

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
July 2, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Palm Beach Motoring Accessories, Inc.

Serial No. 85264259

Leo Zucker of Law Office of Leo Zucker for Palm Beach Motoring Accessories, Inc.

Giancarlo Castro, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Bergsman, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Palm Beach Motoring Accessories, Inc. (“applicant”) seeks registration of the mark AUTOPIA CAR CARE, in standard characters and with CAR CARE disclaimed, for “On-line retail store services featuring products for cleaning, polishing and detailing motor vehicles” and “Providing on-line publications in the nature of instructional guides in the fields of cleaning, polishing and detailing motor vehicles.”¹

¹ Application Serial No. 85264259, filed March 11, 2011, based on first use dates of April 21, 1999.

The examining attorney refused registration of the mark under Section 2(d) of the Act, on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously-registered mark AUTOPIA in typed form for "automobile repair and service" as to be likely to cause confusion.²

After the refusal was made final, applicant appealed, and after its request for reconsideration was denied, applicant and the examining attorney filed briefs. We affirm the refusal to register.

Analysis

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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, 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."). We discuss each of the *du Pont* factors concerning which applicant or the examining attorney submitted argument or evidence. To the extent that any other *du Pont* factors for which no

² Registration No. 2046127, issued March 18, 1997; renewed.

evidence or argument was presented may nonetheless be applicable, we treat them as neutral.

Turning first to the marks, we must compare them “in their entirety 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). That is, we may not dissect the marks into their various components. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). The test 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 so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks (in this case car owners). *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Of course, one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature of a mark in determining its commercial impression. *In re Nat’l Data Corp.*, 224 USPQ at 751 (“There is nothing improper in stating that, for rational reasons, more or less weight

has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”); *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955).

In this case, the dominant element of applicant’s mark is the word AUTOPIA, which is the entirety of registrant’s mark. Indeed, applicant’s services relate to caring for (i.e. “cleaning, polishing and detailing”) cars, and accordingly applicant has disclaimed CAR CARE, which therefore has little significance in our likelihood of confusion determination. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data*, 224 USPQ at 752); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (BINION’S, not disclaimed word ROADHOUSE, is dominant element of BINION’S ROADHOUSE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Furthermore, AUTOPIA appears first in applicant’s mark, which also establishes that it is the dominant element of applicant’s mark. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *Palm Bay Imports Inc.*, 73 USPQ2d 1692; *Century 21 Real*

Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). In fact, applicant “concur[s] that its mark AUTOPIA CAR CARE and the cited registrant’s mark AUTOPIA are similar insofar as both marks have the word AUTOPIA in common.” Applicant’s Reply Brief at 1.

Applicant argues, however, that AUTOPIA is conceptually weak because it includes the word AUTO, which is the subject of applicant’s and registrant’s services, and commercially weak, because it is used and registered by several third parties for a variety of automobile-related products and services. Specifically, applicant introduced evidence that the mark shown below



is registered for “Lights for vehicles,”³ that *Wired* magazine has a recurring automobile-related column entitled “AUTOPIA Road to the Future,” that there is an Autopia Car Wash in California and that Autopia, Inc. in Lenexa, Kansas offers automobile repair services.⁴ While there is no evidence of the extent of use of AUTOPIA by these third parties, or the extent of consumers’ exposure to these marks, we assume for purposes of this decision that AUTOPIA is somewhat suggestive of, and that it is not entitled to an exceedingly “wide scope of protection”

³ Registration No. 3328421.

⁴ Applicant’s reliance on Registration No. 2969995 for the mark AUTOPIA for “Amusement park services” is misplaced because that mark is not used for automobile-related products or services.

for, automobile-related products and services. Applicant's Appeal Brief at 2. Therefore, in order to determine whether registrant's mark is nevertheless entitled to protection against registration of AUTOPIA CAR CARE for applicant's services requires us to compare applicant's services to registrant's.

Accordingly, turning to the services, it is settled that they need not be identical or even competitive in order to support a finding of likelihood of confusion. It is enough that the services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used, to a mistaken belief that applicant's and registrant's services originate from or are in some way associated with the same source or that there is an association between the sources of the services. *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1432 (TTAB 1993); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source of the services. *In re Rexel Inc.*, 223 USPQ at 832.

Here, applicant provides retail store services and publications online, all relating to "cleaning, polishing and detailing motor vehicles," while registrant provides "automobile repair and service." By definition, the service component of

registrant's "automobile repair and service," which is unlimited in scope, could encompass automobile "cleaning, polishing and detailing" services, which are closely and directly related to, and indeed the subject of, applicant's online services.⁵

Furthermore, the examining attorney introduced evidence that automobile repair and automobile cleaning and detailing, the subject of applicant's online services, are related. For example, the following marks are registered to different owners for automobile cleaning-related services on the one hand and automobile repair or maintenance services on the other: 06 GOLEO VI & Design (Registration No. 3081901); ROCKSTARS (Registration No. 3933577); A COUNTRY CLUB FOR CAR PEOPLE (Registration No. 3926921); ATACAMA (Registration No. 3378973); GEELY & Design (Registration No. 3587328); DAIMLER (Supplemental Registration No. 3871657); FIRST STOP AUTO CENTER & Design (Registration No. 3677669); AUTO STOP (Registration No. 3774067); COBBLESTONE & Design (Registration No. 3053651); LOVE YOUR CAR (Registration No. 3086600); DALLAS SPEED SHOP & Design (Registration No. 3241366); G & Design (Registration No. 3132912); CAR COSMETICS & Design (Registration No. 3243817); CAR PROS PLAZA ONE STOP AUTO CARE (Registration No. 4041079); and DENT RECON (Registration No. 4073747). Office Actions of September 15, 2011 and March 27, 2012. "Third-party registrations which cover a number of

⁵ While "automobile service" may often be understood to mean automobile repair or maintenance, registrant identifies "automobile repair" separately and "service" is an exceedingly broad term. *See e.g., CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 n. 3 (Fed. Cir. 1983) (where applicant's identification of goods is broad, "[i]t is proper to construe applicant's description of its goods in the manner most favorable to opposer."); *Hurst Performance, Inc. v. Torsten Hallman Racing, Inc.*, 207 USPQ 671, 674-75 (TTAB 1980).

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.” *See, In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998); *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).⁶ Similarly, the examining attorney introduced printouts from websites showing that Pep Boys, AC Delco, AutoZone, Mike & Henry’s Auto Service, Katy Auto Care, 5 Star Auto Spa, Urgent Care Automotive Repair, Five Star Auto Care, Neil’s Auto Repairs and Murphy’s Autocare offer automotive cleaning products or services on the one hand and automotive repair-related services on the other. Office Actions of September 15, 2011 and March 27, 2012. Finally, it does not escape notice that applicant submitted printouts from registrant’s website in connection with its office action response of August 24, 2011

⁶ Here, although the registrations only establish that automobile repair and automobile cleaning are related, and applicant does not directly offer automobile cleaning services itself, applicant’s identified services are so inextricably intertwined with automobile cleaning that these registrations are relevant. *See e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (finding “overlap” between “retail grocery and general merchandise store services” and furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (“a customer who attends a banquet which he knows is catered by the appellant would, when he encounters a food product in the grocery store under an almost identical mark, naturally assum[e] that it came from the catering firm”); *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (“consumers would be likely to believe that jewelry on the one hand and retail stores selling jewelry on the other emanate from or are sponsored by the same source ...”); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (“As we have said before there is no question that store services and the goods which may be sold in that store are related goods and services ...”).

which makes clear that in addition to “car repair services,” registrant offers “hand car wash” services.

Based on this evidence, and registrant’s unlimited identification of “automobile service,” which could, and in fact does encompass automobile cleaning services, we have no difficulty finding that the parties’ services are related, and closely so. Furthermore, the evidence of record establishes that automobile repair-related services travel in the same channels of trade and are sold to the same classes of consumers as automobile cleaning-related services. These factors both weigh in favor of a finding of likelihood of confusion.⁷

In fact, the parties’ services and channels of trade are more than close enough that confusion is likely if applicant and registrant were to both use AUTOPIA, notwithstanding our assumption, for purposes of this decision, that AUTOPIA is suggestive. In other words, while registrant’s mark may not be entitled to an exceedingly broad scope of protection, it is entitled to protection against applicant’s very similar and partially identical mark used for closely-related services. Furthermore, the evidence establishes that the descriptive and disclaimed term CAR CARE in applicant’s mark could just as easily refer to registrant’s services as applicant’s, and registrant is entitled to use its mark with CAR CARE, which would make the marks identical.

⁷ Applicant points out that its customers are “car enthusiasts” who use the products applicant offers online to clean their own cars. We do not believe this makes confusion unlikely, because just as these “car enthusiasts” could have a need for registrant’s repair services, registrant’s customers could rely on registrant for car repairs while simultaneously relying on the products applicant makes available to clean their own cars.

Finally, while applicant is unaware of any instances of actual confusion despite concurrent use of applicant's and registrant's marks for 14 years, that does not mean that confusion is unlikely. In fact, "[t]he test is likelihood of confusion not actual confusion ... It is unnecessary to show actual confusion in establishing likelihood of confusion." *Weiss Associates*, 902 F.2d at 1546, 14 USPQ2d at 1842-43. The Court of Appeals for the Federal Circuit has observed "[a] showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, especially in an ex parte context." *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 (internal citation omitted). While 14 years is not an insignificant amount of time, there is no evidence as to the amount of use and whether there has been any meaningful opportunity for confusion to occur. We therefore find this factor to be neutral.

As stated, in the absence of relevant evidence or argument, we find that the remaining likelihood of confusion factors are also neutral.

Conclusion

We have considered all of the evidence of record as it pertains to the relevant *du Pont* factors, including applicant's arguments and evidence, even if not specifically discussed herein. In view of our findings that the marks are quite similar, the services related and the channels of trade overlap, we find that use of applicant's mark is likely to cause confusion with the cited registered mark as applied to registrant's goods. To the extent that applicant's arguments raise any

Serial No. 85264259

doubt concerning the likelihood of confusion, we resolve any such doubt in registrant's favor. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe*, 223 USPQ at 1290.

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Act is affirmed.