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Oct. 30, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Gunn GP LLC

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Serial No. 78497204

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Linda W. Browning of Kammer Browning PLLC for Gunn GP LLC.

Tina L. Snapp, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).[1]

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Before Walters, Bucher and Grendel, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark **GUNN SMARTCHOICE SERVICE** (in standard character form) for "vehicle repair services" in Class 37.[2] Applicant

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[1] A different Trademark Examining Attorney handled the application prior to appeal.

[2] Serial No. 78497204, filed October 8, 2004. The application is based on intent-to-use under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

has disclaimed the exclusive right to use SMARTCHOICE SERVICE apart from the mark as shown.[3]

At issue in this appeal are the Trademark Examining Attorney's final refusals to register applicant's mark on the ground that the mark, as used in connection with applicant's services, so resembles each of two previously-registered marks (which are owned by the same owner) as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The first cited registration is Supplemental Register Registration No. 1937610 (the '610 registration), which is of the mark **SMART CHOICE** (in standard character form) for "repairing, painting, cleaning, washing and applying protectants to vehicle body surfaces; vehicle repair services, installation of automotive accessories, and automotive detailing, namely cleaning, washing and application of protectants to automotive body, engine and interior surfaces," in Class 37.[4]

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[3] The disclaimer of SERVICE was made in response to the Trademark Examining Attorney's requirement. The disclaimer of SMARTCHOICE was made voluntarily by applicant in response to the Section 2(d) refusals made in the first Office action. Applicant's voluntary disclaimer of SMARTCHOICE has not affected our Section 2(d) analysis or decision. *See, e.g., In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991).

[4] Issued November 21, 1995; renewed. Affidavit under Trademark Act Section 8 accepted.

The second cited registration is Principal Register Registration No. 1940652 (the '652 registration), which is of the mark **AMERICA'S SMART CHOICE** (in standard character form) for "repairing, painting, polishing, buffing, cleaning, washing and applying protectants to vehicle body surfaces; vehicle repair services; installation of automotive accessories; and automotive detailing, namely cleaning, washing, and application of protectants to automotive body, engine, and interior surfaces," in Class 37.[5]

Initially, we sustain the Trademark Examining Attorney's objection (made in her appeal brief) to the evidence submitted for the first time by applicant as Exhibit B to its appeal brief (i.e., the ten third-party registrations of SMART CHOICE marks), and to the evidence submitted for the first time by applicant as Exhibit C to its appeal brief (i.e., the specimen brochure from one of the cited registrations). These materials are untimely, and will be given no consideration. *See* Trademark Rule 2.142(d), 37 C.F.R. §2.142(d).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in

[5] Issued December 12, 1995; renewed. Affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged.

evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to the Section 2(d) refusal with respect to the '610 Supplemental Register registration of the mark SMART CHOICE, we find that applicant's "vehicle repair services" are identical to the "vehicle repair services" which are included in the recitation of services in the prior registration. We also find that these services are or would be marketed in the same trade channels and to the same classes of purchasers. Thus, we find that the second and third *du Pont* factors (similarity or dissimilarity of services, and similarity or dissimilarity of trade channels) weigh in favor of a finding of likelihood of confusion.

We find, however, that applicant's mark GUNN SMARTCHOICE SERVICE is sufficiently different from the registered SMART CHOICE mark that no confusion is likely,

even if the marks are used in connection with identical services. Even without considering the third-party registration evidence untimely submitted by applicant, we find that SMART CHOICE is obviously and inherently a laudatory and descriptive phrase, as is evidenced by the fact that it is registered on the Supplemental Register. *See In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). It directly informs purchasers that they are making the "smart choice" by selecting registrant's repair services. We find that the mere presence of this laudatory expression in both marks does not suffice to render the marks confusingly similar when viewed in their entireties. Stated differently, notwithstanding the presence of SMART CHOICE in the cited registered mark and the presence of SMARTCHOICE in applicant's mark, we find that the points of dissimilarity between the marks, i.e., applicant's compression of SMART CHOICE into SMARTCHOICE, its addition of the word SERVICE, and, especially, applicant's addition of the house mark GUNN, suffice, collectively, as means by which purchasers will be able to distinguish between the sources of the services offered under the respective marks. *See Knight Textile Corporation v. Jones Investment Co., Inc.*, 75 USPQ2d 1313 (TTAB 2005)(NORTON-MCNAUGHTON ESSENTIALS not confusingly similar to ESSENTIALS even as

applied to identical goods, due to weakness of term ESSENTIALS). For this reason, we find that the first *du Pont* factor (similarity or dissimilarity of the marks) weighs against a finding of likelihood of confusion.

Considering all of the relevant *du Pont* factors, we find on balance that there is no likelihood of confusion between applicant's mark and the cited '610 registered mark. The dissimilarity between the marks is dispositive in this case. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). We accordingly reverse the refusal to register based on the '610 registration.

Turning next to the '652 Principal Register registration of AMERICA'S SMART CHOICE, we find, again, that applicant's "vehicle repair services" are identical to the "vehicle repair services" included in the cited registration's recitation of services, and that these services are or would be marketed in the same trade channels and to the same classes of purchasers. The second and third *du Pont* factors therefore weigh in favor of a finding of likelihood of confusion.

We find, however, that applicant's mark GUNN SMARTCHOICE SERVICE is sufficiently dissimilar to AMERICA'S SMART CHOICE that no confusion is likely, even if the marks

were to be used in connection with identical services. Again, the only point of similarity between the marks is the presence of SMART CHOICE in the cited registered mark and SMARTCHOICE in applicant's mark. Although SMART CHOICE is not disclaimed in the '652 registration (notwithstanding the fact that it is registered on the Supplemental Register in the '610 registration, which is owned by the same entity), we nonetheless find that it is inherently quite laudatory and weak as a source indicator.[6] Its mere presence in both marks does not suffice to render the marks similar in their entireties. The points of dissimilarity between the two marks, i.e., the presence of the house mark GUNN in applicant's mark and of the word AMERICA'S in the cited registered mark, suffice to enable purchasers to distinguish between the sources of the services rendered under the marks. *See Knight Textile Corporation, supra*. We find that the first *du Pont* factor weighs against a finding of likelihood of confusion.

Considering all of the relevant *du Pont* factors, we find on balance that there is no likelihood of confusion between applicant's mark and the cited '652 registered

[6] *See In re National Data Corp., supra*, 224 USPQ at 751 ("The absence of a disclaimer does not, however, mean that a word or phrase in a registration is, or has become, distinctive in the registered mark, so that that part of the mark must be treated the same as an arbitrary feature.").

mark. As with the '610 registration, it is the overall dissimilarity of the marks which is dispositive in this case. *See Kellogg Co. v. Pack'Em Enterprises Inc., supra.* We accordingly reverse the refusal to register based on the '652 registration.

Decision: The Section 2(d) refusals to register based on the cited '610 and '652 registrations are reversed.