

This Opinion is Not a
Precedent of the TTAB

Mailed: November 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Becklean
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Serial No. 85748394
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Lauri S. Thompson of Greenberg Traurig, LLP
for David Becklean.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 118,
Thomas G. Howell, Managing Attorney.

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Before Bucher, Wellington, and Ritchie,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

David Becklean (“Applicant”) seeks registration on the Principal Register of the standard character mark **TOKYO MOTORS** for “business services, namely, retail store services featuring automobile parts, accessories, and aftermarket parts” in International Class 35.¹ Applicant has disclaimed exclusive use of the word MOTORS.

¹ Application Serial No. 85748394 was filed on October 8, 2012, based upon an allegation of a *bona fide* intent to use the mark in commerce, under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's mark based on a likelihood of confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the following two registered marks:

Tokyo Rods (in standard characters) for, *inter alia*,

“online retail and wholesale store services featuring Japanese automobile parts and accessories; advertising of Japanese automobiles and parts for Japanese automobiles for others via the Internet; providing Japanese automotive information via a global computer network relating to vehicles for sale and vehicle parts and accessories” in International Class 35;² and



for

“online retail and wholesale store services, mail order services, electronic catalog services, and online wholesale distributorships featuring Japanese automobile parts and accessories; advertising of Japanese automobiles and parts for Japanese automobiles for others via the Internet; providing consumer information about Japanese vehicles via a global computer network relating to vehicles for sale, availability of vehicle parts and accessories, dealers and manufacturers, automotive services and service providers, as well as trade information about general industry news” in International Class 35.³

The two cited registrations are owned by the same entity and the word RODS is disclaimed in each.

² Registration No. 3741270 issued on January 19, 2010.

³ Registration No. 3848477 issued on September 14, 2010.

After the refusal became final, Applicant appealed and filed a request for reconsideration which was denied. Applicant and the Examining Attorney filed briefs.

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 or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 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).

In this proceeding, we focus our analysis on the first of the two cited marks vis-à-vis Applicant's mark because this registered mark, appearing in standard characters and without the design, bears the closest resemblance to Applicant's mark. The services covered by the two registrations are also essentially the same.

Similarity of the Marks

We first compare the marks and, in doing so, consider them 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 (Fed. Cir. 2005).

The Examining Attorney argues that the dominant element of each mark is the initial term, TOKYO, and the respective secondary terms in each mark, MOTORS and RODS, have less significance because they are descriptive and, accordingly, have been disclaimed. Applicant, on the other hand, references the “anti-dissection rule” and argues that the additional term in each of the two marks suffices for purposes of distinguishing them. Specifically, Applicant argues that his use of the term MOTORS “brings to mind an entirely different mental picture than the term RODS.” Brief, p. 7. According to Applicant, the term “RODS ... is short for ‘Hotrods’ and conveys a mental image of ‘souped up’ cars with many aftermarket parts that oftentimes significantly change the appearance and design of the hot rod from its original state.” *Id.*

Applicant is correct that the anti-dissection rule dictates that marks must be considered in their entireties, including any disclaimed portions of marks. *See, e.g., In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992). However, as the Examining Attorney pointed out, it is also well-settled that disclaimed, descriptive matter generally has less significance in likelihood of confusion determinations. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)). *See also, Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re National Data Corp.*, 224 USPQ at 752 (“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”); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); and *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark's commercial impression”).

Keeping the aforementioned principles in mind, we agree with the Examining Attorney in his assessment that the term TOKYO is dominant in each mark and, when the marks are considered in their entirety, they remain very similar based on this common element. In addition, as the first word in each mark, purchasers are more inclined to focus on TOKYO. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered”). The marks will also obviously be similar in sound and appearance based on the shared, initial term TOKYO and differing only with respect to the latter terms.

As to the commercial impressions and connotations of the marks, Tokyo is the capital of Japan and, thus in connection with retail services featuring automotive parts, is strongly suggestive that Japanese automotive parts or after-market parts for Japanese cars may be purchased from either Applicant or Registrant. We disagree with Applicant’s contention that the combination of TOKYO with the respective, disclaimed terms, MOTORS and RODS, creates two very different commercial impressions, particularly in the manner described by Applicant in his brief. That is, while “rods” may conjure the term “hotrod” or a vehicle modified for speed, the mark TOKYO RODS remains suggestive of a retail automotive parts and

accessories source, albeit one with an emphasis on Japanese cars and performance. Likewise, Applicant's TOKYO MOTORS will be understood by consumers as indicating a retail source for Japanese automobile parts and accessories.

In sum, we find the respective marks to be very similar in sound, appearance, and meaning. Accordingly, this factor strongly favors a finding of a likelihood of confusion.

Strength or Weakness of the Term 'Tokyo'

Applicant does not argue that the common element, TOKYO, is diluted in use by third-parties or that it is otherwise weak and, thus, should not be considered a strong point of similarity between his mark and that of Registrant. Rather, he curiously argues that "the relevant field is crowded with registered marks utilizing the term 'MOTORS' for retail services related to sales of automobiles and automobile parts and accessories." Brief, p. 11. This argument actually supports a finding of a likelihood of confusion because it illustrates why consumers are more likely to focus on the shared term TOKYO. In other words, based on his argument, consumers will likely overlook the more-diluted term MOTORS and perceive TOKYO as the more distinctive and source-identifying term, bringing it closer to Registrant's mark.

We do not hold this argument against Applicant in our analysis. As already discussed, we have determined that TOKYO is the dominant element of each mark and this finding was made irrespective of Applicant's argument. Furthermore, for sake of clarity, we note that the record does not demonstrate that others are using

the term TOKYO in connection with retail services featuring automobile parts and accessories. Accordingly, the strength or weakness of the common element is an issue that remains neutral in our analysis.

Similarity of the Services Described in the Application and Registration

We turn now to the *du Pont* factor involving the relatedness of the services and find them to be very closely related. Both Applicant and Registrant offer retail services featuring automobile parts and accessories. The fact that Registrant's retail services are described as featuring Japanese automobile parts and accessories is of no consequence for purposes of distinguishing the services because Applicant's **TOKYO MOTORS** retail services as recited are broad enough to include the sale of Japanese automobile parts and accessories. Likewise, while Applicant's retail services will be offered in a "brick-and-mortar" store and Registrant's services are rendered online, such a distinction takes little away from the fact that both are selling automobile parts and accessories. We further note that Applicant's recitation of services does not actually exclude the possibility that his retail store services will be rendered online. In this regard, it would not be unheard of for a brick-and-mortar retail store to also have a website featuring the same automobile parts and accessories. To this point, the Examining Attorney has submitted approximately twelve use-based, third-party registrations for marks covering both "retail" and "online retail" store services featuring automotive parts and accessories.⁴ These registrations are not evidence that the marks are actually in use, but they help

⁴ Attached to Office Action issued on September 8, 2013.

show that the services may emanate from a common source under the same mark. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Accordingly, this factor strongly favors a finding of a likelihood of confusion.

Trade Channels, Care in Purchasing and Classes of Consumers for the Goods

Because the retail services of Applicant and Registrant feature the same goods, *i.e.*, automotive parts and accessories, they will be offered to the same class of consumers, namely, those interested in purchasing automotive parts and accessories. We further note that automotive parts run the gamut as to price, from relatively inexpensive, *e.g.*, spark plugs, windshield wipers, etc., to considerably more expensive parts, *e.g.*, transmissions, engines, etc. Although our comparison is of retail automotive parts services (online retail versus in-store) and not the goods being sold, the fact that automotive parts may be relatively inexpensive is relevant because consumers may impulsively purchase inexpensive auto parts online that they have previously purchased in-store. In other words, consumers will not necessarily exercise any higher level of care in choosing their sources (online versus in-store) for these inexpensive parts. This increases the likelihood that consumers may purchase automotive parts online from Registrant's website mistakenly believing that the website is associated with Applicant's physical store, or the reverse.

Applicant argues that confusion is unlikely based on "differences between the marketing channels utilized and target customer base for each mark." Brief, p. 10. In essence, Applicant asserts that he will be advertise his mark only in connection

with “new automobile parts and accessories” whereas Registrant’s services are “actually classified listing services where visitors to the site can buy and sell used car parts and accessories specifically for hot rod and tuner cars from one another.” *Id.* This argument, however, is premised on a distorted or limited reading of Registrant’s recitation of services. The law is clear that our analysis must be based on a full reading of Applicant’s and Registrant’s recitations of services and any asserted limitations thereto, based on extrinsic evidence will not be entertained. See *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1637 (TTAB 2009); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (question of likelihood of confusion is determined based on the description of the services stated in the application and registrations at issue and may not be limited by extrinsic evidence).

Accordingly, the *du Pont* factors involving trade channels for retail automotive parts and accessories services, provided online or in-store, and classes of consumers to whom they are offered, favor finding a likelihood of confusion.

Conclusion

We have carefully considered all of the evidence and arguments of record relevant to pertinent *du Pont* likelihood of confusion factors. In summary, we find that given the services involve retail services featuring automobile parts, traveling in the same channels of trade and being offered to the same classes of consumers, there is a likelihood of confusion as to the source of these services when they are being offered under the respective marks, TOKYO MOTORS and TOKYO RODS.

Decision: The likelihood of confusion refusal to register Applicant's mark is affirmed.