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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Nissan North America, Inc.

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Serial Nos. 77865978 and 77866625

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Gary D. Krugman and Shahrzad Poormosleh, of Sughrue Mion PLLC, for Nissan North America, Inc.

Mayur Vaghani, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

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Before Bucher, Ritchie and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Nissan North America, Inc. ("applicant") has filed an application for the mark ONE-TO-ONE SERVICE, in standard characters, for "customer relationship management services in the field of vehicle maintenance and repair offered

exclusively to applicant's authorized vehicle dealerships,"[1] and an application for the mark depicted below:

for identical services.[2]

The examining attorney has refused registration of applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. §1052, having determined that registration would lead to a likelihood of confusion in view of registrations for the mark ONE-TO-ONE SERVICE.COM (in standard characters) and for the design mark depicted below:

The two cited marks are owned by the same entity and registered for the same recitation of services: "online business services, namely - tracking, managing and cataloging customer service inquiries from web-site

[1] Serial No. 77865978; filed November 5, 2009; first use and first use in commerce asserted as of January 31, 2004; disclaimer to "SERVICE" entered.
[2] Serial No. 77866625; filed November 6, 2009; first use and first use in commerce asserted as of June 30, 2009 and in a different form as of January 31, 2004; disclaimer to "SERVICE" entered.

visitors and customers, and providing online responses thereto; and, conducting and analyzing the results of customer surveys."[3]

When the examining attorney made the refusals final, applicant appealed. On August 4, 2011, the Board granted the examining attorney's motion to consolidate the cases. Both applicant and the examining attorney filed briefs. For the reasons discussed below, we reverse the refusal to register.

I. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we

[3] Reg. No. 2554651 for the mark ONE-TO-ONE SERVICE.COM; issued April 2, 2002; renewed.
Reg. No. 2554652 for the mark ONE-TO-ONE SERVICE.COM and design; issued April 2, 2002; renewed.

keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We have chosen to focus our likelihood of confusion analysis on Registration No. 2554651 for the mark ONE-TO-ONE SERVICE.COM because the mark in that registration is most similar to that in the applications at issue. If we find a likelihood of confusion with this registration, then it would serve little purpose to consider the other registration. Conversely, if we find that there is no likelihood of confusion with registrant's standard character registration in connection with the listed services, there is no need for us to consider the likelihood of confusion with the special form mark of the other cited registration. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

II. Discussion

A. Similarity or Dissimilarity of the Marks in Their Entireties

Applicant, in its brief, states that it "notes and concedes that, while the marks in the cited registrations are not identical to Applicant's mark[4] herein, the respective marks are substantially similar and Applicant, therefore, will not argue to the contrary." *Appeal Brief*, p. 5.

In view thereof, we need not conduct an analysis of the marks, and simply find that they are similar.[5]

B. Similarity of the Services

Applicant uses its mark in association with "customer relationship management services in the field of vehicle

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[4] We presume applicant intends to refer to both of its marks and that the reference to "Applicant's mark" in the singular tense is an inadvertent typo. This is corroborated by applicant's statement, in its reply brief, that applicant has "conceded that the respective marks are similar …." *Reply Brief,* p. 2. Applicant is correct in noting that "Whether or not the marks are confusingly similar is the ultimate legal issue in this case," and we have not construed applicant's position as conceding this ultimate legal issue.

[5] Although applicant has conceded the similarity of the marks, the strength of the registrant's mark is a separate factor that we may consider. We take judicial notice of the definition of the phrase "one-to-one," which is defined at http://www.merriam-webster.com/dictionary as meaning: "1: pairing each element of a set uniquely with an element of another set." While this definition stems from a mathematical function, its meaning is evident in relation to the services provided by registrant, namely, that registrant treats each customer individually, on a one-to-one, personal basis. Thus, the mark is suggestive; as such, it is entitled to a lesser scope of protection than would be the case if it were arbitrary or fanciful.

maintenance and repair offered exclusively to applicant's authorized vehicle dealerships" in International Class 35. The registrations are for "online business services, namely - tracking, managing and cataloging customer service inquiries from web-site visitors and customers, and providing online responses thereto; and, conducting and analyzing the results of customer surveys."

It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods or services identified in the cited registration(s). See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *Canadian Imperial Bank v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1987); and *Paula Payne Products v. Johnson Publishing Co.,* 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods."). The examining attorney contends that the services are of a type that could emanate from a single source, and in support of this position, made of record numerous third-party registrations that purportedly demonstrate that consumers are familiar with entities offering applicant's type of services and registrant's type

of services under the same mark. Copies of use-based, third-party registrations may serve to suggest that the goods and services are of a type which may emanate from a single source, although they are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Upon careful review of the registrations submitted by the examining attorney, we find them not to be highly probative of the purported relationship between the services. While several show that companies that offer "customer relationship management" services may also conduct and analyze public opinion surveys, none appear to be web-based (in other words, "online business services") or directed specifically to customer service inquiries from website visitors and customers, or to customer surveys, as is the case with the cited mark.[6] Moreover, none are in the field of vehicle maintenance and repair.

[6] While there is one registration (Reg. No. 2895993 for the mark REAL-TIME CUSTOMER CARE POWERED BY ISKY & design) that includes customer relationship management services and "promoting the goods and services of others via an on-line electronic communications network by initiating, receiving and responding to on-line inquiries to and from customers of other businesses," this single instance does not show that the services are generally of a type that emanate from a single source, that consumers are familiar with their origination as being from a single source or that the services are related.

In addition, the examining attorney has taken particular note of five web pages attached to the final Office action that purport to show that the services of conducting and analyzing customer survey results are included within the definition of customer relationship management services. According to this evidence, the examining attorney argues that applicant could conduct or analyze customer surveys for its dealerships as part of the relationship management services it provides, creating an overlap between the services and a potential for confusion.

Based on a strict reading of the recitations in each of applicant's application and registrant's registration, the services are potentially related with respect to the services of conducting and analyzing customer surveys. This factor, then, slightly favors a finding of likelihood of confusion.

C. Channels of Trade and Classes of Purchasers

Applicant's services are limited to applicant's "authorized vehicle dealerships" only. Applicant does not offer services under the mark ONE TO ONE SERVICE to the general public. As the examining attorney points out, registrant could offer its "online business services" to

opposer's dealers.[7] However, this appears unlikely. Applicant has submitted ten declarations from authorized vehicle dealerships[8] wherein each dealer attests that he has "never received any information from any business offering the services of tracking, managing or cataloging consumer service inquiries from web site visitors/customers [or] the services of conducting or analyzing the results of such customer inquiries." *Dealer declarations,* para. 6. While the dealers have each signed a similarly worded declaration, two of the dealers have been authorized Nissan dealerships since the 1980's (1981 and 1985), and three since the 1990's (1990, 1995 and 1998). Thus, a long period of time has elapsed during which none of these five declarants ever encountered a business offering the type of services offered by registrant. While the potential for overlap in the channels of trade theoretically exists, chances of its occurrence are slight. This *du Pont* factor is neutral.

[7] Of course, the registrant could offer its services to all classes of consumers that are normal for the type of services involved, and they could be purchased by all potential buyers thereof; in this case, however, any but applicant's customers are not relevant to our inquiry, because applicant has narrowed its recitation of services to its own dealerships.

[8] Although the majority are located in the mid-Atlantic, opposer also submitted the declaration of the Service Director of Tynan's Nissan located in Aurora, Colorado.

D. Buyer Sophistication

The purchasers' likely degree of care is an important factor in this case. We first clarify that, based on the recitation of services, it is applicant's dealers whose potential confusion is to be considered, and not that of a member of the general public, inasmuch as applicant has narrowed the potential purchaser of its services to only its authorized dealerships. "If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e., a customer or purchaser." *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992) (citations and quotation marks omitted).

While "there is always less likelihood of confusion where goods are expensive and purchased after careful consideration," *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786, 790 (1st Cir. 1983), in this case the record does not inform regarding the cost of applicant's services. Nonetheless, applicant contends that its customers are sophisticated in the sense that the close personal relationship cultivated between itself and its dealers has educated them "about the origin of the services offered [such that they] would not be confused as to the source or sponsorship of those

services given the realities of the commercial marketplace in the automotive industry and how automotive manufacturers communicate with their authorized dealership base." *Appeal Brief,* p. 8. The dealer declarations support applicant's contention. In each, the dealer attests that "access to [opposer's customer relationship management] program is only through [opposer's] dedicated dealers only portal, which is password protected and can only be accessed by authorized Nissan dealers." *Dealer declarations,* para. 4. Moreover, they would not be confused if approached by registrant offering its online services: "If I did receive information offering such services, which services were not offered through Nissan's password protected dealers only portal, I would immediately recognize and understand that such services were not offered by, sponsored by, endorsed by, or otherwise connected in any way with Nissan." *Dealer declarations,* para. 4.

"[P]urchaser[ ] ... sophistication is important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.'" (third bracket in original). *Electronic Design,* 21 USPQ2d at 1392 (quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.,* 657 F.2d 482, 212 USPQ 246, 252 (1st. Cir. 1981)); *In re Shipp,* 4 USPQ2d 1174, 1176 (TTAB 1987)(commercial dry

cleaning equipment, which is ordinarily not sold to general public, and laundry and dry cleaning services that are offered to general public are not so related that confusion would be likely from contemporaneous use of virtually identical mark, since only operators of dry cleaning establishments would have potential to encounter both, and since such operators are relatively sophisticated and discriminating in matters relating to dry cleaning industry). In this case, the relevant buyer class is composed solely of professional or commercial purchasers familiar with the field, who have attested to how observant and discriminating they are in practice. This factor strongly favors a finding of no likelihood of confusion.

III. Conclusion

We have carefully considered the entire record, all arguments, and the evidence submitted by applicant and the examining attorney. In the face of this evidentiary record, we agree with applicant that "the only narrow and limited overlap in the potential class of customers comprise sophisticated, knowledgeable individuals who have a close business relationship with applicant," *Appeal Brief* p. 9, and that these consumers are not likely to be confused. In saying this, we note that it is well-established that in evaluating a likelihood of confusion,

the Board must consider more than the mere *possibility* of confusion. *See In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003); *Electronic Design*, 21 USPQ2d at 1393; *Bongrain Intl. (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987); *In re E.I. du Pont*, 177 USPQ at 563. In view thereof, use of applicant's mark in association with "customer relationship management services in the field of vehicle maintenance and repair offered exclusively to applicant's authorized vehicle dealerships," is not likely to cause confusion with the marks in the cited registrations.

Decision: The refusal to register under Trademark Act § 2(d) is reversed as to both marks in trademark application Serial Nos. 77866625 and 77865978.

These applications will proceed to publication in due course.