

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lucas Oil Products, Inc.

Serial No. 90667610

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Before Cataldo, Wolfson and Lebow,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Lucas Oil Products, Inc., filed an application to register on the Principal Register the mark IT WORKS! (in standard characters) identifying the following goods, as amended:

Operating fluids, namely, transmission fluid, power steering fluid, and brake fluid in International Class 1; and

Non-chemical additives for motor fuels; non-chemical additives for engine oils; non-chemical absorbents for removing impurities from fuel; motor vehicle lubricants; lubricants for internal combustion engines in land and water vehicles; Non-chemical engine treatment preparations

and additives for engine oils, gasoline and diesel fuels, transmission fluids and cooling systems in International Class 4.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), as to the goods identified as "motor vehicle lubricants; lubricants for internal combustion engines in land and water vehicles" in Class 4 on the ground of likelihood of confusion with the cited registered mark IF IT'S SELLEYS IT WORKS (in standard characters), identifying goods in several classes including:

All purpose lubricants, namely, anti-corrosive lubricants; lubricants for use on household items, namely, lubricants having cleaning properties; lubricating oils and greases; industrial oils, namely, oils for sealing brickwork, concrete, slate, surfaces in International Class 4.²

Applicant appealed to this Board.³ Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the

¹ Application Serial No. 90667610 was filed on April 23, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), based upon an assertion of June 29, 2001 as a date of first use of the mark anywhere and in commerce on both classes of goods.

² Registration No. 6139179 issued on the Principal Register on September 1, 2020.

³ All citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020).

factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered all *DuPont* factors that are relevant. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”).

Two key considerations are the similarities between the marks and the relatedness of the goods 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 differences in the essential characteristics of the goods and differences in the marks.”); *In re FabFitFun, Inc.*, 127

USPQ2d 1670, 1672 (TTAB 2018). Also under consideration in this appeal are the trade channels in which the goods are encountered and the presence or absence of actual confusion.

A. The Goods and Channels of Trade

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2004); *Octocom Sys., Inc. v. Hous. 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 or services 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) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

The “All purpose lubricants, namely, anti-corrosive lubricants” and “lubricating oils and greases” identified in the cited registration encompass Applicant’s “motor vehicle lubricants; lubricants for internal combustion engines in land and water vehicles.” The goods thus, in part, are overlapping and legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

Applicant argues:

The Applicant's Refused Goods and Registrant's Goods are dissimilar – as one party makes lubricants specifically for motor vehicles and the other makes lubricants predominately for one's home to be used on squeaky doors, drawers, windows, or for cleaning purposes.⁴

However, the broadly identified “All purpose lubricants, namely, anti-corrosive lubricants” and “lubricating oils and greases” listed in the cited registration are not limited to lubricants for home use on squeaky doors, drawers, windows, for cleaning purposes or any particular purpose. We must base our likelihood of confusion determination on the goods as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976); *see also Octocom*, 16 USPQ2d at 1787 (“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”).

As a result, Applicant's more narrowly identified motor vehicle and engine lubricants are presumed to be included among the all-purpose lubricants and lubricating oils and greases identified in the cited registration. *See, e.g., In re Thor Tech, Inc.*, 90 USPQ2d 1634 (TTAB 2009) (finding “recreational vehicles, namely, travel trailers and fifth wheel trailers” to be encompassed by and legally identical to

⁴ 6 TTABVUE 21-22 (Applicant's brief); June 21, 2022 Response to first Office action at 20-21; January 3, 2023 Request for Reconsideration at 16-19.

“trailers”); *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992) (finding “computer software for data integration and transfer” to be encompassed by and legally identical to “computer programs recorded on magnetic disks”). Applicant’s reliance on *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) is inapposite because the goods compared in that case were used for distinctly different purposes, unlike the present appeal in which Applicant’s goods are encompassed by the goods identified in the cited registration.

With regard to the third *DuPont* factor, the similarity of the trade channels in which the goods are encountered, we must again base our likelihood of confusion determination on the goods as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ at 640; *In re William Hodges & Co., Inc.*, 190 USPQ at 48. *See also Octocom*, 16 USPQ2d at 1787. Because Applicant’s goods are legally identical, in part, to the goods in the cited registration, we presume that such goods of Applicant and the registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and

purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

Accordingly, the *DuPont* factors relating to the similarity or dissimilarity of the goods and the similarity or dissimilarity of their trade channels heavily favor a finding of likelihood of confusion.

B. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s IT WORKS! mark and the registered IF IT’S SELLEYS IT WORKS mark in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Cap. v. Lion Cap.*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ

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749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, 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. *Nat’l Data*, 224 USPQ at 751.

In this case, the wording in Applicant’s IT WORKS! mark is encompassed in its entirety by the registered IF IT’S SELLEYS IT WORKS mark. The marks are similar in appearance and sound inasmuch as the registered mark includes the entirety of Applicant’s mark apart from the exclamation point. The exclamation point, used as punctuation in Applicant’s mark, has no meaningful impact visually, aurally or as to commercial impression. *See, e.g., In re Burlington Industries, Inc.* 196 USPQ 718, 719 (TTAB 1977) (“An exclamation point does not serve to identify the source of the goods). Punctuation does not per se change the character of a mark. *See In re Champion Int’l Corp.*, 196 USPQ 48, 49 (TTAB 1977) (finding no distinction, vague or otherwise, can be drawn between “CHECK MATE” with or without a hyphen between the words so that for purposes herein they are identical); *Winn’s Stores, Inc. v. Hi-Lo, Inc.*, 203 USPQ 140 (TTAB 1979) (Likelihood of confusion found between Opposer’s use of the mark WINN’S and Applicant’s use of the mark WIN-WAY DOLLAR STORES since little if any trademark significance can be attributed either

to the apostrophe and letter “S” in Opposer’s mark or the hyphen in Applicant’s mark.).

Applicant’s mark connotes an assurance to consumers that its products under the IT WORKS! mark are effective. The registered IF IT’S SELLEYS IT WORKS mark similarly connotes an assurance that if the products emanate from the registrant, they are effective. The connotation of the registered mark thus is more specific, pointing to the registrant as the source of its goods, whereas Applicant’s mark more broadly assures purchasers that the products so identified are effective without indicating a specific source. The marks thus convey similar meanings touting the efficacy of the legally identical products identified thereby.

The marks differ to the extent that the registered mark further includes the prefacing wording IF IT’S SELLEYS. However, “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.” *In re Mighty Leaf Tea*, 94 USPQ2d at 1260-61 (finding ML in standard characters confusingly similar to ML MARK LEES in stylized form); *see also Stone Lion Cap. v. Lion Cap.*, 110 USPQ2d at 1162 (finding STONE LION CAPITAL confusingly similar to LION and LION CAPITAL); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN likely to be confused with TITAN); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”); *In re*

Chica Inc., 84 USPQ2d 1845, 1848-49 (TTAB 2007) (affirming refusal to register CORAZON BY CHICA & Design based on a registration of CORAZON in stylized format, stating “to many consumers, applicant’s mark for the identical word ‘Corazon’ followed by the phrase ‘BY CHICA’ will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON”).

There is no evidence regarding the strength or weakness of the terms comprising the registered mark. As a result, there is no evidence that IF IT’S SELLEYS IT WORKS or the IT WORKS portion of the registered mark is inherently or commercially strong or weak. The facts of this appeal thus are dissimilar from those in *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005), finding no likelihood of confusion between NORTON McNAUGHTON ESSENTIALS and ESSENTIALS where the evidence demonstrated that “Essentials” was a highly suggestive term. Simply put, Applicant’s IT WORKS! mark is identical in appearance, sound and meaning to a distinctive portion of the registered IF IT’S SELLEYS IT WORKS mark, and the additional portions of registrant’s mark do not obviate likelihood of confusion.

Applicant points out the differences in the appearance, sound and meaning of the marks. However, it is not necessary for the marks to be identical, or to have common pronunciation or number of syllables in order to find their similarities outweigh their differences. “The 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) (internal quotation marks omitted); *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988).

We acknowledge that the presence of IF IT’S SELLEYS as the preceding terms in the registered mark differentiates it visually and aurally from Applicant’s mark. These points of distinction, however, do not sufficiently diminish the strong similarities in connotation and overall commercial impression engendered by these two marks. Similarity in any one of the elements of sound, appearance, meaning, or commercial impression may be sufficient to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion”); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (“In appropriate cases, a 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’”) (citations omitted).

To the extent that Applicant has relied upon a variety of cases involving marks unrelated to those at issue to bolster its contention that the marks are not similar, as is often noted by the Board and the Courts, each case must be decided on its own

merits. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *see also In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

Based upon the above analysis, we find that IT WORKS! is more similar to than dissimilar from the mark IF IT'S SELLEYS IT WORKS in terms of appearance, sound, and particularly connotation and commercial impression. As a result, consumers encountering these marks are likely to mistakenly believe the former is a variation on the registered mark used to identify a particular type of lubricant as a subset of the registrant's goods, but nonetheless emanating from a common source. *See In re Bay State Brewing Co.*, 117 USPQ2d at 1961 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978).

In our comparison of Applicant's IT WORKS! mark to the registered IF IT'S SELLEYS IT WORKS mark, we further consider that, "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *see also ECI Division of E-Systems, Inc. v. Env't Commc'ns. Inc.*, 207 USPQ 443, 449 (TTAB 1980).

This *DuPont* factor supports a finding that confusion is likely.

C. Absence of Actual Confusion

Finally, Applicant argues that there is no evidence of any actual confusion and that there has been concurrent use since at least April 2019. We do not accord any weight to Applicant's contention, unsupported by any evidence, that there have been

no instances of actual confusion despite contemporaneous use of the respective marks.

The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh *DuPont* factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

In re Majestic Distilling Co., 65 USPQ2d 1291, 1205 (Fed. Cir. 2003).

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not compelling in support of a finding of no likelihood of confusion, particularly in an ex parte proceeding in which the owner of the cited registration cannot appear. Thus, we cannot conclude from the purported lack of instances of actual confusion that confusion is not likely to occur.

The seventh *DuPont* factor is neutral.

D. Conclusion

We have considered the record and the relevant likelihood of confusion factors of similarity of the marks, relatedness of the goods and their trade channels, and the absence of actual confusion, and all of Applicant's arguments relating thereto. The other *DuPont* factors do not appear to be relevant inasmuch as we have neither

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arguments nor evidence related thereto. We conclude that consumers familiar with the registrant's goods offered under its mark would be likely to believe, upon encountering Applicant's mark, that the goods in the cited registration and Applicant's legally identical goods originated with or are associated with or sponsored by the same entity. The absence of consumer confusion is neutral.

Decision: The refusal to register Applicant's mark is affirmed under Section 2(d) of the Trademark Act as to the goods identified as: "motor vehicle lubricants; lubricants for internal combustion engines in land and water vehicles" in Class 4. The application will proceed as to the remaining goods in Classes 1 and 4.