

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 ZF Friedrichshafen AG

Serial No. 79322731

Mari-Elise Paul, Trevor Graves, and Brewster Taylor of Stites & Harbison PLLC,
for ZF Friedrichshafen AG.

Marcy Betts, Trademark Examining Attorney, Law Office 106,
Mary Sparrow, Managing Attorney.

Before Taylor, Lykos and Lynch,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), ZF Friedrichshafen AG (“Applicant”) filed a Request for Extension of Protection of an international registration for the standard character mark KING OF THE ROAD on the Principal Register for the following goods:

Batteries; rechargeable batteries; electric batteries; vehicle batteries; car batteries; batteries for electronic cigarettes; battery boxes; battery jars; battery chargers in International Class 9; and

Lighting apparatus for vehicles; lights for vehicles; lights for automobiles; lighting installations for air vehicles;

lamps; electric lamps; light bulbs; light bulbs for directional signals for vehicles; light diffusers; LED light bulbs; lighting apparatus and installations, namely, lighting apparatus for vehicles and lighting installations; electric lights for Christmas trees in International Class 11.¹

Registration was partially refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the typed mark² KING OF THE ROAD on the Principal Register for "mirrors for land vehicles" in International Class 12, that it is likely to cause confusion or mistake or to deceive.³ The Examining Attorney's partial refusal applies to all goods in both classes with the exception of "batteries for electronic cigarettes" in International Class 9 and "electric lights for Christmas trees" in International Class 11.⁴

¹ Application Serial No. 79322731, filed September 21, 2021, based on International Registration No. 1618919, with a priority claim date of April 15, 2021 pursuant to Section 67 of the Trademark Act, 15 U.S.C. § 1141(g). *See generally* The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") and Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 ("MPIA").

Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system in .pdf format. Citations to briefs refer to the actual page number, if available, as well as TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

² "Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. ... A typed mark is the legal equivalent of a standard character mark." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 807.03(i) (July 2022). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

³ Registration No. 1759755 registered March 23, 1993 on the Principal Register; renewed.

⁴ *See* January 8, 2022 Final Office Action.

Applicant appealed and filed a request for reconsideration which was denied. The appeal is now fully briefed. We affirm the partial refusal to register as to both classes of goods.

I. Likelihood of Confusion – Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence or argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). Varying weights may be assigned to each *DuPont* factor depending on the

evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil Co.*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”). These factors, and others, are discussed below.

II. Likelihood of Confusion - Analysis

A. Strength of the Cited Mark

At the outset, we consider the strength of the cited mark since this affects its scope of protection. “[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “The weaker [the cited] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted). In determining the strength of a cited mark, we consider both its inherent strength,

based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Applicant postulates that the cited mark KING OF THE ROAD mark is “relatively weak” and entitled to only a narrow scope of protection in connection with vehicles and vehicle parts.⁵ It contends that the Examining Attorney failed to accord the “appropriate weight” to evidence of third-party use of marks comprised in part of the words “King” and “Road.”⁶

Applicant did not introduce any evidence of third-party uses that would establish any diminished commercial strength of Registrant’s mark, the sixth *DuPont* factor. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116

⁵ Applicant’s Brief, p. 8; 6 TTABVUE 11.

⁶ Applicant’s Brief, p. 8; 6 TTABVUE 15.

USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). Instead, Applicant challenges the strength of the cited mark by making of record third-party registrations. Such registrations can be relevant only to inherent or conceptual strength, rather than commercial strength. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (“third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness”). The following four third-party registrations that are comprised of or include the words KING and ROAD in their marks are in the record:⁷

Registration No. 4649582 for the mark ROAD KING on the Principal Register for “tires excluding motorcycle tires” in International Class 12;

Registration No. 1870447 for the mark ROAD KING on the Principal Register for “motorcycles and structural parts therefore” in International Class 12;

Registration No. 3394916 for the mark KING OFF-ROAD RACING SHOCKS on the Principal Register for “vehicle parts, namely, shock absorbers” in International Class 12; and

Registration No. 3522183 for the mark ROADKING SHOCKS on the Principal Register for “shock absorbers for motor homes and heavy duty trucks” in International Class 12.

⁷ See December 3, 2021 Response to Office Action at TSDR 11-22. We have not considered cancelled Registration Nos. 1282371, 1419927, and 1816973. *See In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (cancelled registrations are not probative support for applicant’s argument of “consumer perceptions [of the subject marks] in the marketplace”); *In re Hartz Hotel Servs. Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations submitted by applicant).

Applicant maintains that “these registrations demonstrate that the USPTO has very clearly recognized that KING OF THE ROAD, a commonly used phrase with a clear meaning used as a title in film and music, is entitled to a very narrow protection ...”⁸

Properly made of record, third-party registrations alone may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 115 USPQ2d at 1675 (internal quotation marks omitted). *See also Jack Wolfskin*, 116 USPQ2d at 1136; *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). “[E]vidence of third-party registrations is relevant to ‘show the sense in which . . . a mark is used in ordinary parlance.’” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *3 (TTAB 2020).

Here, none of the third-party registrations are for the same phrase as the cited mark “King of the Road.” So while there may be some degree of conceptual weakness of the words KING and ROAD in connection with vehicle parts,⁹ on this record, we do not find that the phrase “King of the Road” as a whole is conceptually weak. *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *25 (TTAB 2021) (“[W]hile

⁸ Applicant’s Brief, p. 9; 6 TTABVUE 12.

⁹ By way of comparison, in *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record, 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n.2.

the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are.”).

Thus, Applicant has not shown that the cited mark has been weakened by third-party registrations or uses of similar marks by competitors in the industry offering the same or similar goods. Nor has Applicant submitted evidence to support its assertion that the phrase “King of the Road” has a commonly recognized meaning as a song or film title. “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)). Because the cited registration is “prima facie evidence of the validity of the registered mark,” see Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), we must assume that the mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. See *Tea Bd. of India*, 80 USPQ2d at 1889. See also *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020). Thus, we afford Registrant’s KING OF THE ROAD mark “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

B. The Marks

Next, we consider the first *DuPont* factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound,

connotation and commercial impression. *See Palm Bay Imps.*, 73 USPQ2d at 1692 (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d, 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

It is undisputed that Applicant’s standard character mark and Registrant’s typed mark are identical in appearance and sound. As such, the marks “have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Furthermore, this is not a situation where the same marks are used to identify goods so dissimilar as to engender different connotations or commercial impressions. *See, e.g., In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (no likelihood of confusion found between BOTTOMS UP for ladies’ and children’s underwear and BOTTOMS UP for men’s suits, coats and trousers). The identical nature of the marks weighs heavily in favor of finding a likelihood of confusion.

**C. The Goods and The Similarity or Dissimilarity of Established,
Likely-to-Continue Trade Channels and Classes of Consumers**

Keeping in mind that where identical marks are involved, the degree of similarity between the goods that is required to support a finding of likelihood of confusion declines, *Shell Oil Co.*, 26 USPQ2d at 1689, we now compare the goods as they are

identified in the involved application and cited registration, the second *DuPont* factor. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *B&B Hardware*, 135 S. Ct. at 1300 (recognizing that an “applicant’s right to register must be made on the basis of the goods described in the application”). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). In addition, the Examining Attorney need not prove, and we need not find, similarity as to each good listed in the application. “It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both an applicant's goods (or similar goods) and the goods listed in the cited registration (or similar goods). *See, e.g., Davia*, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

The Examining Attorney submitted third-party website evidence demonstrating that it is not uncommon in the auto parts industry for entities to manufacture and offer for sale some of the International Class 9 and 11 items included in Applicant's application as well as "mirrors for land vehicles" identified in the cited registration under the same trademark, either via the direct-to-consumer websites or via retail online or brick-and-mortar auto parts stores:

- O'Reilly Auto Parts offers car batteries, turn signal light bulbs, and rearview mirrors under the AC Delco brand name via its direct-to-consumer website and repair shops;¹⁰
- Napa branded car batteries, LED bulbs for vehicles, and side view mirrors sold either online via its direct-to-consumer or in its brick-and-mortar store;¹¹

¹⁰ January 8, 2022 Examining Attorney's Final Office Action at TSDR 7-20 (oreillyauto.com/shop accessed on January 5, 2022).

¹¹ January 8, 2022 Examining Attorney's Final Office Action at TSDR 24-33 (napaonline.com accessed on January 5, 2022).

- Omix manufactures light bulbs for vehicles, head light bulbs, and rear view mirrors under the Omix trademark.¹²

This evidence shows consumer exposure to some of Applicant's International Class 9 and 11 goods and Registrant's products as identified in the involved application and cited registration emanating from a common source under a single brand name. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (evidence that third parties use the same mark for the involved goods and services “suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard*, 62 USPQ2d at 1004 (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”). The aforementioned evidence is not from “big box” online or brick-and-mortar retailers selling a wide variety of goods from different suppliers but rather from stores and their dedicated direct-to-consumer sales websites specializing in auto parts. This targeted type of retailing is narrower in scope, and as such is entitled to a higher degree of probative weight. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *8 (TTAB 2020) (“[T]he fact that more targeted sellers offer goods of both the Registrant and the Applicant tells us that the goods are related.”).

Our determination is bolstered by the following subsisting use-based,¹³ third-party registrations introduced by the Examining Attorney showing that the same entity has registered a single mark identifying at least one of the goods classified in

¹² January 8, 2022 Examining Attorney’s Final Office Action at TSDR 34-42 (omix-ada-.com accessed on January 5, 2022).

¹³ We have disregarded any registrations issued pursuant to Trademark Act Sections 44(e) and 66(a) and any cancelled registrations.

International Class 9 or 11 of Applicant's application, and also identifying goods that encompass "mirrors for land vehicles," the only goods identified in the cited registration:

Registration No. 4352519 for the mark ITT for, in relevant part, "batteries" in International Class 9; "vehicle tail lights" in International Class 11; and Vehicle mirrors, namely, blind spot mirrors" in International Class 12;¹⁴

Registration No. 5511844 for the mark SPEC-D for, in relevant part, "Lights for vehicles; vehicle lights and components therefor, namely, projector headlights, euro headlights, LED tail lights, tail lights, bumper lights, corner lens, fog lights, brake lights, light bulbs, side marker lights" in International Class 9; and "vehicle parts, namely, grills, fenders, hood pins, side mirrors" in International Class 12;¹⁵

Registration No. 5535264 for the mark AKKON for lighting apparatus for vehicles; lighting installations for vehicles; lights for vehicles; tail lights for vehicles; vehicle brake lights; rear lights for vehicles in International Class 11 and side view mirrors for vehicles in International Class 12;¹⁶

Registration No. 6077841 for the mark AUTO ACCESSORIES OF AMERICA for, in relevant part "automotive batteries" in International Class 9; "lamps; lights for vehicles; Tail lights for vehicles; lighting apparatus for vehicles" in International Class 11; and "vehicle parts, namely, rear view and side mirrors" in International Class 12;¹⁷

Registration No. 6077841 for the mark UNITED PACIFIC for, in relevant part, "light panels for vehicles, namely, automobiles; light bars for vehicles, namely, automobiles; lights for vehicles, automotive headlamps, incandescent

¹⁴ August 9, 2022 Examining Attorney's Denial of Applicant's Request for Reconsideration at TSDR 9-15.

¹⁵ August 9, 2022 Examining Attorney's Reconsideration Letter at TSDR 38-40.

¹⁶ August 9, 2022 Examining Attorney's Reconsideration Letter at TSDR 41-43.

¹⁷ August 9, 2022 Examining Attorney's Reconsideration Letter at TSDR 48-52.

lamps and their fittings; LED light assemblies for automobiles, vehicle reflectors” in International Class 11 and “mirrors for vehicles, namely, vehicle sleeper mirrors, rearview mirrors, and vanity mirrors” in International Class 12;¹⁸

Registration No. 6398292 for the mark D DUSAREL and Design for, in relevant part “batteries, electric; battery jars” in International Class 9 and “rearview mirrors” in International Class 12;¹⁹

Registration No. 6566956 for the mark WINGSTAR and design for, in relevant part, “battery chargers; batteries for vehicles” in International Class 9; “motorcycle lights; LED light bulbs; headlights for vehicles; vehicle turn-signal light bulbs; tail lights for vehicles; vehicle reflectors; LED light strips for decorative purposes” in International Class 11; and “rear view mirrors; side view mirrors for vehicles” in International Class 12.²⁰

As a general proposition, third-party registrations that cover goods from both the cited registration and an Applicant’s application are relevant to show that the goods are of a type that may emanate from a single source under one mark. *See, e.g., Detroit Athletic Co.*, 128 USPQ2d at 1051; *Hewlett-Packard*, 62 USPQ2d at 1004; *In re Infiniti2ty Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d*, (unpublished), No. 88-1444 , 864 F.2d 149 (Fed. Cir. Nov. 14, 1988). Just as we must consider the full scope of the goods as set forth in the application and registration under consideration, we must consider the full scope of the goods described in a third-party registrations. *In re Country Oven*,

¹⁸ August 9, 2022 Examining Attorney’s Reconsideration Letter at TSDR 54-57.

¹⁹ August 9, 2022 Examining Attorney’s Reconsideration Letter at TSDR 64-67

²⁰ August 9, 2022 Examining Attorney’s Reconsideration Letter at TSDR 67-70.

Inc., 2019 USPQ2d 443903, at *9 (TTAB 2019). Because the benefits of registration are commensurate with the scope of the goods specified in the certificate of registration, a registration that describes goods broadly is presumed to encompass all goods of the type described. *Id.*

Applicant points to 18 pairs of identical or similar marks registered to different entities for “mirror for land vehicles” or the equivalent thereof on one hand, and batteries and battery chargers on the other,²¹ as evidence that such products are considered “not related goods” for likelihood of confusion purposes.²² These third-party registrations are of limited utility to demonstrate the lack of likely confusion because we lack the full context surrounding their registration. For example, we do not know whether any of the applicants/registrants negotiated consent agreements. Our decision-making is guided by the evidence in this record, which as discussed above, shows that the goods are related. “Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought.” *In re Int’l Watchman, Inc.*, 2021 USPQ2d 1171, at *30 (TTAB 2021) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982) and *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 160 USPQ 730 (CCPA 1969)).

This brings us to the similarity or dissimilarity of established, likely-to-continue trade channels and classes of consumers, the third *DuPont* factor. Applicant

²¹ July 7, 2022 Request for Reconsideration at TSDR 18-370.

²² Applicant’s Brief, p. 7; 6 TTABVUE 10.

essentially argues that the trade channels and consumers differ insofar as the owner of the cited mark, King of the Road Mirrors, Inc., allegedly operates in the auto parts sector whereas the consumers of Applicant's goods consist of auto makers that manufacture auto parts for their own vehicles sold to the public and not for separate re-sale to consumers.

We cannot assume, as Applicant argues, that Registrant's "mirrors for land vehicles" are restricted in this fashion. Likewise, we cannot assume that consumers of Applicant's identical auto parts are limited to automakers. Neither the registration nor the application contains restrictions as to the channels of trade or classes of purchasers. As such, the goods presumptively move in all normal trade channels and to the usual consumers that purchase such goods. *See Detroit Athletic Co.*, 128 USPQ2d at 1052 ("the registration does not set forth any restrictions on use and therefore cannot be narrowed by testimony that the applicant's use is, in fact, restricted to a particular class of purchasers") (citation omitted); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). The website evidence discussed above shows that goods of the types identified in both Applicant's application and the cited registration are sold in the same retail brick-and-mortar and online auto parts stores to the same classes of consumers. In other words, because the identified goods are unrestricted as to trade channels and classes of purchasers, we must presume that they travel in the ordinary trade and distribution channels for the goods and will be marketed to the same potential consumers which includes both members of the

general public seeking automotive aftermarket parts as well as automakers and auto repair shops. *See Cai*, 127 USPQ2d at 1801.

Because the scope of the registration Applicant seeks would be defined by the identification of goods and not by actual use, it is the identification of goods in the application and cited registration, and not their actual use in commerce, that we use as our guide:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom, 16 USPQ2d at 1787. For this reason, in the context of an ex parte appeal, the right to register a mark must be determined by how the goods are identified in the application and registration regardless of the manner of actual use. *See Detroit Athletic Co.*, 128 USPQ2d at 1051 ("The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration, and not on real-world conditions."); *see also Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 117 USPQ 213, 214 (CCPA 1958); *Blue Cross and Blue Shield Ass'n v. Harvard Cmty. Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990).

Accordingly, the related nature of the goods, trade channels and classes of purchasers of those goods weigh in favor of finding a likelihood of confusion.

D. Purchasing Conditions

“The fourth *DuPont* factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.’” *See Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *See Palm Bay Imps.*, 73 USPQ2d at 1695.

Applicant argues that the involved goods are generally both sold to “highly sophisticated automobile manufacturers, which would necessarily be discriminating as to source in selecting parts for manufacture of their vehicles,” and that in instances where the “purchases were made for the purpose of maintenance and repair of a vehicle, the purchase would likely be specific for a replacement of the original part for which there would be no likelihood of confusion.”²³

Applicant’s arguments are misplaced. The application and cited registration identify goods that are not restricted by target market, price or consumer sophistication. We must therefore assume that the types of buyers overlap to include sophisticated automakers with large-scale corporate procurement departments and auto shops with expertise in repair and maintenance, as well members of the general public ranging from the highly skilled auto aficionado to novice mechanic. “Board precedent requires the decision to be based ‘on the least sophisticated potential

²³ Applicant’s Brief, pp. 10-11; 6 TTABVUE 14-15.

purchasers.” *Stone Lion*, 110 USPQ2d at 1163. Accordingly, this *DuPont* factor is neutral.

III. Summary of the *DuPont* Factors

We have carefully considered all of the evidence made of record, as well as all arguments related thereto. Applicant has not shown that the cited mark is either commercially or conceptually weak. With identical marks and related goods marketed in the same trade channels to the same category of consumers exercising only ordinary care, consumers are not likely to understand that the goods emanate from different sources. These findings lead us to the conclusion that prospective consumers are likely to confuse the source of the involved goods.

Decision: The partial Section 2(d) refusal is affirmed, and applies to all goods in International Classes 9 and 11 with the exception of “batteries for electronic cigarettes” in International Class 9 and “electric lights for Christmas trees” in International Class 11. The goods subject to refusal will be deleted from the application, which will proceed with those items excluded from the refusal.