

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
August 16, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Carroll Hall Shelby Trust

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Serial No. 77355668  
Serial No. 77356004  
Serial No. 77356033

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Don B. Finkelstein, of Law Offices of Don Finkelstein, for  
Carroll Hall Shelby Trust.

William Breckenfeld, Trademark Examining Attorney, Law Office  
116 (Michael W. Baird, Managing Attorney).

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Before Holtzman, Bergsman, and Ritchie, Administrative Trademark  
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

The Carroll Hall Shelby Trust ("applicant") filed an  
application to register the mark shown below for "land vehicles,  
namely, automobiles and engines for land vehicles," in  
International Class 12, and with a description reading: "The  
mark consists of the outward appearance of a vehicle"<sup>1</sup>:

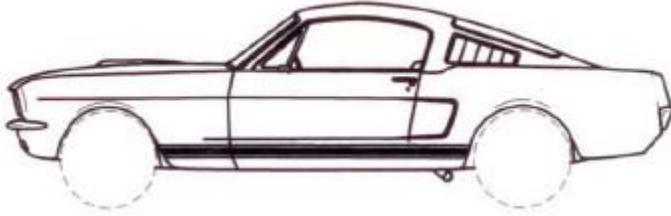
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<sup>1</sup> Serial No. 77355668, filed December 19, 2007, pursuant to Section  
1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging dates of first  
use and first use in commerce on January 1, 1965, and claiming  
acquired distinctiveness pursuant to Trademark Act Section 2(f).

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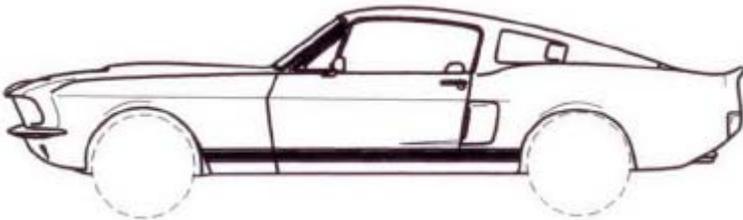
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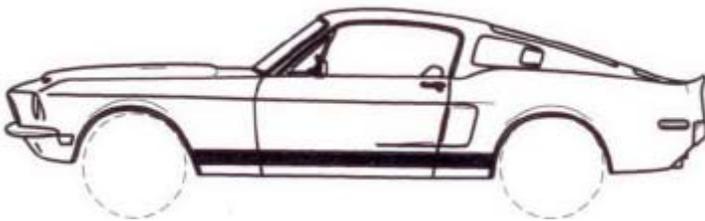
[The '668 application]

Applicant also filed on the same date, the mark shown below, for the same goods, with the same description<sup>2</sup>:



[The '004 application]

Applicant filed a third application on the same date for the mark shown below, for the same goods, with the same description<sup>3</sup>:



[The '033 application]

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<sup>2</sup> Serial No. 77356004, filed December 19, 2007, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging dates of first use and first use in commerce on September 1, 1966, and claiming acquired distinctiveness pursuant to Trademark Act Section 2(f).

<sup>3</sup> Serial No. 77356033, filed December 19, 2007, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging dates of first

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The Trademark Examining Attorney ultimately and finally refused registration of each of applicant's marks under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that each of applicant's three marks so resembles the two registered marks, as shown below, both for "motor vehicles, namely automobiles and structural parts therefor," in International Class 12, and both owned by the same registrant, that when used on or in connection with applicant's identified goods, they are likely to cause confusion or mistake or to deceive:



1.

[the '330 registration],<sup>4</sup> with a description stating: "The mark consists of the configuration of the roof line on an automotive vehicle. The stippling shown indicates placement of the mark and is not claimed as part of the mark."

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use and first use in commerce on September 1, 1967, and claiming acquired distinctiveness pursuant to Trademark Act Section 2(f).

<sup>4</sup> Registration No. 3052330, issued January 31, 2006, and claiming acquired distinctiveness pursuant to Trademark Act Section 2(f). Sections 8 and 15 affidavits accepted and acknowledged.

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2.

[the '331 registration],<sup>5</sup> with a description stating: "The mark consists of the configuration of a C-scoop on the side of an automotive vehicle. The stippling shown indicates placement of the mark and is not claimed as part of the mark."

Upon final refusals of registration, applicant filed appeals in each of the cases, requesting consolidation of the cases due to the similarity of the issues and facts. By order of the Board dated September 6, 2011, the request for consolidation was granted, and we consider the overridingly similar issues and facts of these three appeals together. Both applicant and the examining attorney filed briefs. For the reasons discussed herein, the Board affirms the refusals to register each of the applications.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a

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<sup>5</sup> Registration No. 3052331, issued January 31, 2006, and claiming acquired distinctiveness pursuant to Trademark Act Section 2(f). Sections 8 and 15 affidavits accepted and acknowledged.

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likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence.

#### The Goods and Channels of Trade

The goods in the three applications overlap with and are identical-in-part to those in the cited registrations. Specifically, both identify "automobiles." As such, we find the goods to be legally identical.

In the absence of specific limitations in either the cited registrations or in the applications, we must presume that both registrant's and applicant's goods will travel in all normal and usual channels of trade and methods of distribution. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937, 939

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(Fed. Cir. 1983); *see also In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the services in the registration and the application move in all channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed services). In other words, there is nothing that prevents the registrant from selling its automobiles in the same dealerships and other venues as those used by applicant. Indeed, as noted below, this is apparently often the case with this particular applicant and registrant.

We find that these *du Pont* factors weigh heavily in favor of finding a likelihood of confusion.

#### The Marks

Preliminarily, we note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Of course, in the case of configuration or design

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marks, as we have here, the analysis must be made solely on the basis of a visual comparison of the two marks.

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In this case, the marks at issue are design configurations on automobiles. Registrant is Ford Motor Company, the maker of Mustang automobiles. As applicant explains:

"It is, of course, well known that Carroll Hall Shelby provides modifications and changed appearances to the Mustang automobiles as manufactured by Ford Motor Company under various agreements with Ford Motor Company. The Shelby Mustangs are often sold side by side with the Ford Mustangs in the same showroom. However, the purchasing public recognizes the differences between the Ford Mustangs and the highly modified versions thereof sold as Shelby Mustangs."  
(appl's brief at 4)

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A declaration from Mr. Carroll Shelby in the '668 application, dated January 26, 2010, states "I designed the Shelby GT-350's unique body style to enhance the image of the ordinary Mustang to give it a performance or muscle car cache."<sup>6</sup> (Shelby Decl. at Para. 2).

It is apparent that the "roof line" depicted in, and protected by, the '330 registration is from a different model year than those depicted in the three applications. The roof line in the '330 registration is apparently shorter, while the roof line on the mark on each of the three applications is flatter. Accordingly, we do not find any similarity in sight or commercial impression with the '330 registration.

On the other hand, the "C-scoop" depicted in, and protected by, the '331 registration appears to be incorporated virtually in its entirety in the marks in each of the three applications.

It is apparent that the C-scoop that appears in the marks on the three applications is slightly different visually from that of the '331 registration. While the C-scoop on the mark in the '331 registration stretches between the front and back wheels of the car, the C-scoop on the marks in the applications varies slightly, but does not start at the bottom as far forward as the front wheel, while it does end forward of it.

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<sup>6</sup> With its February 25, 2011 Response to Office Action, applicant stated the following: "Applicant [also] advised that a co-existence agreement with Ford Motor Co. would [also] be submitted in due course as soon as it can be finalized and executed by the parties." However, one was never submitted.

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Nevertheless, there is an unmistakable "C-scoop" in each of the marks.

Applicant alleged for the first time in its appeal brief that the C-scoop in the '331 registration is weak and, as a common element in automobile registrations, is entitled to a narrow scope of protection. However, the examining attorney objected to the evidence of third-party use submitted by applicant in support of this argument as they, too, were submitted for the first time by applicant with its brief. We must sustain the examining attorney's objection.<sup>7</sup> Accordingly, we find no evidence that the C-scoop in the '331 registration is weak.

In comparing the commercial impressions, we examine the marks in their entireties. We note that the C-scoop is but one aspect of what appears as a "muscle car" in the overall "outward appearance of a vehicle" that is captured by the descriptions in the marks in each of the three applications. As noted by the designer, "[t]he Shelby GT-350 was built on a Ford Mustang platform" (Shelby decl. at para. 3). In this regard, we note that although the C-scoop is part of a larger mark in each of the applications, at the same time, it is still a separately recognizable element of the mark. On the other hand, the C-scoop in the '331 registration, which constitutes the whole of

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<sup>7</sup> We note that, in any regard, the printouts attached by applicant to its brief as evidence of third-party "use" of C-scoops are not sufficiently specific as to source or content (including URL or date of printing) to provide us with enough information on which to base an informed judgment on the matter.

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that mark, is incorporated in full in some version in each of the marks in the applications. We find that the commercial impression engendered by the marks in the applications is therefore similar to that created by the mark in the '331 registration.

In sum, we find the similarities between the marks to outweigh their dissimilarities in sight and commercial impression, and, considering that they are they are both used on automobiles, this *du Pont* factor also weighs in favor of finding a likelihood of confusion as to the '331 registration.

There is an unusual situation that must be considered in these cases. As noted above, applicant's automobile is based on the Ford Mustang platform "under various agreements with Ford Motor Company." However, those agreements were not made of record. As stated previously, applicant did not submit any evidence of any consent by Ford Motor Company, the owner of the cited registrations, for applicant to register the design configurations shown in the applications, including the "C-scoop" shown in the '331 registration. Accordingly, we must not infer such consent exists.

#### Conclusion

In summary we have carefully considered all of the evidence of record relevant to the *du Pont* likelihood of confusion factors. We conclude that there is no likelihood of confusion with the mark in the '330 registration due to the dissimilarity

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of the marks. We further conclude, however, that due to the overlap in the goods and the similarity of the marks, there is a likelihood of confusion between each of the three marks in the applications and the mark in the '331 registration.

Decision: The refusal to register is affirmed.