

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NOK Corporation

Serial No. 79090703

Gary D. Krugman of Sughrue Mion, PLLC for NOK Corporation.

Michelle E. Dubois, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Wellington, Adlin and Hightower, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

NOK Corporation (“Applicant”) filed an application to register on the Principal Register the standard character mark **Global-SP** for goods ultimately identified as “*O-rings of rubber for automobiles*, industrial machines, hydraulic equipments and semiconductor manufacturing equipments; non-metal gaskets for industrial machines, hydraulic equipments and semiconductor manufacturing equipments; *non-metal packings for forming seals for use in automobiles*, industrial machines, hydraulic equipments and semiconductor manufacturing equipments,” in

International Class 17¹ (italics provided to emphasize specific goods relevant to this proceeding).

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used with the highlighted goods, so resembles the registered standard character mark **SP DIRECT** for "Automotive aftermarket parts, namely, ...gaskets ...," in International Class 7,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and filed a request for reconsideration. On September 26, 2013, the Examining Attorney denied the request for reconsideration. The appeal resumed and briefs have been filed.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544

¹ Application Serial No. 79090703 is a request for extension of protection of an international registration under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a) (Madrid Protocol). The application been accorded an effective filing date of November 18, 2010. *See* 15 U.S.C. §§ 1141f(b) (filing date).

² Registration No. 3755262, issued on March 2, 2010. The registration also covers various other automotive goods, parts and services.

F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Similarity of the Goods in the Application and Registration

We turn first to the du Pont factor involving the relatedness of the relevant goods, *i.e.*, Applicant's "O-rings of rubber for automobiles [and] non-metal packings for forming seals for use in automobiles" and Registrant's "Automotive aftermarket parts, namely, ...gaskets ..."

The evidence establishes that O-rings, packings for forming seals, and gaskets are roughly synonymous terms for goods that perform essentially the same function. The Examining Attorney submitted the following definitions:³

Gasket: Any of a wide variety of seals or packings used between matched machine parts or around pipe joints to prevent the escape of a gas or fluid.

O-ring: A flat ring made of rubber or plastic, used as a gasket.

Registrant's automotive gaskets thus encompass Applicant's O-rings and packings for forming seals. These goods all share the same purpose, namely, forming seals in automobiles to prevent the leak of a gas or fluid. Printouts from retail automotive supply store websites, such as AutoZone, demonstrate that automotive engine gaskets include "universal O-Rings" as well as various other types of gaskets, *e.g.*, engine oil pan gaskets, valve cover gaskets and water outlet gaskets.⁴ The record also includes printouts for a number of third-party marks registered for automotive gaskets and packings and/or O-rings for purposes of showing that these are the kind

³ Both definitions from The American Heritage Dictionary of the English Language (4th edition, updated 2009), printouts obtained from www.thefreedictionary.com and attached to Office Action dated July 11, 2013.

⁴ Printouts from www.autozone.com attached to Office Action dated July 11, 2013.

of goods that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The Examining Attorney also submitted Internet evidence showing the same manufacturer touting its automotive O-rings and gaskets, as well a retail automotive supply website advertising “Manifold Gaskets By Victor Reinz” (for \$12.19) and “O-Rings by Victor Reinz” (for \$21.18).⁵

We accordingly find that the goods are legally identical. This factor weighs in favor of finding a likelihood of confusion.

The Channels of Trade and Classes of Purchasers for the Goods

Because Registrant’s goods encompass the objectionable goods identified in the application, and they are thus legally identical, we must assume that the purchasers and channels of trade for these goods would also be the same. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade.”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). In any event, the record supports this presumption and shows that automotive

⁵ Website printouts from www.columbiaerd.com and www.carquest.com, respectively, attached to Office Action dated July 11, 2013.

gaskets, seals and O-rings may indeed be found in the same retail automotive supply stores.

In view of the above, the *du Pont* factors of the channels of trade and classes of purchasers also favor a finding of likelihood of confusion.

Sophistication of Consumers

Applicant argues that consumers would “by virtue of the nature of the function and use of the respective goods, be knowledgeable, technically trained mechanics and automobile repair specialists who would purchase the various automotive parts with care.” Brief, p. 6. Applicant characterizes the class of consumers as “sophisticated, knowledgeable individuals who would immediately recognize that Applicant’s goods emanate from Applicant.” However, Applicant does not cite to any evidence and the record does not necessarily support this argument. While we can assume that automotive repair specialists will be one class of consumers, we cannot rule out individual car owners performing their own repairs or service and purchasing these goods from the previously mentioned retail stores, such as www.autozone.com and www.carquest.com. Furthermore, even if we were to find that purchasers of automotive gaskets, O-rings and packings are knowledgeable to the extent that they know how to install these goods, the evidence shows these are relatively inexpensive items costing as little as \$12-\$25. This is certainly not a price point which would cause purchasers to exercise a higher level of care in their decision; also, even if these purchasers are proficient in the automotive repair and service field, this does not necessarily mean that they are

sophisticated in the field of trademarks or immune from source confusion. *Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995). As a result, we find little to persuade us that any consumer sophistication would play a role in avoiding a likelihood of confusion. This factor therefore remains neutral in our likelihood of confusion analysis.

Comparison of the Marks

We now address the similarities and dissimilarities between the marks **GLOBAL-SP** and **SP DIRECT**. In doing so, we compare the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) *quoting du Pont*, 177 USPQ at 567. 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. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1381 (TTAB 2012); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). In making this determination, we recognize that purchasers have fallible memories. *See, e.g., San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2-3 (CCPA 1977); *Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA

1969); *Sakrete, Inc. v. Slag Processors, Inc.*, 305 F.2d 482, 134 USPQ 245, 247 (CCPA 1962); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

The obvious similarity is that both marks contain the element SP and the obvious dissimilarity is that Applicant's mark begins with the term GLOBAL while the registered mark ends with the term DIRECT. Applicant and the Examining Attorney disagree on the importance to be attached to these similarities and dissimilarities.

Applicant's main argument is that the "common component SP in both marks is weak." Brief, p. 4. Applicant has made of record twenty-three (23) third-party registrations for marks containing the element SP, either by itself or with other terms. Applicant suggests possible meanings for the terms "global" and "direct," in arguing that these terms are not descriptive of automotive goods or distribution methods.⁶ As a result, Applicant asserts that "the mere inclusion of SP in both [marks] cannot be the basis of a Section 2(d) refusal where, as here, the respective marks have other components which are dissimilar in sight, sound and connotation." *Id.* at 6.

The Examining Attorney, on the other hand, takes the position that the dominant element of each mark is SP because this letter combination has "no

⁶ At Applicant's request, the Board agrees to take judicial notice of the definitions attached to its brief. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). *See also University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). With regard to Applicant's particular request, we note that "global" may be defined as "worldwide," as well as "comprehensive" and "computer science of or relating to an entire program, document, or file." Likewise, "direct" may be defined as "having no intervening persons," as well as "to manage or regulate" and "candid; frank."

significance in applicant's industry," whereas the terms "global" and "direct" are "descriptive or highly suggestive." Brief, at (unnumbered) p. 9. As the Examining Attorney explains, "[c]onsumers are likely to believe that GLOBAL-SP is an international line of products and SP DIRECT is a line of products from the same company that is provided directly to the consumer, without an intervening agent." *Id.* at 8. In support, the Examining Attorney submitted dictionary definitions for the words "global" and "direct," as well as a few third-party registrations for marks containing the term DIRECT, with the term disclaimed or registered on the Supplemental Register.

With regard to the third-party registrations for marks containing the element SP submitted by Applicant, the Examining Attorney makes the following points: the registrations are not evidence that the marks have actually been used in commerce or that consumers are even familiar with the marks; eleven (11) of the registrations are owned by a single entity and are for tires; four (4) of the registrations have little, if any, probative value because a statement of use in commerce has not been filed; and the goods covered by the registrations are unrelated to automotive gaskets, O-rings, and packing for seals.⁷

We find these marks to be similar in meaning, sound, appearance and overall commercial impression and, on balance, the fact that both marks share the SP element outweighs the difference based on the added wording.

⁷ For example, some of the goods covered by these registrations are: "audio compression software for CD-receive for automobiles"; "pneumatic hand tools for the automotive industry"; "land vehicle body panels, fairings for vehicles..."; and "battery connectors."

For all of the reasons argued by the Examining Attorney, we agree that Applicant has not shown that the shared element, SP, is either a weak or diluted term when used in marks for automotive gaskets, O-rings, and packings for forming seals. In particular, we reiterate the points that many of the third-party registrations submitted by Applicant are owned by a single entity and are for tires. While it may be argued that many of the goods identified in the registrations involve automobiles in some fashion, it has not been argued, let alone shown, that there is a relationship to the goods at issue here. Furthermore, Applicant has not proffered a possible meaning or significance in the industry for the letters SP.

In contrast, the additional wording in the marks, “direct” and “global,” are not particularly distinctive. We further agree with the Examining Attorney that the most likely understanding by consumers will be that these terms are suggestive of the manner or geographic range in which the goods can be purchased. The alternative possible meanings for these words suggested by Applicant (see footnote 6) are not reasonably applicable given the context of the entirety of the marks and the goods. Ultimately, consumers already familiar with the mark **SP DIRECT** are likely to perceive a strong similarity to Applicant’s mark **GLOBAL-SP** based on the shared element, SP.

This factor weighs in favor of likely confusion.

Balancing of Factors

In view of our findings that the marks are similar, Registrant's goods encompass Applicant's, and thus are legally identical to the identified objectionable goods in the application, and that the trade channels and classes of consumers are the same, we find that use of Applicant's mark is likely to cause confusion with the cited registered mark with respect to the objectionable goods.

Decision: The refusal to register based on a likelihood of confusion under Section 2(d) of the Trademark Act is affirmed with respect to the following goods identified in the application: "O-rings of rubber for automobiles" and "non-metal packings for forming seals for use in automobiles." These goods will be deleted from the application in due course.