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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Pennsylvania Independent Oil and Gas Association

Serial No. 85514044

David V. Radack of Eckert Seamans Cherin & Mellott, LLC, for The Pennsylvania Independent Oil and Gas Association.

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(Michael W. Baird, Managing Attorney).

Before Quinn, Ritchie, and Masiello, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

The Pennsylvania Independent Oil and Gas Association ("applicant") filed an application to register the mark BLUE IS THE NEW GREEN, in standard character form, for services identified as "trade association services, namely, promoting the interests of Pennsylvania independent oil and natural gas producers, marketers, service companies and related businesses,"¹ in International Class 35. The Trademark Examining Attorney

¹ Serial No. 85514044, filed January 11, 2012, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), claiming first use and first use in commerce in April 2010.

refused registration of applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the registered mark BLUE IS THE NEW GREEN, in standard character form, for "motor oils; lubricants for motor vehicles,"² in International Class 4, that when used on or in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive.

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs. For the reasons discussed herein, the Board affirms the refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a 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

² Registration No. 3846184, issued September 7, 2010.

differences in the essential characteristics of the goods and differences in the marks"). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. The marks are identical standard character marks, and are, accordingly, identical in appearance and sound. We find that they also convey the identical commercial impression of goods or services in the oil and gas industry that purport to be more environmentally friendly.

Accordingly, we find that the first *du Pont* factor weighs strongly in favor of finding a likelihood of confusion.

The Goods and Services and Channels of Trade

In determining the similarity or dissimilarity of the goods and services, we note that the more similar the marks at issue, the less similar the goods and/or services need to be for the Board to find a likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). When the marks are identical, as they are here, it is only necessary that there be a viable relationship between the goods or services to support a

finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). In any event, the goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods and/or services are related in some manner or that some 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 or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each of the parties' goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). It is well recognized that confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Applicant's identified services are "trade association services" that include "promoting the interests of Pennsylvania independent oil and natural gas producers, marketers, service companies and related businesses." We read this, as we are constrained to do, to include promoting the interests of those who produce any type of oil, and those related companies that

offer or market oil products, including "motor oils" such as that included in the identification of goods in the cited registration. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). Accordingly, based on a plain reading of the identifications themselves, we find applicant's "trade association services" to be related to the "motor oils; lubricants for motor vehicles" in the cited registration. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding likelihood of confusion "as a matter of law" based on a comparison of the parties' identifications, although they involved different goods and services within the fields of technology); *see also Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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 the sales of goods are directed." (citations omitted)); *see also In re Iolo Technologies LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010) ("Here, based on the identifications themselves, we find that applicant offers a product that is complementary in function and purpose

to the software installation, maintenance and updating services offered by registrant.") We note, too, the statement in applicant's brief that:

While it true that Applicant's trade association is open to producers of oil products, it is respectfully submitted that Applicant's members would clearly distinguish between a trade association and a producer of motor oils.
(appl's brief at unnumbered 1).

This argument as to sophistication and consumer care does not deny that the goods and services are related, but rather admits that those who "produce," or create, "oil" products, such as the "motor oils" identified in the cited registration, would be potential members of applicant's "trade association."

Regarding the channels of trade, there is nothing that prevents registrant's "motor oils" from being "promoted" by the "trade association services" offered by applicant. Furthermore, consumers of oil, who purchase registrant's goods, are also one of the likely target audiences for applicant's promotion services.

Accordingly, we find that these *du Pont* factors also weigh in favor of finding a likelihood of consumer confusion.

Consumer Sophistication

Applicant urges us to consider consumer sophistication as a factor. However, applicant has submitted no evidence that either its consumers or those of registrant would be

sophisticated. Furthermore, as our precedent dictates, even sophisticated buyers are not immune from source confusion where, as here, the marks are identical. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949 (Fed. Cir. 2000).

Balancing the Factors

In view of our findings that the marks are identical, the goods and services are related, and the goods and services move in the same or similar channels of trade, we find that applicant's mark BLUE IS THE NEW GREEN for "trade association services, namely, promoting the interests of Pennsylvania independent oil and natural gas producers, marketers, service companies and related businesses" is likely to cause confusion with the registered mark BLUE IS THE NEW GREEN for "motor oils; lubricants for motor vehicles."

Decision: The refusal to register is affirmed.