

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 17, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re DIYAUTOFTW LLC
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Serial No. 87330708
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John P. Fredrickson of Boyle Fredrickson SC,
for DIYAUTOFTW LLC

Odessa Bibbins, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.

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Before Mermelstein, Gorowitz and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

DIYAUTOFTW LLC (“Applicant”) seeks registration on the Principal Register of



the mark DIY AUTO and design, displayed as , for

Providing an Internet website that features information
about automotive maintenance and repair service in
International Class 37.¹

¹ Application Serial No. 87330708 was filed on February 9, 2017, based upon Applicant’s claim of first use anywhere at least as early as November 19, 2015, and use in commerce at least

The Trademark Examining Attorney has refused registration of Applicant's mark 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 services, so resembles the previously registered mark DIY AUTO REPAIR SHOPS and design:



for "repair of automobiles, namely, do-it-yourself vehicle repair shop" in International Class 37,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

as early as January 7, 2016. DIY AUTO is disclaimed. The mark is described as follows: "The mark consists of a light blue shield outlined in black with the black letters 'DIY' in caps, lined in white, printed above 'AUTO' in black, in smaller caps, centered on a white diagonal stripe, with a white nut lined in black centered on the lower portion of the shield." The colors light blue, black and white are claimed as a feature of the mark.

² Registration No. 4540752 issued on the Supplemental Register on May 27, 2014, with a disclaimer of the words DIY AUTO REPAIR SHOPS. The mark is described as follows: "The mark consists of the orange letters 'diy' featuring a white inside outline and outer royal blue outline with the tail of the 'y' underlining the letters 'diy' and containing the word 'AUTO' in royal blue set in a royal blue hexagon figure as a background containing the word 'REPAIR SHOPS' in white below the tail of the 'y.' The royal blue hexagon figure features an orange outer border except for the top curved portion." The colors orange, royal blue and white are claimed as a feature of the mark.

I. Applicable Law

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *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.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within the *du Pont* list, only factors that are “relevant and of record” need be considered). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”).

A. Relatedness of the Services

We must make our determination under this *du Pont* factor on the services as they are identified in the application and registration. *See In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). The identified services need not be identical; rather, “likelihood of confusion can be found ‘if the respective goods [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same

source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The services identified in the application and registration are clearly complementary on their faces, as Applicant provides an Internet website featuring information about automotive maintenance and repair services, and Registrant provides a do-it-yourself vehicle repair shop. Applicant does not dispute that the services rendered under the marks are closely related. This *du Pont* factor weighs in favor of a finding of likelihood of confusion.

B. Comparison of the Marks/Strength of Registrant’s Mark

We must compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*, 177 USPQ at 567); *see also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). In comparing the marks, “[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.*, 101 USPQ2d at 1721 (quotation omitted). The proper focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*,

438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). Finally, where, as in the present case, the marks are used in connection with closely related services, “a lesser degree of similarity between the marks may be sufficient to give rise to a likelihood of confusion.” *Coach Servs.*, 101 USPQ2d at 1721.

The marks are similar to the extent that they share the wording DIY AUTO. The acronym DIY is a commonly used term defined as “do-it-yourself.”³ As evidence of the meaning of this term in the auto repair services industry, Applicant submitted eight Internet printouts showing media references to DIY AUTO or DIY AUTO REPAIR as a category of services or facilities, and another fourteen printouts showing third parties using the terms DIY AUTO or DIY AUTO REPAIR in conjunction with offering DIY repair services or facilities.⁴ On this record, we find that the purchasing public, who are interested in repairing their own vehicles, will understand the terms DIY, DIY AUTO and DIY AUTO REPAIR in their generic sense, rather than as indicating a particular source of do-it-yourself auto repair services.

In addition, as noted above, Registrant’s mark resides on the Supplemental Register. It is well-settled that registration on the Supplemental Register constitutes an admission that the mark was descriptive at the time of registration. *See, e.g., In*

³ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). We take judicial notice of this dictionary entry from dictionary.com, based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2018), accessed September 13, 2018.

⁴ December 7, 2017, Request for Reconsideration, TSDR pp. 44-82. Citations to the TSDR database are to the downloadable .pdf format. Applicant also provided a summary of this information in chart form in its brief. 4 TTABVUE 15-18.

re Clorox Co., 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978); *In re Consol. Foods Corp.*, 200 USPQ 477, 478 n.2 (TTAB 1978) (“Registration of the same mark on the Supplemental Register ... is an admission of descriptiveness.”). That Registrant’s mark includes a disclaimer of the wording DIY AUTO REPAIR SHOPS further supports our finding that the wording is generic. *See In re Carolyn’s Candies, Inc.*, 206 USPQ 356, 359-60 (TTAB 1980) (requiring an applicant seeking registration on the Supplemental Register to disclaim generic wording because it constitutes “unregistrable matter”).

Given the mark and services in the cited registration, it is clear that the registered mark is quite weak, and thus is entitled to a narrow scope of protection. Consequently, consumers are not likely to assume that all similar marks or permutations of Registrant’s mark indicate a common source, and they would rely on what otherwise would be relatively slight differences between the marks to distinguish them. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) (where marks are conceptually weak, “the public will look to other elements to distinguish the source of the services.”). In this case, we find the differences in the designs, font and color are sufficient to distinguish Applicant’s and Registrant’s marks.⁵

⁵ We also note that Applicant appropriately disclaimed the wording DIY AUTO. *See Dixie Rests.* 41 USPQ2d at 1533-34. Thus, neither Applicant nor Registrant claims that the wording in their marks is distinctive.

C. Conclusion

Considering all of the evidence and arguments of record as they pertain to the relevant *du Pont* factors, we find that Registrant's mark is inherently and commercially weak and entitled to a very narrow scope of protection. We further find that consumers are accustomed to encountering DIY AUTO-formative terms in relation to auto repair services such that the slight differences in designs, font and color of the marks suffice to avoid a finding that confusion is likely even when the marks are used on closely related services. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) ("The record shows that a large number of marks embodying the words 'bed and breakfast' are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words 'bed and breakfast.'"); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1207.01(b)(viii) (Oct. 2017) and authorities cited therein ("If the common element of two marks is 'weak' in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality.").

Decision: The refusal to register Applicant's mark DIY AUTO and design,



displayed as , is reversed.