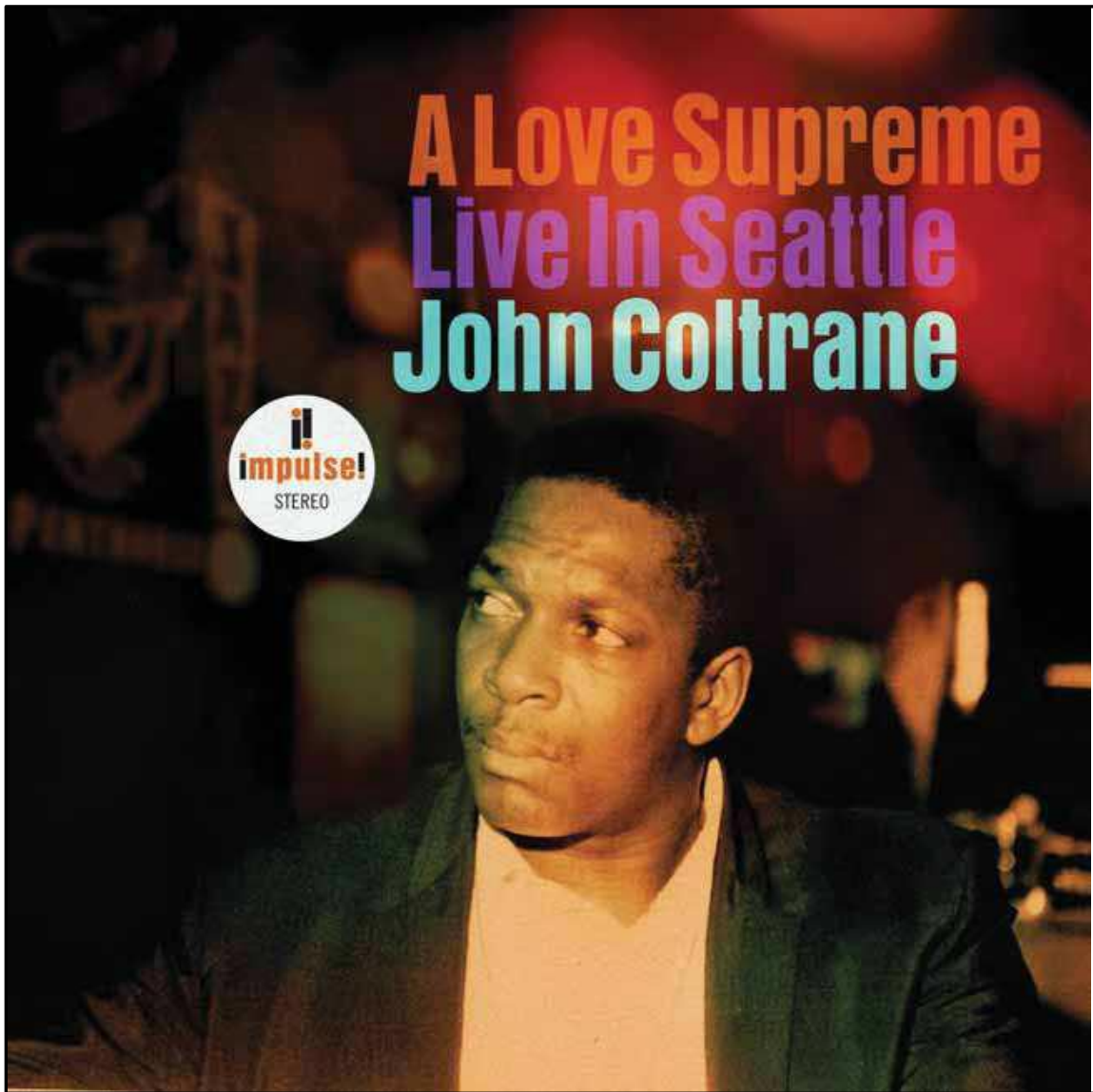
This testimony is supported by documentary evidence, representative examples of which are shown below:<sup>34</sup>

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<sup>33</sup> Krents Declaration, 19 TTABVUE 3-5, 9, ¶¶ 3-8, 12, 30.

<sup>34</sup> *Id.* at 12-178.

- Album cover:



- Images of the *John Coltrane 1963: New Directions* special edition box set nominated for a Grammy in 2020:<sup>35</sup>





- Screenshot from the IMPULSE website, operating for “over 20 years,” “where consumers can browse the artists and records offered under the IMPULSE mark, stream and purchase music and other merchandise, and learn about the history of Impulse and its famous artists”<sup>36</sup>

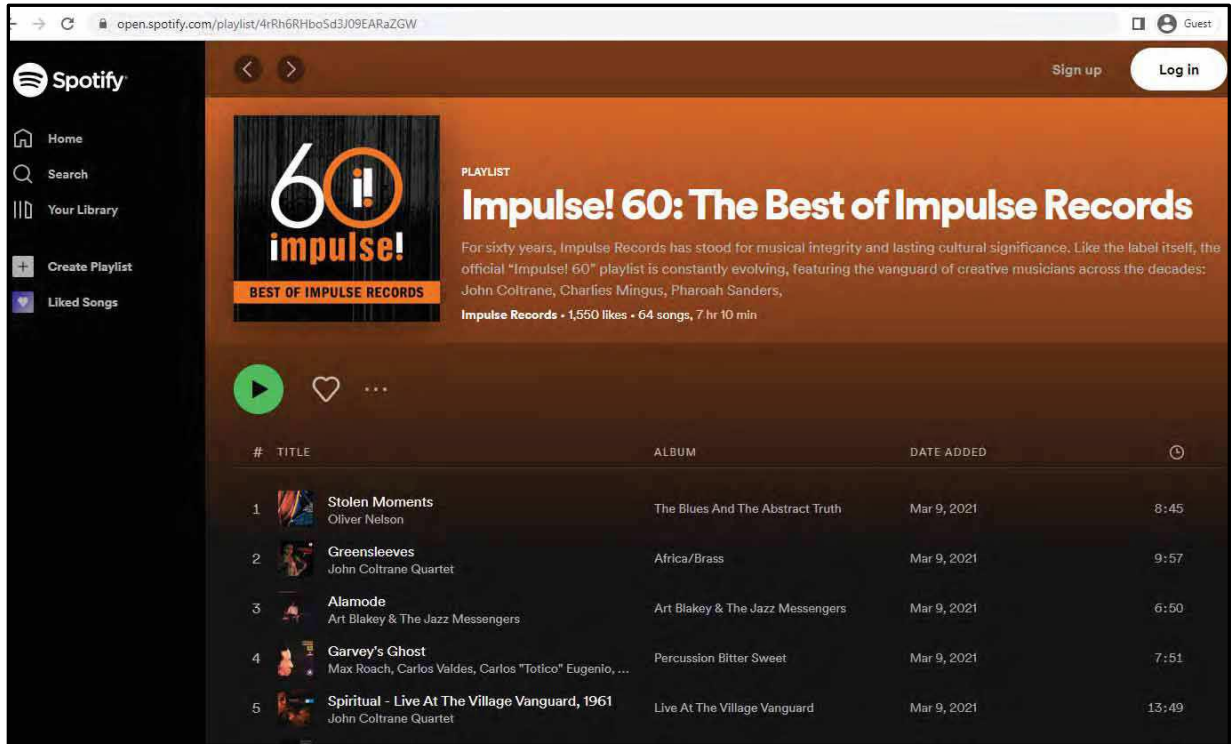


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<sup>35</sup> *Id.* at 6, 34, ¶ 14.

<sup>36</sup> *Id.* at 19 TTABVUE 7, ¶ 18.

- Screenshot of Opposer’s IMPULSE 60<sup>th</sup> anniversary streaming playlists offered through Spotify



Based on the evidence of record, we find that Opposer has proven prior common law rights through its predecessor-in-interest ABC-Paramount Records since 1961 in


the mark , for jazz music recordings and record label services, namely, producing, manufacturing, distributing and promoting jazz music. See *Executive Coach Builders, Inc. v. SPB Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (“The oral testimony even of a single witness may be adequate to establish priority” and “is strengthened by corroborative documentary evidence.”); see also *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232 (CCPA 1945); *Nationstar Mortg.*

*LLC v. Ahmad*, 112 USPQ2d 1361, 1372 (TTAB 2014); *GAF Corp. v. Amatul Analytical Servs., Inc.*, 192 USPQ 576, 577, 583 (TTAB 1976).

Applicant filed the involved application on June 12, 2020 based on an allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b). For priority purposes, Applicant “may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority.” *Syngenta Crop Prot.*, 90 USPQ2d at 1119.

Applicant’s manager and co-owner Collin Hockenbury testified that he “created [Applicant] on March 5, 2019” and that he “also created” the involved mark IMPULSE MUSIC COMPANY for use in connection with the identified services.<sup>37</sup> It is not clear from Mr. Hockenbury’s testimony if Applicant commenced use of its mark on March 5, 2019 but even if it did, the date would be after Opposer’s proven common law use

of the mark  since 1961.

We find that Opposer has proven prior common law rights in the mark  for jazz music recordings and record label services, namely, producing, manufacturing, distributing and promoting jazz music.

## VI. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont*

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<sup>37</sup> Hockenbury Declaration, 25 TTABVUE 3, ¶ 3.

*de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See, e.g., In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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 [or services] and differences in the marks.”). These factors, and others, are discussed below.

We focus our likelihood of confusion analysis on Opposer's common law mark




because it is this “iconic logo”<sup>38</sup> that is the focus of Opposer's allegations of fame and commercial strength. *See, e.g. Sock It to Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at \*6 (TTAB 2020).

#### A. Strength of Opposer's Common Law Mark

We start by assessing the strength of Opposer's common law mark



. “In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.” *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*21.

Opposer argues under the fifth *DuPont* factor that its mark  is strong for musical sound recordings as well as manufacturing, producing and distributing musical sound recordings. Applicant acknowledges that “Opposer's [IMPULSE] label was once a well-known label,” but argues that “the advent of the internet, online

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<sup>38</sup> Krents Declaration, 19 TTABVUE 3, ¶ 6; *see also* n.40 below.


streaming services and strong competition from competing labels have greatly diminished any notoriety Opposer's label may have had.”<sup>39</sup> Applicant further argues under the sixth *DuPont* factor that Opposer's common law mark is weak such that its mark should be allowed to coexist.<sup>40</sup> See *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*17 (citing *DuPont*, 177 USPQ at 567) (“The fifth *DuPont* factor enables Opposer to prove that its pleaded mark[] [is] entitled to an expanded scope of protection by adducing evidence of ‘[t]he fame of the prior mark (sales, advertising, length of use),’ while the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of ‘[t]he number and nature of similar marks in use on similar goods [or services].’”). We consider the parties' arguments and evidence in turn below.

#### 1. The Fifth *DuPont* Factor

In the context of a likelihood of confusion analysis, the commercial strength or fame of a mark is not a binary factor. Rather, it “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689,

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<sup>39</sup> Applicant's Brief, 38 TTABVUE 5.

<sup>40</sup> In discussing the fifth *DuPont* factor, Opposer generally refers to its mark as IMPULSE, without an exclamation point and not in a particular display, but the documentary evidence of record shows that Opposer primarily uses its stylized common law mark, with an exclamation point, as shown here: . We therefore consider whether Opposer has demonstrated the fame or renown of this common law mark for jazz music recordings and the production, manufacture, distribution, and promotion of jazz music recordings.


1694 (Fed. Cir. 2005)). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark falls on the high end of the fame spectrum to clearly prove it. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).


Commercial strength or fame “may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods [or services] sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods [or services] identified by the mark; and the general reputation of the goods [or services].” *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*31; *Weider Pubs., LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002). Fame or commercial strength for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imps.* 73 USPQ2d at 1694.

Opposer, through its predecessor in interest, ABC-Paramount Records, has been consistently using its common law mark  for more than 60 years in

connection with a jazz record label and jazz music recordings.<sup>41</sup> In 1961, Impulse “a separate jazz division of Opposer’s predecessor-in-interest ABC-Paramount Inc.” (“Impulse”) released Ray Charles’ album *Genius + Soul = Jazz*, which included a Top Ten hit on the pop charts and a No. 1. hit on the R&B countdown.<sup>42</sup> “[W]ithin a few months of its release” over 150,000 copies of the album were sold.<sup>43</sup>

Impulse then signed John Coltrane, “the Pulitzer Prize-winning musician whose works are profoundly important to jazz and American culture.”<sup>44</sup> John Coltrane’s

albums displaying the common law mark  have received numerous accolades, and today, the “Impulse label sells Coltrane products under approximately 100 different Unique Product Codes.”<sup>45</sup> Other artists who have released albums with

 records include Duke Ellington (with John Coltrane), Quincy Jones and Diana Krall.<sup>46</sup> “[F]our records released under the IMPULSE mark have been awarded platinum certifications by the Recording Industry Association of America, and two others have been awarded gold certifications. The most recent of these was John Coltrane’s *A Love Supreme*, which was certified as platinum on November 10,

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<sup>41</sup> Krents Declaration, 19 TTABVUE 2-3, 5, ¶¶ 1, 4-5, 12.

<sup>42</sup> *Id.* at 3, ¶ 7.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at 4, ¶ 8.

<sup>45</sup> *Id.*


<sup>46</sup> *Id.* at 4-5, ¶ 9.



2021.”<sup>47</sup> Mr. Krents attached to his declaration representative examples of a number of albums by Coltrane and other artists prominently bearing the common law mark



Under Opposer’s ownership, Impulse continues to sign under the common law

mark  new artists and reissue “classic albums,” including a 2020 reissue of *John Coltrane 1963: New Directions*, which was nominated for a Grammy.<sup>49</sup>

Another artist signed under this common law record label mark, Brandee Younger, received a Grammy nomination in 2021 for best instrumental composition.<sup>50</sup> Opposer currently “offers nearly 450 musical sound recordings under the IMPULSE Mark,” including numerous sound recordings released since 2020, and “dozens of albums released under the IMPULSE mark can be listened through streaming services” such as Spotify, Tidal and Apple Music as shown in the representative screenshot below.<sup>51</sup>

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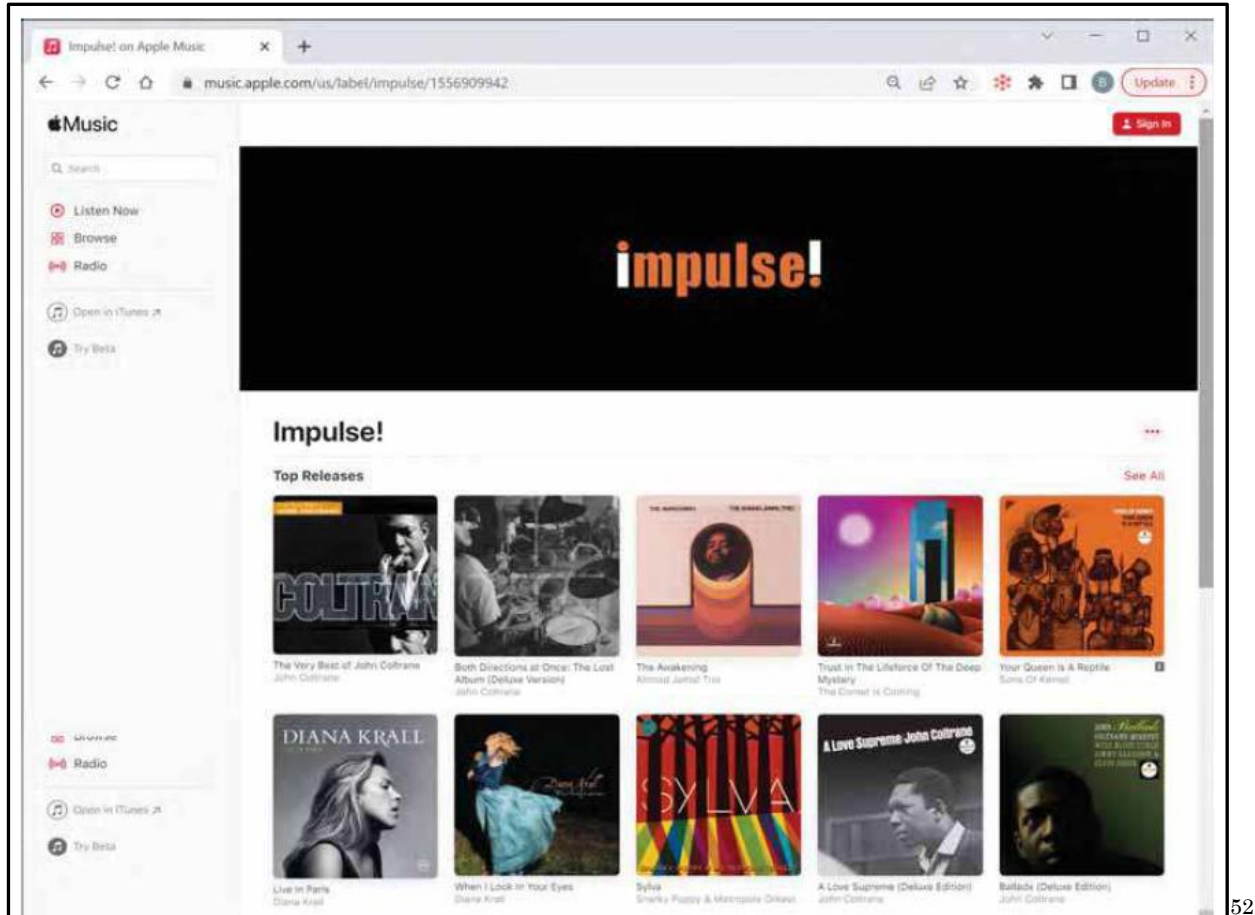
<sup>47</sup> *Id.* at 5, ¶ 11; *see also id.* at 13 (album cover).

<sup>48</sup> *Id.* at 4-5, 12-34, ¶¶ 8, 9 and exhibits thereto.

<sup>49</sup> *Id.* at 5-6, ¶¶ 12-14; *see also id.* at 34 (albums from the reissue bearing the common law mark).

<sup>50</sup> *Id.* at 6, ¶ 13; *see also id.* at 88 (webpage bearing common law mark identifying “New Releases,” including Brandee Younger’s album *Somewhere Different*).

<sup>51</sup> *Id.* at 6, 68-80, ¶¶ 15, 16.



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“Impulse’s music is also available on Sonos Radio, where Impulse and jazz-fan and historian” Kareem Abdul-Jabbar “started airing a collaboration radio station.”<sup>53</sup> In 2021, this station was promoted as follows:<sup>54</sup>

Impulse! Records Radio hosted by Kareem Abdul-Jabbar commemorates the 60th anniversary of the legendary Jazz label that’s home to all-time greats including John and Alice Coltrane, Ray Charles, Quincy Jones and more. As host of the station, basketball hall of famer, activist and jazz historian Abdul-Jabbar will revisit the role of jazz

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<sup>52</sup> *Id.* at 82.

<sup>53</sup> *Id.* at 7, ¶ 17.

<sup>54</sup> 23 TTABVUE 12.

music in his upbringing and its deep roots in African American history and culture.

Mr. Krents testified that “Impulse has sold millions of albums by dozens of artists under the IMPULSE Mark since 1961 in the United States.”<sup>55</sup> The revenue “Impulse has generated” since 2016 under this mark (filed under seal) is impressive.<sup>56</sup>

In 2011, Opposer promoted its 50<sup>th</sup> anniversary of the IMPULSE record label with two days of concerts, and in 2021, celebrated its 60<sup>th</sup> anniversary “with a yearlong campaign that featured limited-edition merchandise for sale as well as the launch of four streaming playlists.”<sup>57</sup> Opposer’s 60<sup>th</sup> anniversary merchandise included “the Impulse 60! Collector’s Zine ..., which included content like essays celebrating Impulse and its history as well as previously unpublished interviews with Impulse artists Alice Coltrane and Roy Haynes. ... Impulse also released web videos celebrating Impulse’s sixty years and the renowned jazz musicians that produced albums under the label over that time.”<sup>58</sup> The videos remain available on the Impulse record label YouTube channel as shown in the screenshot below:<sup>59</sup>

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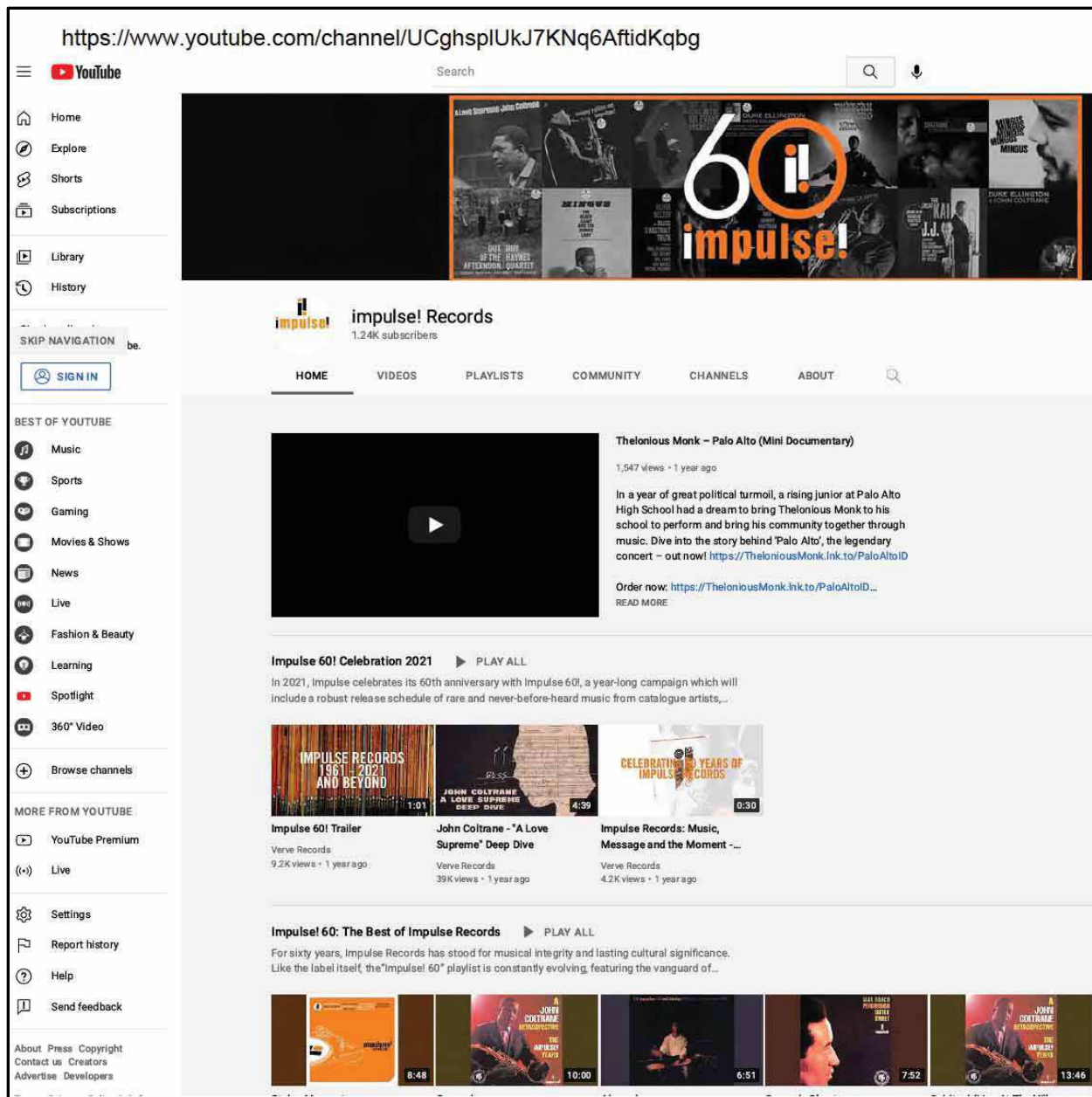
<sup>55</sup> Krents Declaration, 19 TTABVUE 8, ¶ 24.

<sup>56</sup> *Id.*; 17 TTABVUE 8, ¶ 24 (confidential).

<sup>57</sup> 19 TTABVUE 7-8, ¶¶ 21-22.

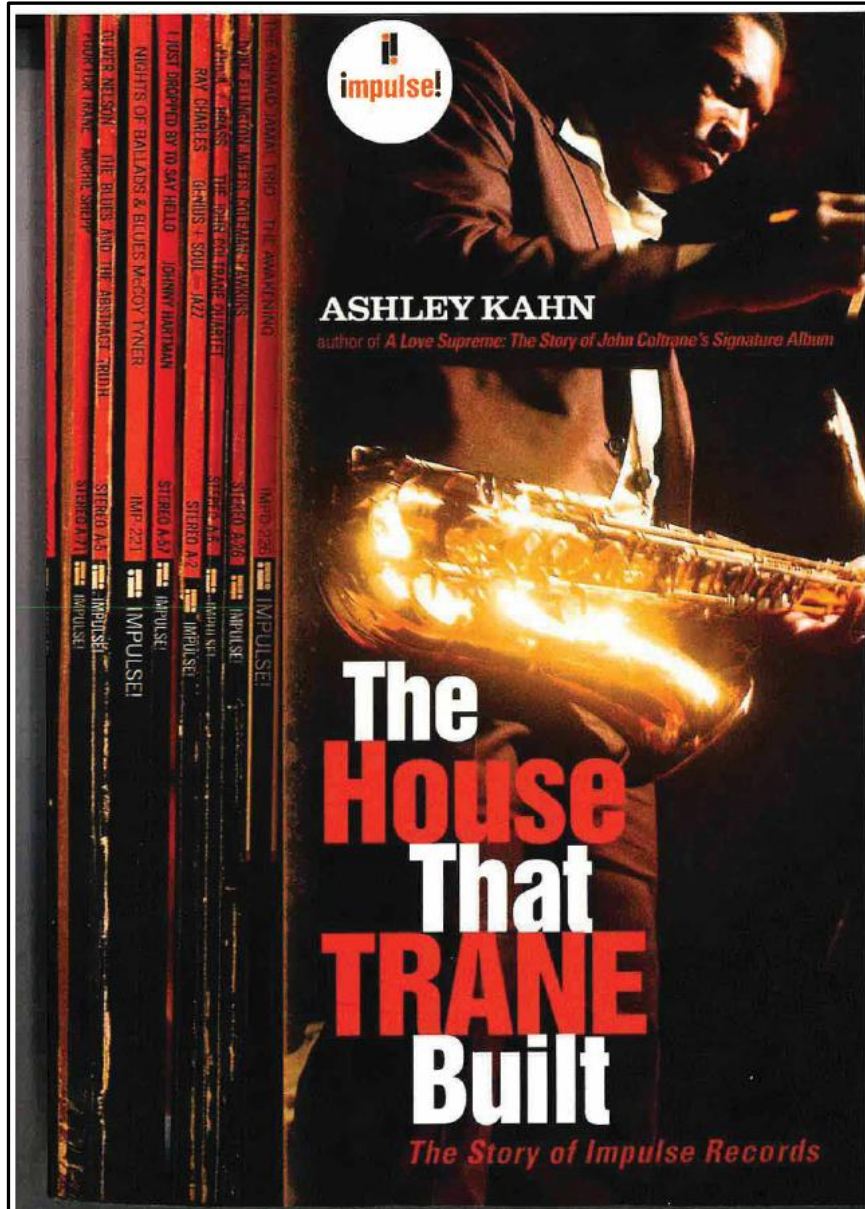
<sup>58</sup> *Id.* at 8, ¶ 22.

<sup>59</sup> *Id.* at 8, 116, ¶ 22.



The record further reflects that Opposer’s IMPULSE record label has received steady media coverage, including in national publications. Opposer introduced more than twenty articles dated between 2006 to 2021 discussing Impulse branded records and jazz music recordings, including articles from THE WALLSTREET JOURNAL and BILLBOARD magazine. In particular, the 50<sup>th</sup> and 60<sup>th</sup> anniversaries of Impulse records received widespread coverage in the press, including in articles in THE NEW

YORK TIMES and THE WASHINGTON POST.<sup>60</sup> And in 2007, Ashley Kahn published a book titled THE HOUSE THAT TRANE BUILT THE STORY OF IMPULSE RECORDS about “Impulse and its history”<sup>61</sup> as shown below:





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<sup>60</sup> *Id.* at 8, ¶ 23.

<sup>61</sup> *Id.*

<sup>62</sup> 23 TTABVUE 48.

The back of this book cover lists reviews by *Rolling Stone* magazine, *Entertainment Weekly.com* and *Publishers Weekly*, among others.<sup>63</sup>

We find that the testimony of Mr. Krents and the documentary evidence of record establish that  is a historically significant record label and that Opposer's "iconic logo"  for jazz music recordings and record label services, namely, producing, manufacturing, distributing and promoting jazz music recordings is well known among jazz enthusiasts.

Applicant argues that while Opposer's albums have "enjoyed some success ... it is not clear that the success of these albums was attributable to the label. The success appears to be attributable to the artist."<sup>64</sup> This argument, however, is undercut by the documentary evidence of record, examples of which are shown above, showing that Opposer's common law mark  is widely promoted in connection with its albums and jazz music recordings.

Applicant further criticizes Opposer's evidence of recent sales as "anemic" when "compared to the overall [music industry] market size of multi-billion dollars."<sup>65</sup> In addition, "[e]ven if Opposer' mark [is] considered in the context of the subset of jazz

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<sup>63</sup> *Id.* at 67.

<sup>64</sup> Applicant's Brief, 38 TTABVUE 25.

<sup>65</sup> *Id.* at 27.

music, Opposer's reported sales do not support a claim that Opposer's mark occupies a significant portion of the jazz recorded music industry."<sup>66</sup>

In assessing whether a mark is commercially strong, we must consider "the class of customers and potential customers of" Opposer's goods and services, "not the general public." *Palm Bay Imps.*, 73 USPQ2d at 1695. Because Opposer has demonstrated common law rights in jazz recordings and the services of a jazz record label, we have correctly considered whether Opposer has established commercial

strength in its common law mark  among jazz enthusiasts as opposed to consumers of music generally. Opposer has not introduced evidence of the size of the U.S. jazz market, but we find that the sales of Opposer's musical recordings in

connection with the common law mark  in the niche jazz market are impressive on their face.<sup>67</sup>




We also are not persuaded by Applicant's argument that "Opposer's failure to quantify the amounts spent on marketing and advertising over any period requires a determination that Opposer's mark is not famous."<sup>68</sup> We acknowledge that Opposer did not introduce evidence of advertising expenditures, but the record includes


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<sup>66</sup> *Id.*

<sup>67</sup> We are not bound by the Southern District of New York's decision in *Schutte Bagclosures Inc. v. Kwik Lok Corp.*, 48 F. Supp. 3d 675, 702 (S.D.N.Y. 2014) that Applicant asserts "requires ... hundreds of millions of dollars in sale for a finding fame." 38 TTABVUE 24. Further, as discussed, fame for likelihood of confusion purposes is not an all or nothing proposition. *Coach Servs.*, 101 USPQ2d at 1721.

<sup>68</sup> Applicant's Brief, 38 TTABVUE 24-25.

evidence that Opposer actively promoted its 50<sup>th</sup> and 60<sup>th</sup> anniversaries in 2011 and 2021, respectively, in connection with the common law mark  and that these anniversaries were covered in the press, including in national publications. The record also includes numerous articles about Impulse since 2006, a 2007 book about  records, and a 2020 Grammy nomination for the box set *John Coltrane 1963: New Directions*, prominently bearing Opposer's common law mark .

Last, we find that Applicant has not proven that “the advent of the internet, online streaming services and strong competition from competing labels have greatly diminished any notoriety Opposer’s label may have had.”<sup>69</sup> The evidence shows that Opposer prominently displays its common law mark  in connection with the streaming and sale on the Internet of its jazz recordings.

Considering the evidence as a whole, we find that Opposer has demonstrated under the fifth *DuPont* factor that its common law mark  falls on the higher end of the spectrum of fame or commercial strength for jazz music recordings

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<sup>69</sup> *Id.* at 5.



and the production, manufacture, distribution and promotion of jazz music recordings. This factor weighs in favor of finding a likelihood of confusion.

## 2. Sixth *DuPont* Factor


“There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at \*4 (Fed. Cir. 2023). Evidence that the public is confronted with significant use by others of similar marks for similar goods and services tends to indicate a lack of commercial strength. *DuPont*, 177 USPQ at 567. “Conceptual strength is a measure of a mark’s distinctiveness,” and “is often classified in categories of generally increasing distinctiveness,” namely: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *Spireon*, 2023 USPQ2d 737, at \*4. “Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

Turning first to commercial strength under the sixth *DuPont* factor, Applicant introduced printouts from the Internet showing third-party use of IMPULSE in the music field.<sup>70</sup> We have not considered those third-party uses that Applicant has not shown are related to the jazz music recordings and jazz music production,

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<sup>70</sup> In its brief, Applicant asserts that “there are over 200 pending and registered trademarks that use the term IMPULSE” and that “[t]he Board may take judicial notice of this fact[.]” 38 TTABVUE 14. The Board does not take judicial notice of third-party marks so we give Applicant’s assertion no further consideration. *See, e.g., In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 n.57 (TTAB 2011) (recognizing that “the Board’s well-established practice is to not take judicial notice of third-party registrations”).

manufacturing distributing and promotion services that Opposer offers under its

common law mark .<sup>71</sup> See, e.g., *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1684 (Fed. Cir. 2018) (Board erred in considering marks for unrelated goods); *Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). We also give little consideration to the printouts from the SoundCloud website listing 52 results for a search of the term “impulse.” Much of the text on these printouts is illegible and it is difficult to discern the nature of the references from the little legible information that is provided. For example, we cannot discern whether the word “impulse” is being used to identify the name of a song, album, band, radio station or something else altogether.

There are nine examples of third parties using IMPULSE and phonetic variations therefore as the name of, or part of the name of, a band or musical group.<sup>72</sup> Based on the record, these musical groups appear to perform in limited geographic areas; two

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<sup>71</sup> See, e.g., 26 TTABVUE 29, 41-44, 52-61 and 63-64 (marks identifying clubs and lounges, VR gaming company, dance and fitness studio, and online retail store featuring home goods).

We also have not considered the evidence of use of “Impulse Music of America” at 26 TTABVUE 48-50. The page promotes, among other events, a March 20, 2020 “John Coltrane Listening Party for the Impulse Release: John Coltrane '63 New Directions.” John Coltrane is an artist on Opposer’s Impulse record label. See Krents Declaration, 19 TTABVUE 4, 6 ¶¶ 8, 14 (“The *John Coltrane 1963: New Directions* box set put out under the IMPULSE Mark was nominated for a Grammy for Best Boxed or Limited Edition Package in 2020.”). Applicant has not demonstrated that this reference is to a third-party as opposed to Opposer. We further note that the other events listed on the page are dated May 3, 2014, August 9, 2013, and July 19, 2009 so it is not clear whether such use is current. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (webpages of third-party uses bearing dates two and three years old lessened the probative value of the evidence).

<sup>72</sup> 26 TTABVUE 21-22, 32-34, 84; 87; 27 TTABVUE 3-16, 38-40.

of the bands are located outside the United States.<sup>73</sup> On this record, we cannot conclude that there has been significant exposure to these uses among relevant U.S. consumers.<sup>74</sup> *Id.* at 1057-58 (criticizing evidence of third-party use because “Respondent did not show how long or how extensively these apparent third-party marks have been used. We have no sense of the degree of consumer exposure to these marks.”). In addition, none of the bands appear to perform jazz music. These same criticisms apply to the third-party use of IMPULSE NEW MUSIC FESTIVAL.<sup>75</sup>

The remaining third-party uses are as follows:

- IMPULSE for an IR Loader, a “guitar tool that will support your playing”; IR appears to stand for “Impulse Response” (27 TTABVUE 18-25) (“Prepare to Get Loaded ... on Impulse Responses!”; “IMPULSE IR LOADER will make the complexity of working with Impulse response files disappear.”);
- IMPULSE identifying a keyboard (26 TTABVUE 36-39).<sup>76</sup> This mark is subject to Reg. No. 4381930 for “musical instruments; electronic musical keyboards” in International Class 15 and “Midi controllers and structural parts for the aforesaid goods,” in International Class 9 (26 TTABVUE 16);

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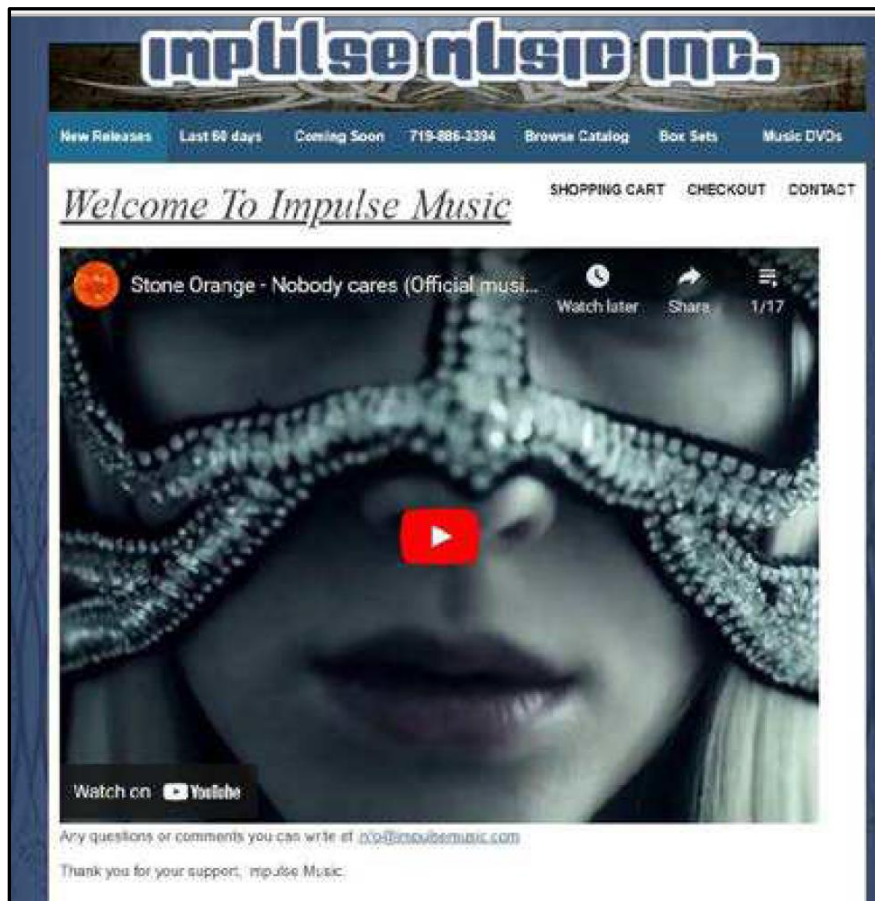
<sup>73</sup> We consider these uses because it is common for music to transcend international borders, although there is no evidence that these 2 international bands have followings in the United States.

<sup>74</sup> Further, the article about THE IMPULSE ALLIANCE DRUM CORP in Philadelphia is dated 2014, 27 TTABVUE 16, lessening its probative value. *Tao Licensing*, 125 USPQ2d at 1058 (evidence of third-party uses two and three years old less probative).

<sup>75</sup> 26 TTABVUE 26-27 (specifying that the entity is “committed to re-imagining what classical music training should look like in the 21<sup>st</sup> century”).

<sup>76</sup> In its brief, Opposer recognizes the evidence showing the “NOVATION-branded keyboard called the ‘Impulse Keyboard.’” 37 TTABVUE 42.

- IMPULSE – a mobile application music player offered by Appmetric on Modyolo.com (27 TTABVUE 33-36);<sup>77</sup>
- IMPULSE MUSIC CONSULTANTS – “Impulse can help you to promote you and your music”<sup>78</sup> (26 TTABVUE 24; 34 TTABVUE 5-6); and
- IMPULSE MUSIC INC. as shown in the screenshot below (27 TTABVUE 27).



<sup>77</sup> The record includes another third-party use of IMPULSE for a mobile application for playing music offered by Rahul Muthyam. The webpage, however, indicates that this mobile app is “Not maintained anymore[.]” 27 TTABVUE 29-31.

<sup>78</sup> We give some consideration to IMPULSE MUSIC CONSULTANTS located in the United Kingdom because this website is in English and there is no indication that the services of promoting musicians, including website development, is limited to consumers in the United Kingdom.

Applicant argues that this last third-party use is the “[m]ost damaging for Opposer’s claim that its mark is strong” because it shows “a record store known as IMPULSE MUSIC Inc., that sells albums and box sets through its brick-and-mortar store as well as online. According to the Colorado Secretary of State’s Office, Impulse Music Inc. was formed in 2009.”<sup>79</sup>

Applicant has not introduced evidence to support its assertion that this third party has a brick and mortar store in Colorado. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”). We further deny Applicant’s request that we take judicial notice from the Colorado Secretary of State’s Office that this entity was formed in Colorado in 2009. *Id.* at 18. Applicant did not attach to its brief a copy of the Colorado Secretary of State record to support its request for judicial notice. Nor did Applicant cite case law to support that this is a proper subject for judicial notice. In any event, even if this entity was formed in 2009, this does not establish that it has actually been using IMPULSE MUSIC INC. for the retail sale of music-related products since that time. Applicant has failed to prove the extent and length of use of this third-party mark.

On balance, we find that the nature and quality of the third-party uses do not support that there has been widespread third-party use of marks narrowing the commercial strength of Opposer’s common law mark for Opposer’s specific jazz-related goods and services under the sixth *DuPont* factor.

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<sup>79</sup> Applicant’s Brief, 38 TTABVUE 17-18.

As to conceptual weakness, the third-party uses above indicate that IMPULSE may have some suggestive significance in the music field generally.<sup>80</sup> This conclusion is supported by other evidence of record demonstrating that the phrase “impulse response” has a meaning in the music field. Soundwoofer, an “Impulse response library,” describes an “impulse response” as follows:<sup>81</sup>

An Impulse response is the changing of one signal using another signal, it is how a signal ‘responds’ to being sent through another one. We at Soundwoofer specialize in a specific type of signal, acoustic signals. So what we do is; change one sound (your sound), with another sound (the sound of expensive recording equipment). ... Our product is basically a ‘snapshot’ of the sound from a speaker cabinet, a microphone, and a studio (or any location with interesting acoustics), at the time of the recording. We can create a ‘mold’ of the acoustic signatures from these components. It means that all you need is the input signal (you playing the guitar) and we will provide the sound of a high end studio, top-notch speaker cabinet and expensive microphones. The only thing you need is your guitar, your computer, and a digital audio workstation.

In short, an “impulse response” is “the ‘spirit’” of amplifier speakers “in a digital format.”<sup>82</sup> Mr. Hockenbury, Applicant’s co-owner and manager testified that he chose


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<sup>80</sup> Applicant also introduced 5 third-party registrations for IMPULSE and IMPULSE-formative marks. The only pertinent registration, Reg. No. 4381930, is for the mark IMPULSE that the record demonstrates is in use for a keyboard, as discussed above. One of the registrations has since been cancelled so we give it no consideration. 33 TTABVUE 5-7 (Reg. No. 5289535 for IMPULSE STUDIOS). *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*26 (disregarding cancelled third-party registrations; “A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b)”). The other 3 registrations are for entertainment-related services that Applicant has not shown to be related to Opposer’s jazz music recordings and jazz music production, manufacturing, distribution and promotion services (Reg. No. 5949884 for IMPULSE PICTURES, Reg. No. 5648512 for GEEK IMPULSE and Reg. No. 3178525 for COMMITTED IMPULSE). 26 TTABVUE 7, 13, 19.


<sup>81</sup> 26 TTABVUE 79-80.

<sup>82</sup> *Id.* at 81.

the mark IMPULSE MUSIC COMPANY “because of its meaning in the music field” referring to an “impulse response.”<sup>83</sup>

While the record supports that Opposer’s common law mark  has some suggestive significance, Applicant has not shown that the mark is “highly suggestive” and entitled to a narrow scope of protection.

### 3. Summary Regarding the Strength of Opposer’s Mark

In sum, Opposer has demonstrated under the fifth *DuPont* factor that its common law mark  for jazz music recordings and the production, manufacture, distribution and promotion of jazz music recordings falls on the higher end of the spectrum of fame or commercial strength entitling it to a greater than normal scope of protection. Applicant has not shown under the sixth *DuPont* factor that this scope of protection has been contracted by widespread pertinent third-party use or that Opposer’s common law mark is conceptually weak. The sixth *DuPont* factor is neutral.

### **B. Similarity or Dissimilarity of the Marks**

Under the first *DuPont* factor, we consider the “similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567; *see also Stone Lion Capital Partners, L.P. v. Lion Capital LLC*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). The

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<sup>83</sup> Hockenbury Declaration, 25 TTABVUE 3, ¶ 4.

proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks and citation omitted)). Further, the marks “must be considered ... in light of the fallibility of memory ....” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *see also In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).






We compare Opposer's common law mark  with Applicant's standard character mark IMPULSE MUSIC COMPANY. The words "Music Company" in Applicant's mark are merely descriptive or generic of Applicant's music-related services and have been appropriately disclaimed. It is well-settled that disclaimed merely descriptive or generic matter may have less significance in likelihood of confusion determinations because consumers tend to focus on the more distinctive portions of marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) ("[N]on-source identifying nature of the words and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis.") (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34); *Palm Bay Imps.*, 73 USPQ2d at 1692 ("That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...."); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'"); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2011) (disclaimed matter is often "less significant in creating the mark's commercial impression").

The word IMPULSE in Applicant's mark is the only term with source identifying significance. For this reason, and because it is the first word in Applicant's mark, we find that consumers of Applicant's services will focus on and remember the IMPULSE portion of Applicant's mark as the dominant element. *Palm Bay Imps.*, 73 USPQ2d

at 1692 (finding the same “first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance” of the other word in applicant’s mark); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Given the descriptive nature of the disclaimed word ‘Technologies,’ the Board correctly found that the word ‘Packard’ is the dominant and distinguishing element of PACKARD TECHNOLOGIES.”); *Code Consultants*, 60 USPQ2d at 1702 (descriptive matter that is disclaimed often “less significant in creating the mark’s commercial impression”); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered[.]”).

Because Applicant’s mark is in standard characters Applicant is not limited to the manner in which it displays its mark. *In re Aquitaine Wine, USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). Applicant could display its mark in a similar font to the literal element in Opposer’s common law mark <sup>84</sup> *Id.* at 1186. Applicant also could emphasize the IMPULSE portion of its mark, which it does with a variation of its mark, shown below,<sup>85</sup> further increasing the visual similarities between the marks.

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<sup>84</sup> Krents Declaration, 19 TTABVUE 3, ¶ 6.

<sup>85</sup> 27 TTABVUE 51, 53, 59, 63, 65, 69, 74.



In comparing the marks, we further take into account the propensity of consumers to shorten marks. *See, e.g., Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant’, it does indicate that people have called it by that name, omitting the word ‘Hamburgers’. Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant’, there likely would be confusion about which ‘Giant’ they were talking about.”); *In re Abcor Dev. Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (acknowledging that generally, “users of language have a universal habit of shortening full names from haste or laziness or just economy of words”); *Big M. Inc. v. United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks[.]”). Consumers may shorten Applicant’s mark to IMPULSE when asking for or referring to its services.

The marks also have similar connotations and commercial impressions as the descriptive phrase “Music Company” merely reinforces the music-related nature of Applicant’s services. *See e.g., Detroit Athletic*, 128 USPQ2d at 1050 (finding the descriptive and disclaimed portions of applicant’s mark “unlikely to change the overall commercial impression engendered by the marks.”) (citing *Dixie Rests.*, 41

USPQ2d at 1533-34). The absence of an exclamation point after the word IMPULSE does not result in any meaningful difference in commercial impression or connotation. *See In re Burlington Indus., Inc.*, 196 USPQ 718, 719 (TTAB 1977) (“[A]n exclamation point does not serve to identify the source of the goods”); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 807.14(c) (July 2022) (“Punctuation, such as quotation marks, hyphens, periods, commas, and exclamation marks, generally does not significantly alter the commercial impression of the mark.”).

For all of these reasons, when we consider Opposer’s common law mark




and Applicant’s standard character mark IMPULSE MUSIC COMPANY in their entirety, we find them to be highly similar in overall appearance, sound, connotation and commercial impression. The first *DuPont* factor weighs in favor of a likelihood of confusion.

### **C. Similarity or Dissimilarity of the Goods and Services, Trade Channels and Classes of Consumers**

The second *DuPont* factor considers “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration” and the third *DuPont* factor considers “the similarity and dissimilarity of established, likely to continue to trade channels.” *Detroit Athletic*, 128 USPQ2d at 1051-52 (quoting *DuPont*, 177 USPQ at 567); *Sabhnani*, 2021 USPQ2d 1241, at \*19. We must base our comparisons under the second and third *DuPont* factors on the identifications in Applicant’s application and the actual goods and services for which Opposer has



shown priority in its common law mark . See *Stone Lion*, 110 USPQ2d at 1162; *Dixie Rests.*, 41 USPQ2d at 1534; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Bongrain Int'l Corp. v. Delice de Fr., Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987) (actual market conditions govern analysis of common law rights).

The goods and services need not be identical or directly competitive for there to be a likelihood of confusion,<sup>86</sup> but the evidence must establish that the goods and services are related in some manner, or the conditions surrounding their marketing are such, that they would be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services emanate from a common source. *Coach Servs.*, 101 USPQ2d at 1722; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).


The opposed application involves two separate classes of goods services. “Because each class in Applicant’s multi-class application is, in effect, a separate application, we consider each class separately, and determine whether [Opposer] has shown a

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<sup>86</sup> For this reason, we find unpersuasive Applicant’s arguments that “Opposer’s goods and Applicant’s services do not overlap” and “are not directly competitive” (38 TTABVUE 11, 18); that it “does not sell musical recordings” (*id.* at 10, 19); and that “Opposer has not provided any evidence that it operates a brick-and-mortar store, that it sells musical instruments of any kind, or that it provides any musical lessons of any type” (*id.* at 19). Similarly unpersuasive is Applicant’s argument that “no consumer seeking [to buy] a jazz cd will mistakenly purchase one of Applicant’s instruments thinking it is one of Opposer’s products.” *Id.* at 29. The issue is not whether consumers would confuse the goods, but whether there is a likelihood of confusion as to source. See, e.g., *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at \*5 (TTAB 2020).



likelihood of confusion with respect to each.” *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015). It is sufficient for a finding of likelihood of confusion if relatedness is established for any goods or services encompassed in the identification in a particular class in an application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Double Coin*, 2019 USPQ2d 377409, at \*6; *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015).

### 1. Applicant’s Class 41 Services

For ease of reference, Applicant’ Class 41 services are “entertainment services in the nature of live musical performances; instruction in the field of music; music production services” in International Class 41. As discussed above, Opposer has demonstrated common law priority in the mark  for jazz musical sound recordings (e.g., records, albums) and record label services, namely, producing, manufacturing, distributing and promoting jazz music recordings. Applicant’s broadly worded “music production services” encompasses all types of music production, including Opposer’s service of producing jazz music. *See, e.g., In re Country Oven*, 2019 USPQ2d 443903, at \*5 (TTAB 2019) (“It is well established that the Board may not read limitations into an unrestricted registration or application.”); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (where an identification of goods is unrestricted, it encompasses all goods of the nature and type described therein).

Applicant’s attempt to distinguish the services on the ground that it “is not a record label” and that it “does not manufacture, distribute, or promote recordings of musicians nor does it have any musicians affiliated with it”<sup>87</sup> is not persuasive. The involved application specifically covers “music production services” without limitation and this includes the type of jazz music production services Opposer provides.

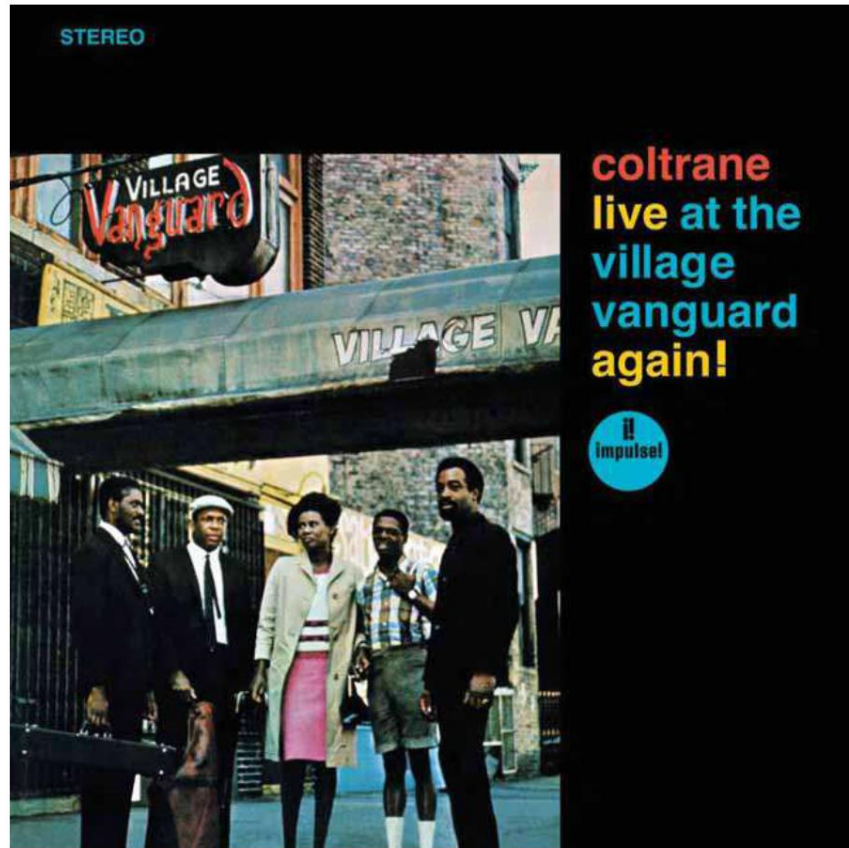
We further note that Opposer’s jazz musical recordings are inherently related to: (1) Applicant’s “music production services” as “music production services” may yield jazz musical recordings; and (2) Applicant’s “entertainment services in the nature of live musical performances” as shown by the fact that some of the jazz albums Opposer

has produced under the  record label and that bear the common law mark  are recordings of live musical performances, e.g.:<sup>88</sup>

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<sup>87</sup> Applicant’s Brief, 38 TTABVUE 20.

<sup>88</sup> Krents Declaration, 19 TTABVUE 4, 13, 17, 21, ¶ 8 and Exhibit PX 1 thereto.



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To further demonstrate relatedness, Opposer introduced 6 third-party use-based registrations for musical sound recordings on the one hand and music production services on the other hand, without limitation on the genre of music.<sup>90</sup> The identifications of goods and services in the third-party registrations are broad enough to encompass jazz musical sound recordings and the production of jazz music and, thus, suggest that Applicant's music production services and Opposer's jazz music recordings may emanate from a common source. *See, e.g., Country Oven*, 2019 USPQ2d 443903, at \*5; *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing

<sup>89</sup> Krents Declaration, 19 TTABVUE 4, 17, ¶ 8; *see also supra*, p. 15.

<sup>90</sup> 21 TTABVUE 14-17, 34-40, 51-75 (SONY MUSIC & Design, TINSEL TOWN RECORDS, TOWN BOY ENTERTAINMENT, BIG LOUD, CONCORD and DEF JAM).



*In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001)); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (use-based registrations probative of relatedness); *Albert Trostel*, 29 USPQ2d at 1785-86 (same).

With respect to the third *DuPont* factor, there are no restrictions on trade channels and consumers in Applicant's identification of services. Applicant's "music production services," may be provided to jazz musicians in music studios, the same as Opposer's jazz music production services. Similarly, Applicant's "entertainment services in the nature of live musical performances" include live jazz performances that may be attended by the some of the same members of the general public that purchase Opposer' jazz music recordings, including those recordings featuring live jazz performances.

In sum, we find that Applicant's "music production services" and "entertainment services in the nature of live musical performances" are related to the jazz musical recordings and the production, manufacture, distribution and promotion of jazz musical recordings that Opposer provides under the common law mark



. The relevant consumers and trade channels also overlap and are otherwise related. The second and third *DuPont* factors therefore weigh in favor of finding a likelihood of confusion as to Applicant's Class 41 services.

## 2. Applicant's Class 35 Services

The involved application covers "on-line retail store services featuring musical instruments; retail store services featuring musical instruments" in International Class 35. In support of its argument that its goods and services are related to

Applicant's Class 35 services, Opposer cites to Mr. Krents' testimony that Opposer uses the mark IMPULSE for an online retail store services featuring "records, clothing and accessories."<sup>91</sup> Opposer, however, has not demonstrated that it provides retail and on-line retail store services "featuring musical instruments," which are the specific services for which Applicant seeks to register its mark in Class 35. Nor does the record demonstrate that Opposer uses the IMPULSE common law mark for the retail sale of musical instruments.

To support relatedness, Opposer has introduced third-party use-based registrations.<sup>92</sup> The two most pertinent registrations are below:

- WORSHIP TOGETHER (Reg. No. 4244871) for sound, downloadable sound, audiovisual and downloadable audiovisual recordings, featuring music religious themes; and "online retail store services featuring musical sound recordings, audiovisual recordings, songbooks, books and musical equipment" (21 TTABVUE 77-80); and
- CAPITOL (Reg. No. 4264800) for "musical sound recordings; audiovisual recordings featuring music; downloadable musical sound recordings" and "online retail store services in the field of music merchandise." (*id.* at 106-112).

The musical sound recordings covered by these registrations are broad enough to encompass jazz sound recordings of the type offered by Opposer and the identified

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<sup>91</sup> Krents Declaration, 19 TTABVUE 7, ¶ 19.

<sup>92</sup> Many of these registrations include deleted goods and services for which the registrations have been cancelled; we have not considered the deleted goods and services. *Made in Nature, v. Pharmavite*, 2022 USPQ2d 557, at \*26. We also do not consider the registrations that have issued under Sections 44 and 66 of the Trademark Act without evidence that these marks are in use in the United States. We take judicial notice that the owner of third-party Registration No. 4985724 for the mark BLUE NOTE has filed a declaration under Section 71 of the Trademark Act, that is pending, seeking deletion of International Class 15 covering musical instruments and that portion of International Class 35 covering "retail store services" featuring "musical instruments and their replacement parts." *Harry Winston v. Bruce Winston Gem*, 111 USPQ2d at 1422-23 (taking judicial notice of the status of registrations in the record).

online retail store services featuring “musical equipment” (Reg. No. 4244871) and “music merchandise” (Reg. No. 4264800) are broad enough to encompass Applicant’s online retail store services featuring musical instruments.

We also have considered the following third-party use-based registrations with identifications broad enough to encompass the online retail sale of jazz music recordings and musical instruments:

- LISTEN FOR PLEASURE (Reg. No. 6228302) for “distributorship services in the field of musical sound recordings and video recordings; computerized online retail store services in the field of music” (*id.* at 114-116); and
- ABBA (Reg. No. 4347054) for “computerized online retail store services in the field of music; on-line retail store services featuring downloadable pre-recorded music ... featuring music and music-related entertainment; retail store services available through computer communications and interactive television featuring CD’s and DVD’s” (*id.* at 138-47).

Opposer has not introduced any evidence that these marks for “online retail store services in the field of music” are actually used in connection with the online retail sale of musical instruments and jazz sound recordings, but Applicant did not introduce evidence to show that these third-party retail services do not feature both such goods. We find that the broadly-worded identifications in these two registrations tend to support a finding that Applicant’s online retail store services featuring musical instruments are related to Opposer’s common law services of distributing jazz musical recordings and Opposer’s jazz music recordings. *See, e.g., i.am.symbolic*, 123 USPQ2d at 1748 (“It is well established that the Board may not read limitations into an unrestricted registration or application.”). *Cf. Country Oven*, 2019 USPQ2d

443903, at \*5-6 (retail store services related to products sold through such retail stores, i.e. retail bakery shops related to bakery items, namely, bread buns).

Opposer also introduced evidence from five third-party retailers that sell both musical instruments and musical sound recordings: Target, Walmart, Best Buy, Guitar Center, and Musician’s Friend.<sup>93</sup> Target and Walmart are big box stores that sell a wide range of goods, not all of which are related. Accordingly, this evidence has minimal probative value. The printouts from the Best Buy website are slightly more probative because it is a big box store featuring electronic-related goods, including music-related goods, but again because it is the type of store that sells a wide range of goods, we do not find this example particularly compelling as to whether Applicant’s Class 35 services are related to Opposer’s common law jazz-music related goods and services.

The evidence showing that Guitar Center and Musician’s Friend sell both musical instruments and jazz music sound recordings is the most persuasive as the record supports that these retail stores feature music-related goods and services.<sup>94</sup> *Cf. Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1004 (“evidence, such as whether a single company sells the goods ... of both parties, if presented, is relevant to a relatedness analysis....”); *Davey Prods.*, 92 USPQ2d at 1203 (finding two third-party

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<sup>93</sup> 24 TTABVUE 141-85.

<sup>94</sup> *Id.* at 171, 176, 182, 184. The record shows that Musician’s Friend’s sells a vinyl record featuring Thelonious Monk, one of the artists who issued an album under Opposer’s Impulse record label. *Id.* at 182; *see also* Krents Declaration, 19 TTABVUE 4, ¶ 9.

webpages showing applicant's and registrant's goods "can be manufactured and sold by a single source" supported relatedness).

Applicant argues that its Class 35 services "are not within Opposer's zone of expansion."<sup>95</sup>

The advent of the [sic] internet music has decimated the brick-and-mortar stores that sell recorded music. Indie is the dominant trend in the music industry in general and the jazz music industry in particular. ... The expansion of the Indie movement has meant that record labels cannot afford to sell their products through brick and mortar stores whereas the services provided by Applicant require that they have a brick-and-mortar store to supply their services as their customers want to test the products Applicant sells. Further, Applicant must carry an inventory of musical instruments that can be rented out. Applicant therefore needs a location in which rental items can be stored. Opposer has no such need.

This argument is unpersuasive; the involved application covers not only retail store services, but **on-line** retail store services featuring musical instruments. The record shows that third parties sell musical instruments through online retail stores.<sup>96</sup> In addition, Opposer as well as third parties sell musical sound recordings through online retail stores.<sup>97</sup>

Where very similar marks are involved, as is the case here, the degree of similarity between the parties' goods and services necessary to support a finding of likely confusion declines. *See, e.g., In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009) ("the greater the degree of similarity between the applicant's mark and the

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<sup>95</sup> Applicant's Brief, 38 TTABVUE 20. The "natural zone of expansion" doctrine normally applies in the context of a priority dispute, which is not at issue here. *Orange Bang*, 116 USPQ2d at 1119.

<sup>96</sup> 24 TTABVUE 141-85.

<sup>97</sup> *Id.*; *see* 19 TTABVUE 85.

[plaintiff's] mark, the lesser the degree of similarity between the applicant's [services] and [plaintiff's] goods [and services] that is required to support a finding of likelihood of confusion"); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002) (same). When we take this into account, we find Applicant's Class 35 services are sufficiently related to Opposer's jazz music recordings and its distribution thereof such that the second *DuPont* factor weighs in favor of finding a likelihood of confusion.

Turning to the third *DuPont* factor, the record includes two examples of music-focused online retail stores selling jazz music recordings as well as musical instruments.<sup>98</sup> The consumers of Applicant's Class 35 services include the general public, including new music students, interested in renting or purchasing an instrument through a retail or online retail store. Such consumers presumably are interested in music generally and a portion of these consumers may be interested in and purchase jazz music recordings through retail and online retail stores. They may even do so as a way to learn how to play their musical instrument.<sup>99</sup>

We find that the second and third *DuPont* factors support finding confusion likely with respect to Applicant's services in Class 35.

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<sup>98</sup> 24 TTABVUE 171-85.

<sup>99</sup> Applicant summarily argues that "[t]he channels of trade for Opposer's musical recordings and Applicant's retail store services are ... unrelated." Applicant's Brief, 38 TTABVUE 21-22. Applicant has not pointed to any evidence in the record to support this argument and, in fact, the record supports the opposite.

### **D. Sophistication of the Relevant Purchasers**

Under the fourth *DuPont* factor we consider “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive goods and services may tend to have the opposite effect. *Palm Bay Imps.*, 73 USPQ2d at 1695.

#### **1. Applicant’s Class 41 Services**

Applicant’s “music production services” may be provided to both new and accomplished musicians, including jazz musicians. While established artists may have a certain degree of sophistication, there is no evidence that this is true of emerging artists who may be new to the music business. Opposer has signed both established jazz musicians as well as new artists to its record label.<sup>100</sup> The evidence does not support a finding that the new artists engaging Opposer’s jazz music production services would be likely to exercise a high degree of care.

Applicant’s “entertainment services in the nature of live musical performances” are the type of services offered to the general public through all types of venues for such services, include music arenas, clubs, hotel lounges, restaurants, coffee houses,

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<sup>100</sup> Krents Declaration, 19 TTABVUE 5, ¶¶ 10, 12.

private events such as weddings, and sidewalk performances.<sup>101</sup> The price for live musical performances may vary from costly for well-known, established artists, to free music provided by street performers.

Opposer's jazz music recordings also are purchased by the general public. Some of these consumers may be sophisticated jazz aficionados while others may be less knowledgeable consumers new to the genre. The record further shows that Opposer's jazz music recordings, including recordings of live music performances, may be sold for as low as \$17.99.<sup>102</sup>

Under the fourth *DuPont* factor, we must consider the least sophisticated potential purchasers. *Stone Lion*, 110 USPQ2d at 1163. The record does not support a finding that the least sophisticated potential consumers of Applicant's music production services and live musical performances and Opposer's goods and services are likely to exercise any particular degree of care in engaging in or consuming the services and goods.

We find the fourth *DuPont* factor neutral with respect to Applicant's Class 41 services.

## 2. Applicant's Class 35 Services

The musical instruments featured in Applicant's retail store and online retail store are the types of goods purchased by the general public, including those members

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<sup>101</sup> See, e.g., 27 TTABVUE 8-11 (a cover band promoting its performance at a private event); *id.* at 84 (a band promoting performances at resorts, theme parks, universities and hotels).

<sup>102</sup> 24 TTABVUE 182 (album by Thelonious Monk, one of the artists signed to Opposer's music label).



of the general public that are professional musicians, who might exercise care in purchasing an instrument, as well as new music students, who may be unlikely to exercise any particular degree of care in renting or purchasing a musical instrument through a retail or online retail store.

Applicant argues that the prices of the musical instruments it sells and rents through its retail store and online retail store services are generally high<sup>103</sup> but the record shows that a guitar, for example, may sell for as low as \$79.00.<sup>104</sup> As discussed above, the jazz music sound recordings that Opposer distributes are not particularly expensive and may be purchased by the general public without any particular degree of care.

We find the fourth *DuPont* factor neutral with respect to Applicant's Class 35 services.

### **E. Absence of Actual Confusion**

The seventh and eighth *DuPont* factors are “[t]he nature and extent of any actual confusion” and “[t]he length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. The eighth *DuPont* factor “requires us to look at actual market conditions.”<sup>105</sup> *In re Guild Mortgage Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020).

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<sup>103</sup> Applicant's Brief, 38 TTABVUE 22.

<sup>104</sup> 24 TTABVUE 184.

<sup>105</sup> Applicant argues that “another record store,” Impulse Music, Inc. “has used the mark IMPULSE in connection with the sale of recorded music since 2009 and yet there has been no apparent confusion between that store and Opposer.” 38 TTABVUE 30. Under the seventh and eighth *DuPont* factors, we consider whether there has been actual confusion and the opportunity for such confusion between the parties marks, not the plaintiff's mark and the

Mr. Hockenbury testified that “[o]f the thousands of customers that visit our store and use our services, no one has ever suggested that [Applicant is] affiliated with the Impulse Records, nor has anyone ever confused us with the record company.”<sup>106</sup> Generally, “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *Majestic Distilling*, 65 USPQ at 1205.

We find the record does not support that there has been a meaningful opportunity for consumer confusion to have occurred. Applicant has been using its mark for only a few years and has a single physical location in Santa Clarita, California. In 2022, Applicant received industry awards as “one of the Top 100 Dealers” and having the “Best Online Engagement’ making [Applicant] one of the Top 9 Music Stores/Dealers in the World”<sup>107</sup> but those awards are quite recent. Mr. Hockenbury’s testimony that Applicant has had “thousands of customers”<sup>108</sup> is vague and Applicant did not introduce any evidence of its revenue or sales.

In any event, it is well-settled that proof of actual confusion is not necessary to establish a likelihood of confusion. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1053; *Weiss Assocs. Inc. v. HRL Assocs. Inc.* 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990); *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*58; *Double Coin*, 2019 USPQ2d 377409, at \*8.

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mark of a third-party. We appropriately considered the third-party use of IMPULSE MUSIC, INC. under the sixth *DuPont* factor. *See supra* pp. 35-37.

<sup>106</sup> Hockenbury Declaration, 25 TTABVUE 4, ¶ 9.

<sup>107</sup> *Id.* at 3, ¶ 8.

<sup>108</sup> *Id.* at 4, ¶ 9.

The seventh and eighth *DuPont* factors are neutral in our analysis.

#### **F. Ninth, Tenth and Twelfth *DuPont* Factors**

Applicant addresses the ninth, tenth and twelfth *DuPont* factors briefly in its brief.

Under a heading for the ninth *DuPont* factor, the “variety of goods on which a mark is or is not used,” Applicant states: “As discussed above, Opposer’s goods and Applicants services do not overlap, nor are they related to one another.”<sup>109</sup> This argument is pertinent to the second *DuPont* factor but not the ninth *DuPont* factor, which considers the variety of goods on which the opposer’s mark is used (e.g. house mark, ‘family’ mark, product mark). *DuPont*, 177 USPQ at 567.

Use on a wide variety of goods weighs in favor of a likelihood of confusion. *See, e.g., In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB 2001). Opposer has not proven use of its mark with a wide variety of goods and services so we find the ninth *DuPont* factor neutral. *Cf. id.* at 1867.

Applicant argues under the tenth *DuPont* factor that “[s]ince there is no interface between the Applicant and the owner of a prior mark, this factor benefits Applicant.”<sup>110</sup> “Market interface” under the tenth *DuPont* factor concerns whether there has been any interaction between the parties indicating a lack of confusion between the marks such as a consent agreement, contractual provisions designed to preclude confusion, an assignment, or laches or estoppel. *Cunningham v. Laser Golf*,

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<sup>109</sup> Applicant’s Brief, 38 TTABVUE 31.

<sup>110</sup> *Id.* at 30.

55 USPQ2d at 1847 (citing *DuPont*, 177 USPQ at 567). There is no evidence in the record regarding any market interface between parties. Accordingly, this *DuPont* factor is neutral.

Applicant argues under the twelfth *DuPont* factor that the extent of potential confusion weighs in its favor because Applicant “has no ambitions to become a record label, nor does it intend to sell recorded music” and “Opposer has not expressed any intent [to] provide retail store services for the sale or rental of musical equipment or provide music lessons, or offer the service of musical instrument repair.”<sup>111</sup> In essence, Applicant reiterates its arguments under the second *DuPont* factor. As discussed above, we find the goods and services related and the marks highly similar so the potential for confusion is not de minimis. *DuPont*, 177 USPQ at 567 (twelve *DuPont* factor considers “the extent of potential confusion, i.e. whether de minimis or substantial”). The twelfth *DuPont* factor is neutral.

### **G. Thirteenth *DuPont* Factor**

Bad faith adoption or intent to confuse falls under the thirteenth *DuPont* factor “any other established fact probative of the effect of use.” *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008); *see also Quicktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at \*4 (Fed. Cir. 2021). Establishing bad faith requires a showing that the applicant intentionally sought to trade on the opposer’s good will or reputation. *See Big Blue Prods. Inc. v. Int’l Bus. Machs. Corp.*, 19 USPQ2d 1072, 1076 (TTAB 1991).

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<sup>111</sup> *Id.* at 31.

Opposer argues that “given the extensive sales, advertising, and publicity of the IMPULSE Mark and the widespread consumer and industry recognition of the IMPULSE Mark, it strains credulity to believe [Applicant’s] co-owners, who claim to have spent well over a decade in the music industry in various capacities were not aware of the Impulse label at the time they adopted the IMPULSE MUSIC COMPANY Mark in June 2020.”<sup>112</sup>

Mere knowledge of the existence of a prior user’s mark does not, by itself, constitute bad faith. *Quicktrip*, 2021 USPQ2d 35, at \*4; *Action Temporary Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989). There must be a showing that the applicant intentionally sought to trade on the opposer’s goodwill or reputation, *Big Blue Prods. Inc. v. Int’l Bu. Machs. Corp.*, 19 USPQ2d 1072, supported by evidence of an intent to confuse. *See Quicktrip*, 2021 USPQ2d 35, at \*4 (citing *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009)). No such evidence is of record here.

The thirteenth *DuPont* factor is therefore neutral.

#### **H. Weighing the *DuPont* Factors**

Opposer has demonstrated that its common law mark  for jazz musical recordings and for record label services, namely, producing, manufacturing, distributing and promoting jazz musical recordings, falls on the higher end of the fame or commercial strength spectrum, and therefore, the fifth *DuPont* factor weighs

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<sup>112</sup> Opposer’s Brief, 37 TTABVue 37 (internal citations omitted).

in favor of finding confusion likely. Applicant's evidence of third-party use and registration is insufficient to demonstrate commercial or conceptual weakness of Opposer's common law mark so the sixth *DuPont* factor is neutral.

We find that Applicant's mark in its entirety is very similar to Opposer's common law mark in appearance, sound, connotation and commercial impression and Applicant's services, trade channels and consumers are related to Opposer's common law goods and services, trade channels and consumers. Accordingly, the first, second and third *DuPont* factors also weigh in favor of finding a likelihood of confusion.

The fourth, seventh, eighth, ninth, tenth, twelfth and thirteenth *DuPont* factors are neutral. The record does not establish that consumers would exercise anything more than a normal degree of care in making a purchase. The absence of actual confusion is not probative in the circumstances here. Opposer has not demonstrated use of its mark on a wide range of goods and services. There is no evidence pertinent to market interface. Under the twelfth *DuPont* factor Applicant merely reiterates its arguments under the second *DuPont* factor. And the record does not support that Applicant adopted its mark in bad faith.

Weighing all of the *DuPont* factors, we find that Applicant's standard-character mark IMPULSE MUSIC COMPANY for "online retail store services featuring musical instruments; retail store services featuring musical instruments" in International Class 35 and "entertainment services in the nature of live musical performances; instruction in the field of music; music production services" in International Class 41 is likely to cause confusion with Opposer's common law mark



for jazz musical recordings and record label services, namely, producing, manufacturing, distributing and promoting jazz musical recordings.

**Decision:** The opposition is sustained as to both classes.