

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

Mailed: May 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Compass Automotive, Inc.
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Serial Nos. 87473737 and 87533115
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Fadi Toma of Hakim, Toma & Yaldoo, P.C.,
for Compass Automotive, Inc.

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

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Before Kuhlke, Dunn and English,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Compass Automotive, Inc. (“Applicant”) seeks registration on the Principal Register of the marks GUEPARDO (in standard characters)¹ and



described as consisting “of a stylized representation of a

¹ Application Serial No. 87473737 was filed on June 2, 2017, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

cheetah above the word “G U E P A R D O”, in all caps, with a space in between each letter”² (“GUEPARDO marks”) both for “vehicle wheels” in International Class 12. Both applications include the following translation:

The English translation of “GUEPARDO” in the mark is “CHEETAH”.

The Trademark Examining Attorney has refused registration of Applicant’s marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s marks, when used in connection with the identified goods, so resemble the mark CHEETAH for “tire bead seating equipment, namely, pneumatically powered tire changer machines for land vehicles,” in International Class 7 and “hand tools for tires, namely, tire irons, wheel pullers,” in International Class 8³ as to be likely to cause confusion, mistake or deception.

After the Examining Attorney made the refusals final, Applicant appealed to this Board. In the Board’s December 20, 2018 Order, the appeals were consolidated. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1085 (TTAB 2016). We affirm the refusals to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. The Examining Attorney’s objection to the new evidence attached to Applicant’s brief

² Application Serial No. 87533115 was filed on July 18, 2017, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

³ Registration No. 3748978 issued on February 16, 2010, Sections 8 and 15 combined declaration accepted and acknowledged.

is granted, except as to the U.S. Census Report excerpt, for which we take judicial notice. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (“[t]he record in the application should be complete prior to the filing of an appeal”). *See also In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 n.7 (TTAB 2016) (Board may take judicial notice of U.S. Census Report); *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney’s objection to applicant’s submission of registrations with appeal brief sustained).

We further note that the Examining Attorney and Applicant submitted printouts of pages from the Internet that do not include the URL of the website and the date the excerpt was accessed. However, because there are no objections to this evidence, it has been considered in our determination. *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1586-87 (TTAB 2018).

II. Likelihood of Confusion

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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be

considered.” (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); *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 of factors, only factors that are “relevant and of record” need be considered).

A. Similarity of the Goods/Channels of Trade/Consumers

With regard to the goods, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods as they are identified in the applications and cited registration. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *In re Dixie Rest. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); see also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014). It is well settled that Applicant’s and Registrant’s goods do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the

mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

The Examining Attorney argues that the goods are related because they are complementary goods. 8 TTABVUE 9. In support of this argument, the Examining Attorney relies on the following evidence to show that pneumatically powered tire changer machines for land vehicles are used to remove a rubber tire from a vehicle wheel and wheel pullers are used to remove vehicle wheels from a land vehicle:⁴



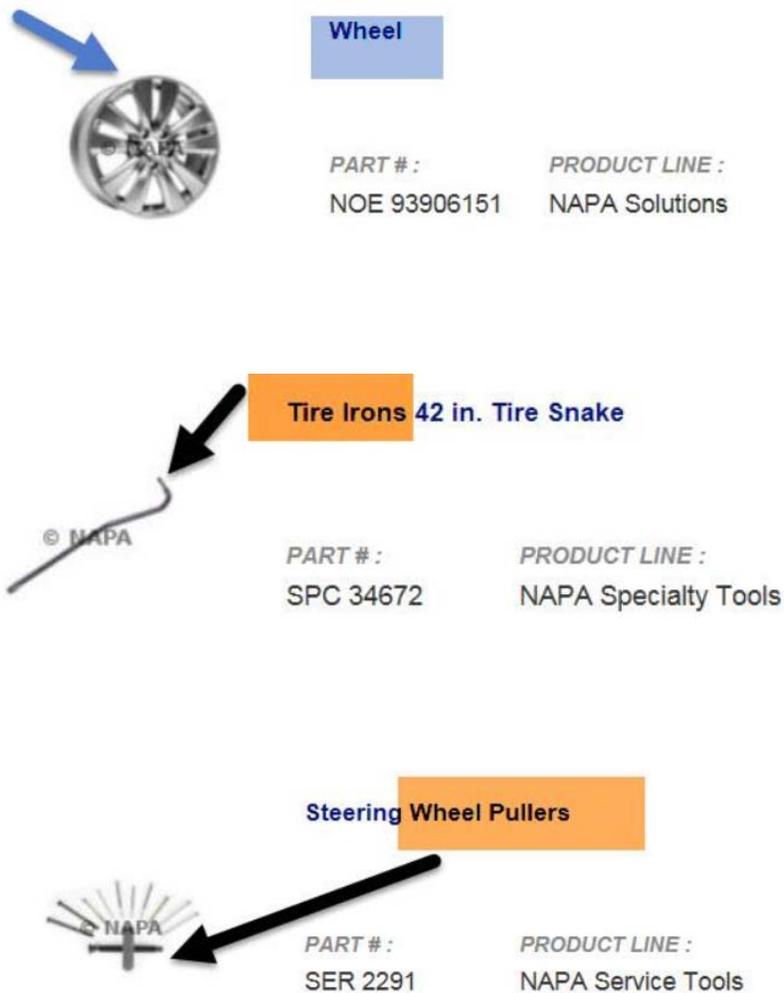
⁴ September 6, 2017 Office action at 6-9; April 1, 2018 Office action at 6. Citations to the record are to the USPTO Trademark Status & Document Retrieval system in Application Serial No. 87473737. Two of the tire changers are from third parties. The third example is Applicant's tire changing machine.



Product Details	PRODUCT DESCRIPTION
The Tubeless Tire Iron assists in the mount/demount process.	AME 71635 HEAVY DUTY WHEEL PULLER Designed to remove stuck hub-piloted truck wheels easily. This tool he

The Examining Attorney also included examples of “vehicle wheels” and “tire irons” and “wheel pullers” sold by the same retailer under the Napa line of products:⁵

⁵ April 1, 2018 Office action at 7-9.



Applicant contends that none of the goods in the Examining Attorney’s examples resemble the goods found on Registrant’s website. A representative example of bead seaters from Registrant’s website provided by Applicant is reproduced below:⁶

⁶ March 5, 2018 Response to Office Action at 17.

CH-10AL CHEETAH® BEAD SEATER (ALUM)	CH-60C CHEETAH® BEAD SEATER	CH-05 CHEETAH® BEAD SEATER	CHR-1 CHEETAH® SAFETY- FLATE	CH-05AL CHEETAH® BEAD SEATER (ALUM)	CH-02 CHEETAH® BEAD SEATER
\$551.00	\$3,565.00	\$249.00	\$770.00	\$416.00	\$129.00

The product includes the following description:

Used properly the CH-13AL Cheetah Bead Seater will seat the bead on virtually all tractor and heavy equipment tires. The CH-13AL works on both vertical and horizontal applications and can be used in the field where the tires remain mounted to the equipment.⁷

Applicant argues that the goods are not related because they are different goods; however, as explained above the goods need not be identical to find they are related in such a manner that there is likely confusion. *In re Albert Trostel & Sons Co.*, 29 USPQ2d at 1785. Applicant concedes that a “trained mechanic may use the Registrant’s goods to seat and seal a tire against the rim of Applicant’s wheel” but contends they are not “often used together.” 4 TTABVUE 11. While a particular wheel and tire bead seating equipment may not be used “often” together, tire bead seating equipment and wheels are used together each time any tire is seated and sealed against the rim of any wheel. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 186 USPQ 476, 479 (CCPA 1975) (likelihood of confusion, based in part on finding “Safety-Kleen’s parts washer and Dresser’s tools would be utilized in the same

⁷ *Id.* at 19.

service areas by the same professional mechanics and maintenance personnel; and that Dresser's hand tools and Safety-Kleen's parts washer are related in use to the extent that mechanics could utilize such tools to remove the parts for cleaning in the cleaner and that, admittedly, the parts cleaner can be and has been utilized to clean dirty and greasy hand tools."); *In re Iolo Technologies, LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010) ("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. Specifically, an optimizing software feature would be among the software tools that a computer technician might use when installing, maintaining or updating electronic communications computer software.").

Applicant's remaining arguments go to the issue of the channels of trade and how consumers encounter the marks. If the cited registration describes goods or services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). Therefore, to the extent Applicant's argument is simply directed to its own channel of trade and Registrant's actual channel of trade, our determination is bounded by the four corners of the applications and registration, we may not read into them limitations based on actual use. *See, e.g., In re Bercut-Vanderboort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) (an applicant may not restrict the scope of its goods or

services or the scope of the services covered in the registration by extrinsic argument or evidence). *See also 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, 1754 (TTAB 2007)); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008).

Applicant's vehicle wheels and Registrant's tire irons and wheel pullers are sold in the same channels of trade and offered to the same consumers as shown in the examples above under the Napa retailer website. This channel of trade includes all ordinary customers in the general population for automotive products. Registrant's tire bead seating equipment, namely, pneumatically powered tire changer machines for land vehicles may be limited to more professional purchasers, i.e., those who have experience changing tires in the shop and in the field. The examples of these goods in the record show them being marketed primarily to mechanics and auto shops. However, these consumers would also purchase vehicle wheels.

The record establishes that pneumatically powered tire changer machines for land vehicles, vehicle wheels, tire irons and wheel pullers are related and offered in the same channels of trade, whether to the general public or to the more narrowly defined mechanics and auto shops.

We find the goods are related, travel in the same channels of trade and are offered to the same customers. In view thereof, these *du Pont* factors favor a finding of likelihood of confusion.

B. Sophistication of Purchasers

Applicant argues that the mechanics purchasing Registrant's goods would take care in the purchasing decision and the average prospective consumer considering vehicle wheels would typically exercise great care when selecting wheels for their vehicle. 4 TTABVUE 15-16.

As indicated above, the involved identifications of goods are not limited, so we must presume that the classes of purchasers include ordinary consumers as well. While the pneumatic tire changer may only be purchased and used by auto mechanics who would exercise heightened care in the purchasing decision, the ordinary purchasers of Registrant's other goods, tire irons and wheel pullers, would include anyone who owns an automobile. We acknowledge that vehicle wheels are not impulse purchases and the ordinary purchaser of vehicle wheels would exercise some care. However, while we may infer a higher level of scrutiny in their purchasing, there is not sufficient evidence of record upon which to make a determination that this factor would outweigh the other *du Pont* factors. Moreover, even sophisticated buyers are not immune from confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find this factor to be neutral.

C. Similarity or Dissimilarity of the Marks

We consider Applicant's GUEPARDO marks and Registrant's mark CHEETAH and compare them "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison*

Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)). Further, marks “must be considered ... in light of the fallibility of memory” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). 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 marks are clearly different in appearance and sound from the Registrant’s respective mark. The Examining Attorney relies on the doctrine of foreign equivalents in making her determination that the marks are similar in connotation and that this similarity is sufficient to find the marks confusingly similar. “Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with

English word marks. See *Palm Bay Imps.*, 73 USPQ2d at 1689. The doctrine is applied when it is likely that “the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent.’” *Id.* at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). See also *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127-28 (TTAB 2015) (equivalency in meaning or connotation can outweigh differences in the marks). However, “such similarity as there is in connotation [between the foreign word mark and the English word mark] must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.” *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983); see also *In re Ness & Co.*, 18 USPQ2d 1815, 1816 (TTAB 1991).

The record establishes that CHEETAH is the exact translation from the Spanish word GUEPARDO.⁸ We have consistently found that Spanish is a “common language” in the United States, and we have routinely applied the doctrine of foreign equivalents to Spanish-language marks. *In re Aquamar*, 115 USPQ2d at 1127; *In re La Peregrina Ltd.*, 86 USPQ2d at 1648 (“there is no question that Spanish is a common, modern language”); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983); *Rosenblum v. George Willsher & Co.*, 161 USPQ 492 (TTAB 1969). According to an excerpt from the United States Census Bureau Newsroom, submitted

⁸ September 6, 2017 Office action at 5 (Translation Dictionary).

by the Examining Attorney, 40 million U.S. residents age 5 and older spoke Spanish at home in 2016, which is 13.3 percent of U.S. residents age 5 and older.⁹

Applicant argues the doctrine of foreign equivalents does not apply because “[a]lmost 88% of the U.S. population does not speak Spanish at home” therefore “[a] substantial number of ordinary American purchasers would not ‘stop and translate’ the foreign term into its English equivalent.” 4 TTABVUE 4. Applicant expands on this argument and contends “there is ... no valid reason to believe the average American purchaser will stop and translate Applicant’s GUEPARDO mark.” *Id.* at 9. Applicant further argues that even if the doctrine of foreign equivalents applies, the differences in sound and appearance of the marks outweigh any equivalence in meaning. *Id.* at 10.

Applicant’s point about the number of possible consumers that could be confused, is not persuasive. It is well settled that the doctrine of foreign equivalents applies where the “ordinary American purchaser ... who is knowledgeable in the foreign language” would stop and translate the mark. *In re Thomas*, 79 USPQ2d at 1024. The percentage of the American population that makes up that subgroup is not the measure (and in any event 12% of 328830848 is not insubstantial). The measure is whether the language in question is a common modern language.

Applicant is correct that applying the doctrine is only part of the process of determining whether the marks being compared are confusingly similar. Appearance, sound, meaning, and overall commercial impression are also factors to be considered

⁹ April 1, 2019 Office action at 5.

when comparing marks. *See Palm Bay Imps.*, 73 USPQ2d at 1691; *In re Ness & Co.*, 18 USPQ2d at 1816 (“[S]uch similarity as there is in connotation [between the foreign word mark and the English word mark] must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.” (quoting *In re Sarkli, Ltd.*, 220 USPQ at 113)). However, equivalency in meaning or connotation may outweigh differences in the marks. *In re Aquamar, Inc.*, 115 USPQ2d at 1127-28.

Here, GUEPARDO translates directly to CHEETAH. There is no other nuance or meaning for either term; they are exact equivalents. *Cf. In re Sarkli, Ltd.*, 220 USPQ at 113 (SECOND CHANCE and REPECHAGE not exact equivalents); *In re Buckner Enters. Corp.*, 6 USPQ2d 316 (TTAB 1987) (DOVE not confusingly similar to PALOMA which may be translated into either dove or pigeon). It has not been shown that CHEETAH is conceptually or commercially weak for these goods.¹⁰ There is also nothing in the “marketplace circumstances or the commercial setting in which the mark is used” to indicate that purchasers would be unlikely to translate the mark. *In re La Peregrina*, 86 USPQ2d at 1648.

Here, as in a number of prior cases with similar facts, the equivalency in meaning of the marks outweighs the differences in how the marks look and sound. *See Ithaca Indus., Inc.*, 230 USPQ 702, 704 (TTAB 1986); *see also, In re La Peregrina*, 86 USPQ2d at 1649-50 (“LA PEREGRINA and PILGRIM [both for jewelry] are foreign

¹⁰ As decided above, we have not considered Applicant’s untimely evidence of third-party registrations, but note consideration of this evidence would not alter the determination.

equivalents and, thus, the marks are identical in meaning. This factor outweighs the differences in appearance and pronunciation.”); *In re Thomas*, 79 USPQ2d at 1021 (MARCHE NOIR for jewelry likely to be confused with BLACK MARKET MINERALS for retail jewelry store services, despite marks being “decidedly different in sound and appearance,” in large part because “marche noir” means “black market” in French); *In re Perez*, 21 USPQ2d at 1075 (finding EL GALLO for fresh vegetables, namely tomatoes and peppers likely to be confused with ROOSTER for fresh fruit, in large part because “gallo” means “rooster” in Spanish); *In re Am. Safety Razor*, 2 USPQ2d at 1460 (“While the marks [GOOD MORNING (with design) and BUENOS DIAS] are concededly distinguishable in their appearance and pronunciation, it is our view that the equivalency in meaning or connotation is sufficient, in this case, to find likelihood of confusion.”); *In re Hub Distrib.*, 218 USPQ 284 (TTAB 1983); *Rosenblum*, 161 USPQ at 492 (RED BULL for Scotch whiskey likely to be confused with TORO ROJO for rum, in large part because “toro rojo” means “red bull” in Spanish). The design of the cheetah in Application Serial No. 87533115 merely serves to reinforce the connotation and commercial impression engendered by the word portion of the mark. *In re Am. Safety Razor*, 2 USPQ2d at 1460.

Given the exact equivalency we find that the marks are similar.

D. Balancing the Factors

Applying the doctrine of foreign equivalents, we find that confusion is likely to occur in the marketplace. We conclude that bilingual (English and Spanish) consumers familiar with Registrant’s “tire bead seating equipment, namely,

pneumatically powered tire changer machines for land vehicles” and “hand tools for tires, namely, tire irons, wheel pullers” sold under the mark CHEETAH would be likely to believe, upon encountering the Spanish equivalent GUEPARDO and GUEPARDO with the image of a CHEETAH for “vehicle wheels,” that the “vehicle wheels” originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusals to register Applicant’s GUEPARDO marks are affirmed.