

This Opinion is not a
Precedent of the TTAB

Mailed: May 7, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Nauert

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Serial No. 85104423

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Kenya L. Williams of Fulwider Patton for Richard Nauert.

Susan R. Stiglitz, Trademark Examining Attorney, Law Office 109 (Dan Vavonese,
Managing Attorney).

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Before Quinn, Bucher and Mermelstein,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Richard Nauert filed, on August 10, 2010, an intent-to-use application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register the mark **NuArt Can Am** (in standard characters) for “automobiles and structural parts therefor; automobile chassis; automobile bodies” in International Class 12.¹

¹ The application also includes International Class 7, and the identification of goods reads as follows: “automobile parts, namely, automobile engine valve covers, engine parts in the nature of electronic fuel injection modules, intake manifolds, and engine management systems in the nature of electronic control modules that utilize input valves calculated from sensor devices to control the fuel mixture, amount of fuel, ignition timing, and idle speed of an internal combustion engine.” The examining attorney stated in her brief (p. 2) that the Section 2(d) refusal does not pertain to applicant’s goods in Class 7. Applicant owns Registration No. 4368899, issued July 16, 2013, for the mark **NU ART** (in standard characters) for Class 7 goods identified exactly as those in the present application.

The trademark examining attorney refused registration in Class 12 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark **CAN-AM** (in standard characters) for "land motor vehicles, namely, all terrain vehicles, motorcycles, three-wheeled motorized vehicles, scooters and structural parts therefor; engines for land vehicles, namely, all terrain vehicle engines, motorcycle engines, three-wheeled vehicle engines, scooter engines and structural parts therefor; motorcycles and parts therefor" in International Class 12² as to be likely to cause confusion.

When the refusal in Class 12 was made final, applicant appealed. Applicant and the examining attorney filed briefs.³ We affirm the refusal to register in Class 12.

Applicant initially points out that the examining attorney previously withdrew the Section 2(d) refusal and approved the mark for publication, but that "based on further review and consideration," the examining attorney reinstated the refusal. This circumstance, according to applicant, indicates that the Office recognizes that the cited registration is entitled to only a narrow scope of protection. Applicant also highlights the fact that registrant, when faced with a Section 2(d) refusal in its underlying application, specifically distinguished its goods from those of the then-existing cited registrations, which included the goods "automobiles and structural

² Registration No. 3686113, issued September 22, 2009.

³ Although applicant requested an oral hearing, it subsequently withdrew the request.

parts therefor.”⁴ In applicant’s words, “given that the cited Registrant distinguished its goods from “Automobiles and structural parts therefor” in its effort to obtain its registration, such distinction should still be applicable with regard to Applicant’s identified goods,” so that “the cited Registrant should not now be provided with a greater scope of protection than it deserves.” (Brief, p. 10). Applicant further argues that the marks are different in sound and appearance, and that the presence of NUART in its mark suggests “something new and creative.” Applicant also contends that its goods consist of clean sheet prototype sport cars for racing, and that these cars are custom-made for race car enthusiasts and are very expensive, with a minimum price of \$500,000. These goods are contrasted with registrant’s recreational vehicles that sell for prices as low as \$7,000. Thus, applicant states, its goods travel in different trade channels to sophisticated purchasers. Applicant additionally contends that the cited registration is entitled to a narrow scope of protection due to numerous third-party uses of “Can Am” in connection with motorized vehicles. In urging that the refusal to register be reversed, applicant introduced the following evidence: excerpts from the file wrapper of the cited registration; dictionary entries; a listing for “Can-Am” from Wikipedia; excerpts from applicant’s and registrant’s websites; excerpts from third-party websites; and the summary report of a Google search of the terms “Can Am” and “automobile.”⁵

⁴ Registrant obtained a consent agreement from the owner of the cited registrations (Reg. No. 2883129 for the mark CAN AM, and Reg. No. 3163329 for CAN-AM EXOTICS). Those cited registrations subsequently were cancelled for failure to file an affidavit of continued use under Section 8.

⁵ Applicant’s request for reconsideration is accompanied by certain documents related to the examination history of the present application. Such filings are superfluous inasmuch as

The examining attorney maintains that the marks are similar, and that consumers will view applicant's mark as a new or updated version of registrant's mark leading to a mistaken belief that applicant's goods originate from registrant. The goods are related, according to the examining attorney, as shown by third-party registrations of the same mark covering the types of goods involved herein, and excerpts from third-party websites showing that certain manufacturers produce automobiles, motorcycles, ATVs and scooters, and that certain retailers offer these types of motorized vehicles. The examining attorney points out that the respective identifications of goods are not restricted, but rather are broadly worded, and accordingly applicant's "real-world" distinctions between the goods are immaterial to the likelihood of confusion analysis.

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). 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 F.2d 1098, 192 USPQ 24 (CCPA 1976).

the entire application file is automatically of record. *See* TBMP §§ 1203.01, 1203.02(e) (2013). In addition, applicant unnecessarily attached to its request for reconsideration certain evidentiary documents that were previously submitted. *See In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires the Board to determine whether attachments had been properly made of record); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary).

We first direct our attention to the *du Pont* factor of the similarity/dissimilarity between the marks. 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, 1960 (Fed. Cir. 2005), quoting *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Applicant has taken the entirety of registrant’s mark CAN-AM (minus the hyphen which has no source-indicating significance)⁶ and merely added the term “NuArt” to form the mark **NuArt Can Am**. The addition of this term in applicant’s mark is insufficient to distinguish the marks, even though we recognize that applicant owns a registration for the mark NU ART. The salient fact is that both marks share the term CAN AM, and thus the marks are similar in appearance and sound. Although applicant correctly points out that purchasers would be more likely to view the first part of its mark as being the dominant portion of the mark, we find it just as significant in this case that the second portion of applicant’s mark is

⁶ A hyphen does not serve to distinguish two marks. *See, e.g., Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010), *aff’d mem.*, 2011 WL 5400095 (Fed. Cir. Nov. 9, 2011).

identical to the entirety of registrant's inherently distinctive mark. As to meaning, applicant contends that the term "Can Am" is suggestive of the sport of car racing, and that applicant's mark as a whole means that the goods "consist of innovative design or creation, and suggests a particular type of race car based upon a clean sheet design or the creation of an automobile product not derived from anything else." (Brief, p. 15). Although the presence of the term "NuArt" in applicant's mark gives it a somewhat different connotation, purchasers are just as likely to perceive applicant's mark as suggesting a new or innovative brand extension into automobiles of registrant's CAN-AM mark associated with motorcycles. In sum, in both cases, the term "Can Am" suggests Canadian American, and we find that the presence of the term "Can Am" in both marks outweighs the differences, and that the marks engender similar overall commercial impressions. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692 (affirming Board's holding that contemporaneous use of mark VEUVE ROYALE for sparkling wine and mark VEUVE CLICQUOT PONSARDIN for champagne is likely to cause confusion); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila likely to cause confusion); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (HEWLETT PACKARD and PACKARD TECHNOLOGIES create similar overall commercial impressions); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN and TITAN are more similar than they are different, and addition of applicant's

“product mark” VANTAGE to the registered mark would not avoid confusion); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY’S ACCU TUNE and design for automotive service stations, and ACCU-TUNE for automotive testing equipment is likely to cause confusion).

The similarity between the marks is a factor that weighs in favor of a finding of a likelihood of confusion.

We next direct our attention to the *du Pont* factor of the similarity/dissimilarity between the goods. It is not necessary that the respective goods be identical or competitive, or even that they move in 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 originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). 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).

We make our determination regarding the similarities between the goods, channels of trade and classes of purchasers based on the goods as they are identified in the application and registration, respectively. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir.

1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Applicant's identification of goods reads "automobiles and structural parts therefor; automobile chassis; automobile bodies;" registrant's identification reads "land motor vehicles, namely, all terrain vehicles, motorcycles, three-wheeled motorized vehicles, scooters and structural parts therefor; engines for land vehicles, namely, all terrain vehicle engines, motorcycle engines, three-wheeled vehicle engines, scooter engines and structural parts therefor; motorcycles and parts therefor." Likelihood of confusion must be found if there is likely to be confusion with respect to *any* item that comes within the identification of goods in the application or registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Applicant argues that there is a disparity between its clean sheet prototype sports cars for racing series and registrant's motorcycles and all-terrain vehicles. More specifically, applicant asserts that the goods "are different and non-competitive, as their application and utility serve different objectives." (Brief, p. 16). Applicant further states that "its automobiles are highly specialized, very expensive, and custom-made especially for racing." (Brief, p. 17). Applicant's arguments, based on the "real-world" premise that its goods are custom-made race cars, are ill founded. First, applicant's identification of goods reads "automobiles," not "custom-made race cars." As such, applicant's goods encompass all types of automobiles, including conventional passenger automobiles as well as race cars.

Likewise, registrant's "motorcycles" are presumed to include conventional ones used for every-day transportation, as well as for racing and recreation. Secondly, the evidence of record suggests that automobiles and motorcycles are related motor vehicles. Third-party website screen shots show that manufacturers, such as Honda and Suzuki, produce both automobiles and motorcycles under their respective marks. (Final Office action, April 17, 2012). The record also includes numerous use-based third-party registrations showing that the same entity has registered the same mark for goods of the types identified in the application and cited registration (i.e., automobiles and motorcycles). "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), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

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

Applicant also argues that the trade channels are different, and that the high cost of its goods, coupled with the sophistication of purchasers, ensures that confusion is unlikely to occur. As to these points, there is no restriction or limitation

on trade channels, price or sophistication of purchasers in either of the identifications of goods. Because there are no limitations as to channels of trade or classes of purchasers in the identifications of goods in the application and cited registration, it is presumed that applicant's and registrant's goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). As shown by the examining attorney's evidence, both automobiles and motorcycles may be sold through the same outlets. (*See* third-party websites showing that the same retailers may offer for sale both automobiles and motorcycles (Denial of Request for Reconsideration, 7/16/13)). Further, there are no price points in the identifications, so we must assume that the goods include relatively inexpensive automobiles and motorcycles. As to purchasers, we must assume that the potential purchasers of such goods would include ordinary consumers. In any event, even if we consider the purchase of an automobile or a motorcycle to be a fairly thoughtful decision made by sophisticated consumers, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and similar goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), *citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are

not infallible.”). *See also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the similarity between the marks and the goods sold thereunder outweigh any presumed sophisticated purchasing decision. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff’d*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

In view of the above, we find that the factors of similar trade channels and classes of purchasers weigh in favor of affirming the refusal to register. As to price of the goods and sophistication of purchasers, we find these factors to be neutral.

There are other factors that require our consideration. One avenue of applicant’s attack on the refusal relates to the commonly used and understood term “Can Am” as it relates to automobile racing. Applicant relies upon a Google search for the terms “Can Am” and “automobile” that returned over 3.1 million hits. Applicant submitted the first 50 hits (Exhibit L, Request for Reconsideration). In this connection applicant highlights the first result regarding a “rare 1977 Pontiac Lemans Can Am – 6.6[L] V8 Muscle Car.” In addition, a listing for “Can-Am” in Wikipedia recounts the history of the Can-Am (“Canadian-American”) sports car racing series (1966-1986). Applicant states that the evidence establishes “the common nature of the words CAN AM for use in connection with automobiles given the history of the words, as the words CAN AM, whether depicted with or without a

hyphen, have long been associated with the sport of car racing and the vehicles associated therewith” (Exhibit F, Request for Reconsideration). (Brief, p. 20).

The search report, in and of itself, is entitled to little probative value. These search results do not include sufficient text to show the context within which the term is used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011). While the search retrieved a large number of hits, this too is of very limited probative value. *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1153 n.1 (TTAB 2008). In any event, as pointed out by the examining attorney, many of the hits appear to refer to registrant’s mark and its goods sold under the mark CAN-AM.

Lastly, even assuming *arguendo* that registrant’s mark is weak, even a weak mark is entitled to protection against the registration of a similar mark for related goods. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). Accordingly, this factor is neutral.

Applicant also relies upon statements made by registrant while prosecuting its underlying application. Applicant essentially contends that given registrant’s argument about the differences between registrant’s goods and automobiles, that is, the very type of goods identified in applicant’s application, the examining attorney is in error when she cites the registration against the involved application. Although we may consider these comments as facts “illuminative of shade and tone in the total picture confronting the decision maker,” they cannot substitute for our reaching our own conclusion based on the evidentiary record in the present

application. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978); *see also Anthony's Pizza & Pasta Int'l, Inc. v. Anthonys Pizza Holding Co.*, 95 USPQ2d 1271, 1281 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010). In any event, comments made by registrant in 2005 do not necessarily reflect the current marketplace. Moreover, a prior, contrary statement of opinion, made on a legal issue in an unrelated proceeding, does not result in any sort of estoppel in the present appeal. The statements are not treated as admissions that the goods are not related; they certainly do not show that registrant has consented to the registration now sought by applicant. Also, what registrant argued to the USPTO to overcome the refusal to register based on the now-cancelled marks is of little value because the issue before us is the likelihood of confusion between registrant's mark and applicant's mark, not the third-party mark. *See Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984), *quoting Krug Vins Fins de Champagne v. Rutman Wine Co.*, 197 USPQ 572, 574-75 (TTAB 1977) ("The conflict here is between petitioner [appellee] and respondent [appellant] and not between petitioner and the world."); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 750 (TTAB 1986) ("another's prior use of a confusing similar mark for the same goods or services, may not be relied upon as a defense in opposition and cancellation proceedings."). The examining attorney is entitled to refuse registration of applicant's mark if she can show that the marks now involved are likely to be confused.

On a related point, applicant highlights the fact that the examining attorney withdrew the refusal and then reinstated it which, applicant contends, demonstrates that she “initially recognized the narrow scope of protection to which that and the other marks were entitled in approving the instant mark for publication.” (Brief, p. 10). “The existence of [third-party] registrations is not evidence of what happens in the marketplace 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); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). Further, a cancelled registration has no evidentiary value as to the scope of protection afforded to registrant’s mark, nor may we even presume that the cancelled registration was validly issued. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions” previously afforded to the registration). Although we have considered this aspect of the examination history of the present application, it is entitled to minimal probative value.

We have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We

conclude that purchasers familiar with registrant's land motor vehicles, including motorcycles sold under the mark **CAN-AM**, would be likely to mistakenly believe, upon encountering applicant's mark **NuArt Can Am** for automobiles, that the goods originated from or are associated with or sponsored by the same entity. Stated differently, purchasers are likely to mistakenly believe that applicant's mark **NuArt Can Am** for automobiles is a new, updated brand extension of registrant's mark **CAN-AM** for motorcycles and, thus, that registrant is the source of both types of goods.

Decision: The refusal to register in Class 12 is affirmed. The application will proceed in Class 7 only.