

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Petroleum Service Company
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Serial No. 85904470
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Camille M. Miller of Cozen O'Connor,
for Petroleum Service Company

Zachary R. Sparer, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

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Before Bergsman, Shaw and Kuczma,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Petroleum Service Company (“Applicant”) seeks registration on the Principal Register of the mark BLUESKY LUBRICANTS (in standard characters) for

Lubricating oils, food-grade lubricants, lubricants for industrial machinery, compressor oils and lubricants, gear and bearing oils and lubricants, lubricants for hydraulic systems, in International Class 4.¹

Applicant disclaimed the exclusive right to use the word “lubricants.”

¹ Application Serial No. 85904470 was filed on April 15, 2013, based upon Applicant’s claim of first use anywhere on June 23, 2012 and use in commerce on September 14, 2012.

The Trademark Examining Attorney has 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 previously registered mark BLUE SKY for "chemical additives for the after-treatment of exhaust gas, in particular chemical additives for reducing nitrogen oxides in exhaust gas from diesel engines; chemicals used in industry, in particular oil binders, anti-freezing agent, road salt," in Class 1, as to be likely to cause confusion.

Our determination under Section 2(d) is based on an analysis of all of the 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 Co., 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 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"). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

A. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound,

connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, “finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar.’” *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (citations omitted). *See also In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that “[t]he 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). *See also San Fernando Electric 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), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant’s mark is BLUESKY LUBRICANTS. The dominant element of Applicant’s mark is the term BLUESKY because the word “lubricants” is descriptive and has been disclaimed. 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 a consideration of the marks in their

entireties. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting*, *In re Nat'l 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, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001).

The significance of the term “BLUESKY” as the dominant element of Applicant’s mark is further reinforced by its location as the first part of the mark. *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). *See also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

The term BLUESKY in Applicant’s mark consists of two ordinary words, namely, “Blue” and “Sky” which have been combined to form the single term

BLUESKY. The combination of the two English words is apparent to any reasonable person. *See In re Cox Enters. Inc.*, 82 USPQ2d 1040, 1044 (TTAB 2007) (THEATL is the equivalent of THE ATL); *In re Wells Fargo & Co.*, 231 USPQ 95, 96-97 (TTAB 1986) (EXPRESSERVICE is the equivalent of EXPRESS SERVICE); *In re U. S. Steel Corp.*, 225 USPQ 750 (TTAB 1985) (SUPEROPE held equivalent in terms of purchaser impressions to “super rope”). The presence or absence of a space in the terms BLUESKY and BLUE SKY is of little significance in our comparison of the marks. *See Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) (hyphen did not distinguish MAGNUM from MAG-NUM); *Charrette Corp. v. Bowater Commc’n Papers Inc.*, 13 USPQ2d 2040, 2042 (TTAB 1989) (PRO-PRINT is similar to PROPRINT). *Goodyear Tire & Rubber Co. v. Dayco Corp.*, 201 USPQ 485, 489 n.4 (TTAB 1978) (“Fast-Finder” with hyphen is in legal contemplation substantially identical to “Fastfinder” without hyphen).

In view of the foregoing, we find that the marks are very similar in terms of appearance, sound, connotation and commercial impression.

B. The similarity of dissimilarity and nature of the goods.

Having found that Applicant’s mark is very similar to Registrant’s mark, we turn to the similarity or dissimilarity and nature of Registrant’s “chemical additives for the after-treatment of exhaust gas, in particular chemical additives for reducing nitrogen oxides in exhaust gas from diesel engines; chemicals used in industry, in particular oil binders, anti-freezing agent, road salt” and Applicant’s lubricants.²

² “Lubricant” is defined as “a substance, as oil or grease, for lessening friction, esp. in the working parts of a mechanism.” **THE AMERICAN HERITAGE DICTIONARY OF THE**

It is not necessary that these goods be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. *See In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Melville Corp.*, 18 USPQ2d 1386, 1387 (TTAB 1991). Moreover, the greater the degree of similarity between Applicant's mark and the registered mark, the lesser the degree of similarity between Applicant's goods and Registrant's goods is required to support a finding of likelihood of confusion. *In re Opus One, Inc.*, 60 USPQ2d at 1815; *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). Where, as in this case, the Applicant's mark is very similar to Registrant's mark, there need only be a viable relationship between the goods to find that there is a likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source"); *In re Concordia Int'l Forwarding Corp.*, 222 USPQ2d at 356.

ENGLISH LANGUAGE (UNABRIDGED), p. 1142 (2nd ed. 1987). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We focus our analysis on Registrant’s “chemical additives for the after-treatment of exhaust gas, in particular chemical additives for reducing nitrogen oxides in exhaust gas from diesel engines” because Applicant explained that the goods in the cited registration are “a diesel fuel exhaust fluid designed to meet the needs of all new 2010 diesel engine powered vehicles” that “reduces nitrogen oxide emissions by 90% and improves fuel efficiency by 5%.”³ We may use extrinsic evidence to determine what the description of goods means. *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990). Once the meaning of the description of goods is established, we analyze the goods based on the description of goods in the application and registration. *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Trademark Examining Attorney introduced copies of numerous use-based, third party registrations comprising both diesel fuel additives and lubricants.⁴ Third-party registrations which individually cover a number of different goods that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB

³ October 11, 2013 response to Office action derived from Registrant’s website. See also Applicant’s Brief, p. 12. *See also* the DA Lubricant company website (dalube.com) and the Peak website (peakauto.com) explaining how their products help to reduce NOx exhaust into harmless nitrogen and water vapor. May 1, 2014 Office action.

⁴ July 31, 2013 and October 21, 2013 Office actions.

1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).⁵

The registrations listed below are representative.

Mark	Reg. No.	Goods
NAPA	1754707	Anti-gel and conditioner additive for diesel fuel; automotive lubricants
NEXOLUB	3616561	Chemical engine treatments and additives for engine oils, gasoline and diesel fuels; lubricating oil, lubricating oil for motor vehicles, automotive lubricants
	3846373	Chemical engine treatments and additives for engine oils, gasoline and diesel fuels; automotive lubricants
BTM	4092162	Chemical engine treatments and additives for engine oils, gasoline and diesel fuels, transmission fluids and cooling systems; automotive lubricants; all-purpose lubricants; lubricating oil for motor vehicle engines
SEA FOAM	4220549	Moisture emulsification for gas, diesel fuel, engine oil, power steering fluid, hydraulic fluid and transmission fluid; automotive lubricants
PRODIGY	4189853	Diesel fuel additive to prevent gelling, diesel fuel additive conditioner, diesel fuel additive treatment; automotive lubricants, motor oils

The Trademark Examining Attorney also introduced excerpts from websites listed below to show that the goods of both the Applicant and Registrant emanate from a single source.⁶

1. STP (stp.com)

⁵ We did not include the entire description of goods for each registration. We have listed only the goods relevant to this appeal.

⁶ July 31, 2013, October 21, 2013, and May 1, 2014 Office actions.

This website promotes the sale of STP fuel additives to maximize fuel efficiency such as STP Diesel Fuel Injector Treatment and STP Oil Treatment to help protect against engine wear.

2. Pennzoil (pennzoil.com)

This website advertises PENNZOIL engine oils and PENNZOIL lubricants for a variety of applications.

3. Valvoline (valvoline.com)

This website advertises VALVOLINE motor oil, including diesel motor oil, and VALVOLINE fuel additives, including diesel fuel treatments.

4. Archer Lubricants (archeroil.com)

This website advertises the sale of ARCHER diesel engine oils with additives to enhance performance and improve emissions, as well as a full line of lubricants for agricultural and industrial needs.

5. Q8 Oils (q8oils.com)

This website advertises Q8 “lubricants to suit every type of vehicle,” including diesel engines, and hydraulic oil, transmission oil, and lubricants for industrial applications.

6. D-A Lubricant Company (dalube.com)

This website advertises the sale of DEFendal Diesel Exhaust Fluid, “a urea-based fluid designed specifically for use in SCR (Selective Catalytic Recovery) system to reduced NOx emissions,” as well as gear oils.

7. John Deere (deere.com)

This website advertises the sale of JOHN DEERE diesel exhaust fluid for selective catalytic reduction, as well as JOHN DEERE engine oils.

8. Peak (peakauto.com)

This website advertises the sale of PEAK BLUE DEF diesel exhaust fluid to help “convert NOx into nitrogen gas and water vapor, as well as PEAK motor oil and automotive gear oils.

9. Scott (scottpetroleuminc.com)

This website advertises the sale of SCOTT diesel exhaust fluid “to change the Oxides of Nitrogen (NOx) emissions in diesel fuel exhaust to nitrogen and water vapor,” as well as SCOTT lubricants for machine tools, planes, automobiles, tractors, trucks, and trains.

Applicant argues that the goods of Applicant and Registrant are “distinct” and that consumers would not expect them to emanate from the same source.⁷ While the goods are different, the evidence shows that the goods in Applicant’s description of goods and the goods in Registrant’s description of goods are types of goods that may emanate from the same source.

In view of the foregoing, we find the goods are related.

C. Established, likely-to-continue channels of trade and classes of consumers.

Applicant argues that the goods at issue move through different channels of trade.

The channels of trade in which Applicant’s and Registrant’s goods are offered are sufficiently distinct to

⁷ Applicant’s Brief, p. 12.

obviate a likelihood of confusion among consumers. Applicant's goods are marketed to the industrial, commercial, and manufacturing sections for use with industrial machinery used in the processing of food. In contrast, Registrant's goods are for use in automobile/trucks and are marketed and sold to the automotive/trucking industry.

The respective goods are each sold through each parties' [sic] distributors. Applicant's goods are sold through an exclusive distributorship relationship with Petroleum Service Company, are focused on industrial uses and consumers requiring lubricants for industrial machinery. In contrast, Registrant's goods are sold through a network of authorized dealers that mainly focus on providing goods and services to the automotive/trucking industry. While of these distributors might offer lubricants, these lubricants are focused on the automotive/trucking industry. In contrast, Applicant's goods are for industrial use and in connection with industrial machinery.⁸

However, because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the cited registration or Applicant's application, it is presumed that Registrant's goods and Applicant'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 Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1437 (TTAB 2014). In other words, we must give full sweep to the description of goods and the modes of distribution and we cannot read any limitations into the description of goods. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). For example, Applicant's "lubricating oils" are

⁸ Applicant's Brief, p. 14.

not restricted to industrial use. Accordingly, Applicant's "lubricating oils" is broad enough to encompass motor oil and diesel oil and may be sold in the same outlets and to the same consumers that purchase Registrant's diesel fuel additives.

D. The number and nature of similar marks in use on similar goods.

Applicant contends that "Blue Sky" marks are weak and diluted "as it is highly suggestive of environmental [sic] related goods and services, and diluted given the large number of third party [sic] uses of similar marks in connection with goods and services ... to connote the ideas and feelings such as 'pollution free', 'environmentally friendly', 'clear', 'clean', etc."⁹

To corroborate this contention, Applicant submitted excerpts from the websites listed below:¹⁰

1. BLUE SKY BIOFUELS (blueskybiofuels.com) a website advertising biofuels. Retail sales were suspended because the company did not have any fuel to sell.

2. BLUE SKY Clear Air (blueskycleanair.com) a website advertising the sale of GREENSKY fuel conditioner for reducing emissions.

3. BLUE SKY Environmental, Inc. (blueskyenvironmental.com) a website for an air emissions testing service.

4. BLUE SKY Consulting Group (blueskyconsultinggroup.com) a website for a consulting firm in the field of fiscal and economic issues.

5. BLUESKIES Environmental Associates, Inc. (blueskiesassociates.com) a website for an environmental consulting firm.

⁹ Applicant's Brief, pp. 4 – 5.

¹⁰ April 18, 2014 response to Office action.

6. The Rocky Mountain Power Blue Sky Program (rockymountainpower.net) for selling renewable energy.

Applicant also submitted a copy of Registration No. 4325674 for the mark WE DEFEND BLUE SKIES! for “urea based solution used in the treatment of engine emissions.”¹¹

The evidence demonstrates that the term “Blue Sky” is suggestive of an environmentally friendly product. However, none of the third-party uses are related to the goods of Applicant or Registrant and there is only one other registration for a “Blue Sky” mark – WE DEFEND BLUE SKIES! The existence of one arguably similar mark on the Register should not aid Applicant in registering another confusingly similar mark. *In re Delbar Prods., Inc.*, 217 USPQ 859, 861 (TTAB 1981).

Applicant argues that its telescoping of the words “Blue” and “Sky” and the addition of the word “Lubricants” is sufficient to alleviate any likelihood of confusion citing as support *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150 (TTAB

¹¹ October 11, 2013 Office action and April 18, 2014 Office action. We did not consider the registrations for the SKY BLUE marks, SKY marks without a “Blue” prefix, or BLUE marks without a “Sky” suffix because those marks engender different commercial impressions.

We did not consider copies of pending applications because a pending application is competent to prove only that the application was filed. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

Also, we did not consider the list of registrations from the Trademark Electronic Search System because the list did not include the goods and it included the words “Blue” and “Sky” in any order. *Nat’l Fidelity Life Ins. v. Nat’l Ins. Trust*, 199 USPQ 691, 694 n.5 (TTAB 1978) (list of registrations without goods and services and other relevant information “has no probative value”).

2012).¹² However, *Hartz* is inapplicable because in that case the third-party use of the term GRAND HOTEL for identical services was overwhelming. In this case, the third-party use is far afield and not nearly as extensive as in *Hartz*.

E. Balancing the factors.

Because the marks are similar, the goods are related, and the goods move in the same channels of trade and are sold to the same classes of consumers, we find that Applicant's mark BLUESKY LUBRICANTS for "lubricating oils, food-grade lubricants, lubricants for industrial machinery, compressor oils and lubricants, gear and bearing oils and lubricants, lubricants for hydraulic systems" is likely to cause confusion with the registered mark BLUE SKY for "chemical additives for the after-treatment of exhaust gas, in particular chemical additives for reducing nitrogen oxides in exhaust gas from diesel engines; chemicals used in industry, in particular oil binders, anti-freezing agent, road salt."

Decision: The refusal to register Applicant's mark BLUESKY LUBRICANTS is affirmed.

¹² Applicant's Brief, pp. 8 – 9.