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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re A-Fab, LLC

Serial No. 77639815

Charles J. Meyer of Woodard, Emhardt, Moriarty, McNett & Henry for A-Fab, LLC.

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(Karen M. Strzyz, Managing Attorney).

Before Quinn, Holtzman and Cataldo, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

A-Fab, LLC filed, on December 24, 2008, an application to register the mark DYNATECH (in standard characters) for "engine exhaust system components, namely, pipes, collectors and mufflers ordered through specialty racing product ordering services." The application was filed under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging first use anywhere and first use in commerce at least as early as 1990.

The trademark examining attorney refused registration under Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with applicant's goods, so resembles the previously registered mark DYNATEK (in standard characters) for "ignition systems for motor vehicles comprising, ignition coils and fuel injection controllers for motor vehicles; [and] crank sensor ignition triggers for motor vehicles"¹ as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant argues that the examining attorney has impermissibly applied a *per se* rule by presuming that the involved goods are related merely because they are automotive in nature. Moreover, applicant asserts that the likelihood of confusion decision must be based on the factual evidence of record, and that the examining attorney's evidence falls short of establishing a sufficient relationship between the goods upon which to base a finding of likelihood of confusion. More specifically, applicant critiques in great detail the deficiencies of the third-party registrations relied upon by the examining attorney to show a relatedness between the

¹ Registration No. 3479598, issued August 5, 2008.

goods. Applicant also contends that the relevant purchasers are unlikely to be confused because of the differences between the goods, the specialized channels of trade, the high degree of consumer care, the crowded nature of the automotive field with similar marks, and the differences in overall commercial impression between the marks. Because of the limitation in applicant's identification of goods, namely "specialty racing product ordering services," applicant asserts that the likelihood of confusion analysis must focus on this narrow trade channel where registrant's and applicant's products could possibly overlap. Applicant further reports that despite thirteen years of contemporaneous use of the marks, applicant is unaware of any instances of actual confusion. In urging that the refusal be reversed, applicant submitted a declaration with accompanying exhibits. Applicant also introduced third-party registrations in connection with its argument that the cited mark is entitled to a narrow scope of protection.

The examining attorney maintains that the marks and goods sold thereunder are similar. As to the degree of distinctiveness of registrant's mark, the examining attorney states that the third-party registrations submitted by applicant, in the absence of evidence showing

actual use, are entitled to little probative value. As for the relatedness of the goods, the examining attorney points to his introduction of third-registrations that serve to suggest that engine exhaust system components and ignition systems for motor vehicles are goods that may emanate from a single source under the same mark. Lastly, the examining attorney is not persuaded by the assertion of no actual confusion given that there is no way to ascertain whether there has been a meaningful opportunity for confusion to have occurred in the marketplace.

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

We first turn to compare applicant's mark DYNATECH with registrant's mark DYNATEK. We must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v.*

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). The test, under the first *du Pont* factor, 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 that confusion as to the source of the goods offered under the respective marks is likely to result. Applicant concedes that the marks "have portions in common," but adds that they are not identical. (Brief, p. 15). Applicant argues that the visual differences between the "-TECH" and "-TEK" suffixes provide the marks with different commercial impressions, and that applicant's "-TECH" suffix is an easily recognizable shortening of the word "technology," thereby suggesting a meaning that the cited mark, employing "-TEK," lacks.

The marks DYNATECH and DYNATEK are identical in sound. As to appearance, the first portion of the marks, "DYNA-" is identical, and the second portion of the marks, namely "-TECH" and "-TEK," differ only slightly. We question whether this difference would even be noted by purchasers. As to meaning, contrary to applicant's argument, we doubt whether purchasers would attribute a different meaning to the marks based on the difference in spelling between

"-TECH" and "-TEK"; to state the obvious, "-TEK" is often used in marks in the same manner as is "-TECH," that is, as a shortened form of the word "technology." It is likely that purchasers would view both marks as suggesting the same idea, namely that the respective goods employ "dynamic technology." Given the identity in sound and meaning, and the similarity in appearance, the marks DYNATECH and DYNATEK engender similar overall commercial impressions.

The similarity between the marks weighs in favor of a finding of likelihood of confusion

Applicant argues that the number of third-party registrations of DYNATECH and similar marks show that the cited mark is entitled to only a narrow scope of protection. In this connection, applicant introduced thirteen third-party registrations of marks comprising DYNATECH and variations thereof (e.g., DYNATEC, DYNATEX and DYNATEK). Although we have considered applicant's evidence, it is of limited probative value to support applicant's position because "[t]he existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American*

Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). Moreover, in the present case, only one of the registrations covers goods in the automotive field (DYNOTECH MOTORSPORTS for automobile aftermarket driveline components); the other twelve registrations cover different goods, ranging from vinyl replacement windows to fishing rods and reels. As correctly pointed out by the examining attorney, these registrations for goods unrelated to the goods at issue are irrelevant to our analysis. See *In re Melville*, 18 USPQ2d 1386, 1388-89 (TTAB 1991).

In sum, the existence of one third-party registration of the mark DYNOTECH MOTORSPORTS in the automotive field does not diminish the distinctiveness of the cited mark DYNATEK. This factor is neutral in the *du Pont* analysis.

We next turn to a comparison of the goods. It is well settled that the goods need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under

circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The question of likelihood of confusion is determined based on the identification of goods in the application vis-à-vis the goods as set forth in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); and *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In considering this *du Pont* factor, it must be noted at the outset that there is no *per se* rule governing likelihood of confusion cases involving all types of automotive products. To the extent that the Board's decision in *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) has been interpreted as presenting a *per se* rule, namely that all automotive goods are *per se* related, such that there must be a likelihood of confusion from the use of the same or similar marks in relation to the goods, this is an

incorrect reading of the *In re Jeep Corp.* case and its progeny. Rather, the likelihood of confusion analysis is governed by the record before the Board.

The only evidence introduced by the examining attorney comprises twenty-one third-party registrations that, according to the examining attorney, cover both types of goods involved herein, namely automotive ignition products and automotive exhaust products.

Applicant, on its behalf, submitted the declaration of Jeffrey Scales, applicant's chief operating officer and executive vice president. Mr. Scales has over 20 years of experience in the vehicle racing component industry, and he states that he has substantial knowledge regarding the marketing and sale of vehicle racing components in the vehicle racing industry, particularly racing components ordered through specialty racing product ordering services, that is, the type of trade channel for applicant's engine exhaust system components. Applicant's goods, according to Mr. Scales, are highly specialized and complex products, marketed as premium racing components of the highest quality to ensure greater speed and enhance vehicle performance. Mr. Scales further states that exhaust system components are typically provided in varying specific sizes, designs and configurations, and that purchasing such

components requires great care to ensure that the component is compatible with a particular vehicle and will fit and operate properly. In the purchasing process, which involves care and sophistication, applicant typically provides personalized guidance to customers ordering components over the telephone. Mr. Scales indicates that applicant's goods sell at "relatively high price points," often selling for several hundreds of dollars, and some for over one thousand dollars, and are typically sold to purchasers who are sophisticated and highly knowledgeable about the racing industry. The declaration is accompanied by excerpts from applicant's website.

Inasmuch as the examining attorney has the burden to make a prima facie showing that the goods are related, we first turn to consider the twenty-one third-party registrations. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). See *In*

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re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant has critiqued this evidence in considerable detail, beginning by pointing out that four of the registrations are not based on actual use in the United States. These four registrations, not based on use, have no probative value whatsoever. *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007). Further, two of the other registrations are owned by the same entities, each for a different mark setting forth the same goods, which renders them redundant. We are left, therefore, with fifteen registrations that may have probative value.

Applicant's principal criticism of the remaining registrations is that "many" of the registered marks are "house or brand marks including laundry lists of various goods, diminishing the argument that any two goods found in the extensive listings are naturally related." (Brief, p. 8). Indeed, the following registrations (9) include lengthy identifications of goods, covering a large number of automotive components, spanning a wide range: Reg. No. 3171805 for S SPORTEC and design; Reg. No. 3443337 for VALUEPART; Reg. No. 3555825 for ZICRON; Reg. No. 3404404 for AUTOPART INTERNATIONAL; Reg. No. 3629275 for PRIME

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CHOICE; Reg. No. 3678282 for WE ENABLE MACHINES THAT MAKE LIFE BETTER; Reg. No. 3670585 for KURYAKYN; Reg. No. 3044874 for VITO'S PERFORMANCE; and Reg. No. 3403698 for C1 CONCEPT-1 and design.

The other registrations (6) set forth shorter identifications of goods, with no clear indication that the marks are in the nature of house or brand marks. The registrations include the following: Reg. No. 3367520 for PASSION FOR PERFORMANCE for a relatively short list of automotive products, including tubular exhaust pipes and electronic fuel injection modules; Reg. No. 3480137 for CXRACING for a relatively small number of automotive parts, including exhaust system components and fuel injectors; Reg. No. 3523602 for C4ORCE and design for a small number of products, including electronic fuel injectors and exhaust system headers and mufflers; Reg. No. 3657377 for TAB PERFORMANCE RIDE EVERYDAY, PERFORM EVERY SECOND and design for fuel injection modules and exhaust pipes; Reg. No. 3040031 for PROWLER for a short list of goods, including ignition and exhaust parts; and Reg. No. 3378706 for TECHNIK ENGINEERING for a short list of goods, including fuel injectors and exhaust components.

In sum, nine of the fifteen registrations may be considered to be in the nature of house or brand marks for

automotive parts, and we have given less probative weight to them. See *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1324 n.3 (TTAB 2010). The other six registrations do not appear to be in the same category, and these registrations support the examining attorney's assertion that goods of the kind involved herein (exhaust and ignition systems components for motor vehicles) are of a type that may emanate from a single source. However, so as to be clear, none of the registrations include both registrant's goods and the specific goods of applicant, namely exhaust system components *sold through specialty racing product ordering services*. Given the amendment to applicant's identification to specify the specific trade channel, the examining attorney's registration evidence loses some of its probative value.

In comparing the goods, we readily recognize that while applicant's goods are limited to a specific trade channel, namely "specialty racing product ordering services," the identification of goods in the cited registration does not include any limitation. However, in view of the restriction in applicant's identification, we must focus our analysis on the only relevant trade channel, namely "specialty racing product ordering services."

As indicated above, applicant has countered with Mr. Scales' declaration and accompanying evidence. Mr. Scales has over twenty years of experience in the vehicle racing component industry. According to Mr. Scales, goods for specialty racing are complex and relatively expensive components that must be properly matched in terms of size, design and configuration to be compatible with different types of motor vehicle engines. The purchase of such goods is made by a knowledgeable consumer or one who is guided to properly match the parts. As indicated by Mr. Scales, applicant's exhaust components are sold through specialty outlets, with applicant typically providing personalized guidance to ensure compatibility with the motor vehicle. As shown by applicant's website, the exhaust system components are provided in varying sizes and configurations that are only available for certain vehicles. Further, given that applicant's goods are intended for the racing industry, purchasers tend to be sophisticated and highly knowledgeable when it comes to components for engines; the purchase of such components is done with a higher degree of care than when buying parts for the everyday car used for commuting.

To state the obvious, exhaust components and ignition components are specifically different goods, with different

purposes and functions. Moreover, we find that the limitation present in applicant's identification of goods, coupled with Mr. Scales sworn-to statements regarding the sophisticated nature of racing components and of the purchasers therefor, outweigh the registration evidence submitted by the examining attorney. Further, given the size of the automotive parts industry, the presence of a mere six registrations listing both exhaust and ignition components is an insufficient basis upon which to find a likelihood of confusion as to source. Simply put, although we readily acknowledge that exhaust and ignition components are both automotive parts, the registration evidence is an insufficient basis for us to conclude that the goods are related, especially when considered in the context of Mr. Scales' statements about the degree of care and sophistication when it comes to purchasing specialty racing components. Because the only overlap among customers are the careful, knowledgeable purchasers of applicant's goods (due to the limitation in applicant's identification), these are the only purchasers who might be exposed to both marks. Therefore, we find that the degree of care likely to be exercised by purchasers of the goods does not support a finding of likelihood of confusion. The specific differences between the goods, as well as the relatively

sophisticated decision-making involved in purchasing applicant's specialty racing exhaust components, warrant a finding that there is no likelihood of confusion.

Applicant's assertion of no actual confusion between the marks is entitled to little weight. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205 ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). See *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. In any event, the record is devoid of probative evidence relating to the extent of use of registrant's and applicant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont*

factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

Based on the record before us, we see the likelihood of confusion refusal as amounting to only a speculative, theoretical possibility. Based on the specific differences between the goods, and the degree of care of knowledgeable purchasers when buying specialty racing components for motor vehicles, we find that the examining attorney, by submitting only the third-party registrations, has not met his burden of establishing that confusion is likely to occur, even when similar marks are involved. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d at 1391 (Fed. Cir. 1992), *citing* *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

Decision: The refusal to register is reversed.