

Mailed:
Oral Hearing date:
September 10, 2002

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

April 16, 2003
Paper No. 38
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Pep Boys Manny, Moe & Jack of California
v.
Cherng Lian Ent Co., Ltd.

Opposition No. 108,772 to application Serial No. 75/138,188
filed on July 18, 1996

Marsha G. Gentner of Jacobson Holman, PLLC for The Pep Boys
Manny, Moe & Jack of California.

Thomas J. Moore of Bacon & Thomas for Cherng Lian Ent Co., Ltd.

Before Simms, Hohein and Holtzman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Cherng Lian Ent Co., Ltd. has filed an application to
register the mark "ROAD BOY" and design, as shown below,



for "light fixtures for vehicles, namely, lights for automobiles,

Opposition No. 108,772

fog lights, headlights for automobiles, [and] light bulbs for land vehicles".¹

As set forth in its amended notice of opposition, **The Pep Boys Manny, Moe & Jack of California** has opposed registration on the grounds that, "long prior to the date of first use alleged in the application opposed herein, Opposer, through its predecessor in interest and its exclusive licensee The Pep Boys Manny Moe & Jack [... hereinafter ... collectively referred to as 'Pep Boys'] has, and is now, engaged in the distribution, marketing, sale, advertising and promotion of a variety of automotive maintenance, repair, parts, accessories and retail store services"; that "Pep Boys has continuously used the name(s) and mark(s) PEP BOYS, THE PEP BOYS, and THE PEP BOYS MANNY, MOE & JACK [hereinafter collectively referred to as the 'PEP BOYS Mark(s)'], as well as a fanciful design of Pep Boys' founders, 'MANNY, MOE & JACK', ... [hereinafter referred to as the 'PEP BOYS Logo'] to identify and designate Opposer, its business, Opposer's wide variety of automotive products, services and retail stores, and to distinguish those goods, services, business and stores from those of others"; that opposer is the owner of and will rely upon certain pleaded registrations for such marks; that opposer "has built up extensive goodwill under its PEP BOYS Mark(s) ... and PEP BOYS Logo, with the result that since prior to the date of first use alleged in the application opposed

¹ Ser. No. 75/138,188, filed on July 18, 1996, which alleges a date of first use anywhere of March 16, 1990 and a date of first use in commerce of June 1, 1990. The lining, while a feature of the mark, is

Opposition No. 108,772

herein, Opposer's said ... marks have become so well recognized as to be 'famous'; that applicant's "ROAD BOY" and design mark "is a simulation and colorable imitation of, and is confusingly similar to, Opposer's ... famous PEP BOYS Mark(s) ... and/or PEP BOYS Logo"; that applicant's goods "are similar and/or related to Opposer's goods and services, and/or those offered or sold in Opposer's Pep Boys' stores"; that applicant's "ROAD BOY" and design mark, when used in connection with its goods, so resembles opposer's various pleaded marks for its goods and services as to be likely to cause confusion, mistake or deception; that applicant, prior to adopting and determining to use its mark in connection with its goods, had "knowledge of Opposer and its famous PEP BOYS Mark(s) ... and PEP BOYS Logo"; and that "the registration and/or commercial use of the opposed ROAD BOY & Design mark by Applicant will cause dilution of the distinctive quality of Opposer's ... famous and distinctive PEP BOYS Mark(s) ... and/or PEP BOYS Logo."

Applicant, in its answer, has denied the salient allegations of the amended notice of opposition. Briefs have been timely filed² and an oral hearing, attended by counsel for the parties, was held.

for shading purposes and is not intended to indicate color. The mark consists of a silhouette of two men between the words "ROAD BOY."

² Applicant's consented motion for an extension of time until May 6, 2002 to file its brief on the case is granted. While, with respect to opposer's contested motion for an extension of time to file its reply brief herein, it is pointed out that the provisions of Trademark Rule 2.119(c) are not applicable to a due date set by a Board order, the motion is granted inasmuch as good cause therefor has otherwise been shown for an extension from May 21, 2002 until May 28, 2002. Fed. R. Civ. P. 6(b) and Patent Rule 1.7, as made applicable by Trademark Rule 2.1. (Nonetheless, had applicant more properly raised by motion,

Preliminarily, we turn to the request in applicant's brief for leave, pursuant to Fed. R. Civ. P. 15(b), to amend its answer to assert a counterclaim against two of opposer's pleaded registrations. Specifically, by its proposed counterclaim, applicant seeks to cancel Reg. Nos. 310,199 and 1,699,427, each of which is for a mark which, as applicant observes, has a design feature which includes "a cigar in the mouth of Manny." According to applicant, opposer "has ceased use with an intent not to resume use of each mark that shows a cigar in the mouth of Manny, who is one of the Pep Boys" characters shown in such marks, and thus has abandoned the marks.

In particular, applicant contends in support thereof that, "[d]uring the trial testimony [on August 28, 2001] of Opposer's witness, Mr. Furtkevic, he testified that these marks have been abandoned" because his testimony was that "in 1990, during the Great American Smoke Out, we decided to remove the cigar from the Manny character ... and that act garnered national media attention." Although applicant further asserts that "[t]he removal of the cigar is clearly a material alteration" of each mark, inasmuch as "[i]f a change garners national media attention, then that change is certainly material," applicant

rather than in its brief on the case, its request for leave to amend the answer to assert a counterclaim, it is clear that under the rules of practice opposer would in any event have had the additional time it requested in which to respond thereto, and it should not be deprived thereof by the shortcut taken by applicant in its brief.) Finally, in view of the circumstances, opposer's uncontested motion for leave to exceed the page limitation for its reply brief is granted. The 29-page reply brief submitted by opposer on May 28, 2002 is accordingly accepted, but the "corrected" version thereof, filed by opposer on May 31, 2002, is untimely and has been given no consideration.

maintains that "[t]his information was not available to Applicant when the Answer to [the] Amended Notice of Opposition ... was filed on February 7, 2001" and, thus, "there was no counterclaim for cancellation at that time." Applicant argues, however, that allowance of the requested amendment is proper at this juncture under Fed. R. Civ. P. 15(b) as being necessary to cause "the pleadings to conform to the evidence" presented at trial.

We agree with opposer, however, that not only is it plain that the issue of opposer's alleged abandonment of two of the marks which are the subjects of its pleaded registrations was never tried by the express or implied consent of the parties, but in any event there has been no abandonment inasmuch as the removal of the cigar from Manny's mouth results in marks which continue to convey essentially the same commercial impression as those marks do with such a cigar. As opposer accurately points out (footnote omitted):

Indeed, the whole of the testimony regarding the alleged abandonment issue--which constitutes a single sentence--occurred in the midst of Opposer's [witness's] direct testimony regarding the numerous times Opposer has been the subject of publicity. It was not raised--nor later addressed--by Applicant's counsel during cross-examination. Indeed, Applicant's counsel never raised an issue of abandonment. Thus, the context in which the single sentence was uttered would not have apprised Opposer that Applicant was pursuing as [sic] abandoned [sic] claim.

Furthermore, we concur with opposer that it is obvious that (*italics in original*):

The national media attention to Manny's "decision" to quit smoking was not garnered

by the significance of the change in the commercial impression of mark[s] ..., but rather by the *symbolic* value to the anti-smoking movement of the "act" of such a[n] ... icon. Indeed, as to the commercial impression [of the marks], one has to look closely to even notice the cigar, [or its absence,] at all. There is no evidence to suggest that consumers have or do notice a "material" difference.

Accordingly, applicant's request for leave to amend its answer to assert a counterclaim is denied. Fed. R. Civ. P. 15(b).

The record includes the pleadings; the file of the opposed application; and, as part of opposer's case-in-chief, the testimony, with exhibit(s),³ of: (i) the director of marketing communications for its parent company, William V. Furtkevic; (ii)

³ Applicant, in its brief, has reiterated the objection, which it raised during the deposition of Mr. McElroy, to consideration of opposer's Exhibit 43, which consists of a list of advertising and sales figures for fiscal years 1985 through 2000. Specifically, applicant notes in its brief that it continues to object to such exhibit to the extent that it "differs from or provides additional information" from "what was produced in discovery," contending that "[i]n the Responses to Applicant's First Set of Interrogatories ..., Opposer provided advertising expense figures [only] for the years from 1994 to 2000." However, inasmuch as applicant has failed to substantiate its objection by submitting a copy of the alleged responses, the objection is overruled and Exhibit 43 has been considered.

In addition, applicant in its brief expands upon its objection, which it raised during the deposition of Mr. Furtkevic, that the documents offered as exhibits "were not produced before today's trial testimony deposition." (Furtkevic dep. at 45.) Applicant, in particular, requests that all of the exhibits to the depositions of opposer's three witnesses "should be excluded from evidence" because opposer "did not provide Applicant with copies of numerous documents that are now offered[,] as Opposer's Exhibits, until the day of the trial testimony depositions [on August 28, 2001], despite previous discovery requests for these documents." Applicant, however, has not only failed to substantiate its objection by submitting a copy of the documents allegedly supporting its position, but as documented by opposer's reply brief, it appears that the parties, while agreeing to produce requested documents on "a mutually acceptable date or dates," never settled on a specific date or dates by which production would be made. Applicant's objection is thus overruled and the exhibit(s) to each of opposer's witnesses' trial depositions have been considered.

the vice president of finance, treasurer and assistant secretary of opposer, Bernard K. McElroy; and (iii) opposer's chief administrative officer, Frederick A. Stampone. As the rest of its case-in-chief, opposer has submitted notices of reliance upon (i) certified copies of various registrations for its marks and (ii) applicant's responses to certain of opposer's discovery requests.⁴ Applicant, as its case-in-chief, has filed a notice of reliance upon opposer's response to one of applicant's requests for admission. Applicant did not take testimony or submit any additional evidence, and opposer did not offer any rebuttal evidence.

Priority of use is not in issue in this proceeding with respect to those of opposer's pleaded registrations which, as specifically set out later in this opinion, have been established by opposer's notice of reliance to be subsisting and owned by opposer.⁵ See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Priority of use

⁴ As a general proposition, it is pointed out that unlike either interrogatories and the answers thereto or requests for admission and the admissions thereof, requests for production of documents and any documents produced in response thereto are not proper subject matter for a notice of reliance under Trademark Rule 2.120(j) with the exception of documents which otherwise meet the requirements of Trademark Rule 2.122(e). See Trademark Rules 2.120(j)(3)(ii) and TBMP §711. However, since applicant in its brief has treated opposer's reliance on applicant's responses to certain of opposer's requests for production of documents as forming part of the record by not objecting thereto, such has been considered herein.

⁵ Specifically, while opposer pleaded in its amended notice of opposition that, among other things, it was the owner of the following registrations, no evidence thereof was made of record: Reg. No. 1,395,353, issued on May 27, 1986; Reg. No. 1,420,631, issued on December 9, 1986; Reg. No. 1,562,597, issued on October 24, 1989; Reg. No. 1,562,599, issued on October 24, 1989; Reg. No. 1,665,248, issued on November 19, 1991; and Reg. No. 1,997,613, issued on August 27, 1996.

likewise is not in issue herein as to four additional registrations which, as noted with particularity later on, have also been shown by opposer to be subsisting and owned by opposer. Although such registrations were not pleaded by opposer, they have been considered inasmuch as opposer introduced them as part of its notice of reliance on certain registrations for its pleaded marks during its initial testimony period and applicant, in its brief, has treated those registrations, like the others which accompany such notice, as forming part of the record.⁶

Accordingly, as to the claim of priority of use and likelihood of confusion, the focus of our determination is on the issue of whether applicant's "ROAD BOY" and design mark, when used in connection with the goods set forth in its application, so resembles one or more of opposer's "PEP BOYS" marks, including those with its "PEP BOYS" logo, for its various goods and services as to be likely to cause confusion, mistake or deception as to source or sponsorship. As to the claim of dilution, we must determine whether opposer's "PEP BOYS" marks are famous and distinctive, and if so, whether applicant's use of its mark began after opposer's marks had become famous and whether such use causes dilution of the distinctive quality of opposer's marks.

⁶ Applicant states in its brief that opposer's registrations "are recited in the Notice of Reliance" and that "[p]riority is not an issue[,] insofar as Opposer's registrations are concerned, because Applicant has not counterclaimed for cancellation based on priority of use." We accordingly consider opposer's four additional registrations to have been stipulated into the record.

According to the record, opposer pleaded and is the owner of subsisting registrations for the following:⁷

(1) the mark "THE PEP BOYS" and design, which is registered as shown below



for "high pressure lubricants, motor lubricating oils, [and] transmission and differential lubricants" in International Class 4;⁸

(2) the mark "PEP BOYS," which is registered for:

⁷ The information indicated is in accordance with TBMP §703.02(a), which provides in pertinent part that:

[W]hen a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely upon, the current status of the registration, as shown by the records of the PTO. See *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846 (TTAB 1978); and *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979).

⁸ Reg. No. 310,199, issued on February 13, 1934, which sets forth a date of first use anywhere and in commerce of August 31, 1933; third renewal. "The mark includes as a feature a reproduction of pen and ink sketches intended to resemble the officers of the ... corporation."

(a) "retail store services in the field of automotive accessories" in International Class 42;⁹

(b) "oil additive[s], transmission fluids, and power steering fluids" in International Class 1; "hand soap cleaners" in International Class 3; and "batteries for land vehicles" in International Class 9;¹⁰

(c) "vehicle servicing, repair and maintenance services and installation of vehicle parts" in International Class 37;¹¹ and

(d) "metal key rings, [and] metal money clips" in International Class 6; "plastic pocket pen knives" in International Class 8; "tape measures and metal cases therefor" in International Class 9; "cigarette lighters made of precious metal, [and] watches" in International Class 14; "correspondence holders, pens, playing cards, [and] pen and pencil sets" in International Class 16; "tote bags, non-leather duffel [sic] bags, golf umbrellas, [and] nylon backpacks" in International Class 18; "drinking glasses, mugs, portable beverage coolers; [and] beverage insulators sold together as a unit with sport bottles sold empty" in International Class 21; "beach towels" in International Class 24; "caps, visors, clothing, namely, sweaters, polo shirts, golf shirts, jackets, pullovers, t-shirts, sweatshirts, denim jackets, cotton jackets, baseball jackets, tank tops, [and] nightshirts" in International

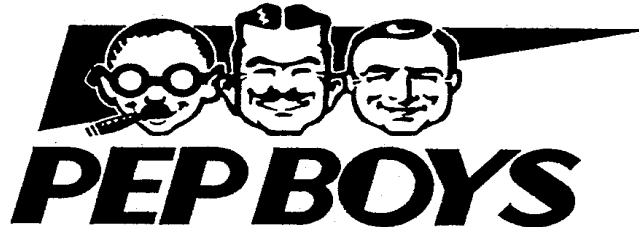
⁹ Reg. No. 1,288,346, issued on July 31, 1984, which sets forth a date of first use anywhere and in commerce of 1925; combined affidavit §§8 and 15.

¹⁰ Reg. No. 1,472,747, issued on January 19, 1988, which sets forth a date of first use anywhere and in commerce of November 23, 1984 for the goods in both International Classes 1 and 3, and July 15, 1984 for the goods in International Class 9; combined affidavit §§8 and 15.

¹¹ Reg. No. 1,562,598, issued on October 24, 1989, which sets forth a date of first use anywhere and in commerce of 1945; combined affidavit §§8 and 15.

Class 25; and "tossing disc toys, footballs, golf balls, [and] teddy bears" in International Class 28;¹² and

(3) the mark "PEP BOYS" and design, which is registered as reproduced below



for "automotive repair and maintenance services" in International Class 37 and "retail automotive store services" in International Class 42;¹³

(4) the mark "PEP BOYS" and design, which is registered as illustrated below



for:

(a) "vehicle maintenance and repair services" in International Class 37 and "retail automotive store services" in International Class 42;¹⁴ and

¹² Reg. No. 2,036,750, issued on February 11, 1997, which sets forth a date of first use anywhere and in commerce of October 1992 for the goods in International Classes 6, 8, 9, 14, 16, 18, 24 and 28, 1984 for the goods in International Class 21 and 1982 for the goods in International Class 25; combined affidavit §§8 and 15.

¹³ Reg. No. 1,699,427, issued on July 7, 1992, which sets forth a date of first use anywhere and in commerce of March 4, 1990 for the goods in both International Classes 1 and 3; combined affidavit §§8 and 15.

¹⁴ Reg. No. 1,883,21, issued on March 14, 1995, which sets forth a date of first use anywhere and in commerce of October 1, 1991 for the goods in both classes; combined affidavit §§8 and 15.

(b) "metal key rings, [and] metal money clips" in International Class 6; "plastic pocket pen knives" in International Class 8; "tape measures and metal cases therefor" in International Class 9; "cigarette lighters made of precious metal, [and] watches" in International Class 14; "correspondence holders, pens, playing cards, [and] pen and pencil sets" in International Class 16; "tote bags, non-leather duffle bags, golf umbrellas, [and] nylon backpacks" in International Class 18; "drinking glasses, mugs, portable beverage coolers; [and] beverage insulators sold together as a unit with sport bottles sold empty" in International Class 21; "caps, visors, clothing, namely, sweaters, polo shirts, golf shirts, jackets, pullovers, t-shirts, sweatshirts, denim jackets, cotton jackets, baseball jackets, tank tops, [and] nightshirts" in International Class 25; and "tossing disc toys, footballs, golf balls, [and] teddy bears" in International Class 28;¹⁵ and

(5) the mark "THE PEP BOYS MANNY, MOE & JACK" and design, which is registered as depicted below



for "watches" in International Class 14; "mugs" in International Class 21; and "clothing, namely t-shirts, sweatshirts,

¹⁵ Reg. No. 2,206,793, issued on December 31, 1996, which sets forth a date of first use anywhere and in commerce of October 1992 for the goods in International Classes 6, 8, 9, 14, 16, 18 and 28, 1984 for the goods in International Class 21 and 1982 for the goods in International Class 25; combined affidavit §§8 and 15.

denim jackets, tank tops, [and] nightshirts"
in International Class 25.¹⁶

Additionally, the record establishes that opposer is
the owner of subsisting registrations for the following:

(1) the mark "PEP BOYS PARTS USA" and
design, which is registered as shown below



for "retail stores featuring automotive parts
and accessories" in International Class 42;¹⁷

(2) the mark "PEP BOYS EXPRESS," which
is registered for "retail stores featuring
automotive parts and accessories" in
International Class 35;¹⁸

(3) the mark "PEP BOYS EXPRESS" and
design, which is registered as depicted below



¹⁶ Reg. No. 2,001,610, issued on September 17, 1996, which sets forth a date of first use anywhere and in commerce of October 1992 for the goods in International Class 14, 1984 for the goods in International Class 21 and 1982 for the goods in International Class 25; combined affidavit §§8 and 15.

¹⁷ Reg. No. 2,039,686, issued on February 25, 1997 with a claim of acquired distinctiveness as to the term "USA," which sets forth a date of first use anywhere and in commerce of January 22, 1995. The word "PARTS" is disclaimed.

¹⁸ Reg. No. 2,226,116, issued on February 23, 1999, which sets forth a date of first use anywhere of November 13, 1997 and a date of first use in commerce of November 20, 1997.

for "retail stores featuring automotive parts and accessories" in International Class 35;¹⁹ and

(4) the mark "PEP BOYS. LOS AUTOS NOS QUIEREN. LA GENTE NOS ADORA.," which is registered for "retail stores featuring vehicle parts and related accessories" in International Class 35 and "vehicle repair and maintenance" in International Class 37.²⁰

The record also reveals that opposer is a retailer of automotive parts and accessories as well as a provider of automotive repair and maintenance services. Opposer renders such services through a chain of stores, all of which are owned and managed by opposer rather than operated as franchises. As of the testimony of opposer's witnesses on August 28, 2001, opposer was operating 629 stores in 36 states and Puerto Rico, an increase from the 313 stores which it operated in 17 states as of 1990. Opposer occupies a position in the automotive after-market, in light of its most recent retail sales being in excess of two billion dollars, which places it among the "leaders who provide automotive service and sell parts and accessories." (Stampone dep. at 17.) While the largest companies in such field do, on the parts side of the business, "in the neighborhood of three and an half to \$4 billion" and operate "thousands of stores," opposer still ranks, in terms of number of stores, "within the top five

¹⁹ Reg. No. 2,228,755, issued on March 2, 1999, which sets forth a date of first use anywhere of November 13, 1997 and a date of first use in commerce of November 20, 1997. The mark is lined for the colors red and blue.

²⁰ Reg. No. 2,345,076, issued on April 25, 2000, which sets forth a date of first use anywhere and in commerce of August 1998 for the services in both classes. The English translation of the mark is: "PEP BOYS. CARS LIKE US. PEOPLE LOVE US."

Opposition No. 108,772

among automotive parts retailers." (Id.) Opposer "enjoyed a similar share of [the parts] market in 1990, although its "share of the after market would have been larger than it is today" because "many of the automotive parts chains [with which it competes] have grown faster since 1990 than Pep Boys." (Id. at 18.)

Measured by the number of service bays in its stores, opposer as of August 28, 2001 "rank[ed] among the top five [automotive service providers] in the country," "operating over 6500 bays." (Id. at 17.) In terms of Pep Boys['] size within the automotive service provider category, the larger service and tire chain[s] such as Firestone and Goodyear have probably grown at about the same rate as Pep Boys," so that opposer's market "share would probably have been in 1990 similar to what it is today." (Id. at 18.) Thus, "[b]y virtually any account, Pep Boys is among the nations [sic] leading automotive after-market parts and service providers." (Id. at 17.)

Founded in 1921, opposer was originally known as "Pep Auto Supply," but changed its name to "Pep Boys" sometime in the 1920s. Opposer derived its name as follows:

Manny and Moe, [the two founders of opposer,] ... were sitting in the back room on a case of Pep Valve Grinding Compound One guy said that's a great name, that connotes high energy, the word pep. So they were convinced that word would lend a lot of success for an otherwise generic automotive company.

The rest of the story relates to an experience with a motorist in Philadelphia who was cited by a policeman for his headlights not working properly. He basically pulled this person over and said,

you should go and see the boys down at Pep. They had become such a popular place for motorists back in those days.

They took on the meaning of being one of the boys, which in Philadelphia is kind of a term that's used with a warm and friendly connotation. To be referred to as "one of the boys" is one of the members of an elite club.

That reference by this policeman repeatedly caused enough of awareness within Manny and Moe [that they thought] why don't we add that to the name. Consequently, the name was changed from Pep Auto Supplies to Pep Boys.

(Id. at 12-14.)

Basically, opposer "sells a broad assortment of automotive parts, tires, accessories and supplies," including "head lamps" and "[a]llmost any after-market part you can put on a vehicle." (Furtkevic dep. at 8-9.) It "also provide[s] complete automotive diagnostic and repair services" at "[a]ll but 12" of its stores. (Id. at 9.) Likewise, according to another of its witnesses, opposer "offer[s] roughly 35,000 different automotive parts, accessories, chemicals, tires, and related automotive supplies" in addition to providing "a vast assortment of automotive maintenance and repair services." (Stampone dep. at 5-6.)

With respect to the specific kinds of goods for which applicant seeks registration of its mark, namely, "light fixtures for vehicles," Mr. Furtkevic testified in particular on direct examination as follows:

Q Does Pep Boys actually sell light fixtures for vehicles in its stores?

A Absolutely, yes, we do.

Q What are the various light fixtures you sell in the stores?

A We sell head lamps primarily. We also sell other bulbs that are used in cars; parking lights; break [sic] lights, turn signal bulbs, bulbs that go in your trunk, glove box, inside the cabin of cars. Pretty much sums up most of the places you can put a light bulb in a car.

(Id. at 43-44.) Likewise, Mr. Stampone testified that, since at least 1989, opposer has continuously sold lights for automobiles, including fog lights, headlights and light bulbs for land vehicles, and confirmed that a 1955 catalog by opposer (Exhibit 44) advertises auto bulbs, fog lamps, back up lamps and headlamps. Opposer, he also noted, has advertised automobile lights in its most recent television advertising.

However, as shown by its Exhibits 42A-C, the head lamps or headlights sold by opposer in its retail stores bear the "SYLVANIA" brand name. Nothing in the record, including various catalogs introduced by opposer, demonstrates that opposer has ever used any of its "PEP BOYS" marks, or variations thereof, as trademarks for any vehicle lighting fixtures, such as head lamps or headlights, although it has repeatedly advertised those goods, along with a wide range of other automotive after-market parts and accessories, under its various "PEP BOYS" service marks and variants thereof.

Opposer uses the name "PEP BOYS" as a service mark on the building façade of all of its retail outlets, in its print advertising and promotional materials, including brochures,

Opposition No. 108,772

catalogs, newspaper ads and direct mail pieces, on its in-store point-of-purchase graphics, and in connection with its television, radio and Internet advertising. Its national television advertising, for example, airs primarily on sports programs and is done on the following networks: "ABC; NBC; Fox; PBS; ESPN; ESPN2; TNT; TNN[;]" and "CBS." (Id. at 16.) In 2001, it conducted local television advertising, mostly on sports shows, "in Los Angeles, Philadelphia, Dallas, Fort Worth and Atlanta." (Id. at 17.) During the same year, opposer's ads appeared in newspapers such as the Atlanta Journal Constitution, Philadelphia Inquirer, Los Angeles Times, USA Today and Miami Herald. Opposer, under the domain name "pepboys.com," has also had a website since about 1994.

As to its various promotional activities, opposer in 2001 was "the presenting sponsor of the Pennsylvania 500, which is a Winston Cup NASCAR race on TNT," and was "a race sponsor of the NHRA 50 Anniversary Race in Pomona, California." (Id. at 29.) In 2000, it was "the title sponsor of the great outdoor games ... on ESPN" and, "for two years, 1997 and '98," it was "the title sponsor of the Indy Racing League, which includes the single largest spectator event in the world, [namely, the] ... Indianapolis 500." (Id. at 29-30.) Much earlier, "the infamous Pep Boys Snowman Aircraft, which was a flight piloted by Admiral Bird to the South Pole back in 1933," was "[o]ne of many promotional events that Pep Boys has sponsored or been involved with in some way over the years." (Stampone dep. at 14.) Other promotional activities by opposer, besides sponsorship of

sporting events, presently include in-store promotions and cross-promotions of its products and services, such as various rebate programs.

As another method of promoting itself, opposer, around the mid-1990s, produced a catalog "to advertise and sell licensed logo-bearing merchandise," including sweaters, sweatshirts, uniform shirts and sport bottles bearing its "PEP BOYS" and design mark and polo shirts, jackets, pullovers, sweatshirts, sweaters, sport shirts, t-shirts, boxer shorts, caps, duffel bags, sport bottles, collectible trucks, mugs, umbrellas and pens featuring its "THE PEP BOYS" and design mark. (Furtkevic dep. at 30-31.) According to Mr. Furtkevic, opposer "actually distributed all of this merchandise, but today most of it is no longer manufactured with the exception of" such items as polo shirts, caps and collectibles. (Id. at 31.) In addition, "[b]ased upon various promotions," opposer still "will engage a promotional company to manufacture premium items that contain the Pep Boys mark like pens, tablets, other wearable products, hats, [and] key chains." (Id. at 31-32.) Such goods are "[d]istributed to employees and are also distributed [to the public at large] at ... NASCAR events, motor sports events, races, [and] other things like that" in which opposer participates as an event sponsor. (Id. at 32.) Moreover, coffee mugs bearing opposer's "PEP BOYS" and design mark are sold in its retail stores and such mark has been used on a disposable camera, which was offered as a premium item to its customers during "the

Opposition No. 108,772

winter of 2000 to promote usage of the Pep Boys private label Credit Card." (Id. at 33.)

Opposer has been the subject of publicity, receiving mention, for instance, on a radio newscast for its initiation of a job-training partnership program with the Urban League in the City of Los Angeles. Opposer also gained notoriety, according to Mr. Furtkevic, in 1990 when, "during the Great American Smoke Out, we decided to remove the cigar from the Manny character of the brand symbol and that act garnered national media attention on the cover of USA Today" and "it was also featured in the Philadelphia Inquirer." (Id. at 37.) Moreover, besides "photocopies of various press clippings that represent ... print publicity ... received over the past number of decades" (Id. at 38), Mr. Furtkevic notes that other instances in which opposer and the designation "PEP BOYS" have received publicity include the following:

Pep Boys has been mentioned on NBC with the Manny, Moe and Jack characters. We've been repeatedly mentioned and depicted by Jay Leno as part of the Tonight Show broadcast and Late Night with David Letterman. Pep Boys was actually referred to in the 1959 film, "Auntie Mame," starring Rosaline Russell.

There have been other instances like that where Pep Boys has been featured in films or television programming. There was an episode of the Simpsons [television show] where Manny, Moe and Jack, in an animated fashion, were shown coming off of the façade of one of our buildings and delivered a few lines

(Id. at 37.) Several requests for licenses have also recently been granted by opposer, giving the licensees "permission to use

the Pep Boys name and/or marks in feature film or entertainment programming that they're currently producing." (Id. at 41.)

For fiscal years 1985 through 2000, opposer's (and its subsidiaries') "merchandise sales," which consist of sales of all products marketed at retail, including those sold under various "PEP BOYS" and "PEP BOYS" and design marks as well as such third-party brands as, for example, "SYLVANIA," have generally increased on an annual basis from nearly \$367 million in 1985 to a peak of almost \$2 billion in 1998, with a small decrease from such amount in 1999 before rebounding slightly in 2000.²¹

Opposer's (and its subsidiaries') "service revenue," which is the labor charged to customers, has steadily increased each year from around \$22 million in 1985 to almost \$461 million in 2000.²²

Together, merchandise sales and service revenue constitute opposer's (and its subsidiaries') "total net sales," which have progressively climbed from just under \$389 million in 1985 to just over \$2.418 billion in 2000.²³

²¹ Specifically, as set forth in opposer's publicly available annual reports, merchandise sales totaled \$366,707,000 in 1985, \$452,650,000 in 1986, \$505,583,000 in 1987, \$586,162,000 in 1988, \$703,487,000 in 1989, \$774,502,000 in 1990, \$873,381,000 in 1991, \$1,008,191,000 in 1992, \$1,076,543,000 in 1993, \$1,211,536,000 in 1994, \$1,355,008,000 in 1995, \$1,554,757,000 in 1996, \$1,720,670,000 in 1997, \$1,991,340,000 in 1998, \$1,954,010,000 in 1999 and \$1,957,480,000 in 2000.

²² In particular, opposer's service revenues were \$22,207,000 in 1985, \$33,248,000 in 1986, \$48,181,000 in 1987, \$69,806,000 in 1988, \$95,204,000 in 1989, \$110,172,000 in 1990, \$128,127,000 in 1991, \$147,403,000 in 1992, \$164,590,000 in 1993, \$195,449,000 in 1994, \$239,332,000 in 1995, \$273,782,000 in 1996, \$335,850,000 in 1997, \$407,368,000 in 1998, \$440,523,000 in 1999 and \$460,988,000 in 2000.

²³ Such sales ranged from \$388,914,000 in 1985, to \$485,899,000 in 1986, \$553,764,000 in 1987, \$655,968,000 in 1988, \$798,691,000 in 1989, \$884,674,000 in 1990, \$1,001,508,000 in 1991, \$1,155,594,000 in 1992, \$1,241,133,000 in 1993, \$1,406,985,000 in 1994, \$1,594,340,000

"Gross media" expenditures by opposer (and its subsidiaries), which include "any type of advertising ... done" (e.g., print, radio and television ads), have for the most part risen from nearly \$12 million in 1985 to a high of over \$53 million in 1998 before falling by about a million dollars in 1999 and again in 2000.²⁴ (McElroy dep. at 8.) In all, "after 80 years of promotion ... through hundreds of millions of dollars of national and local advertising in very prominent newspapers and [on] national broadcasts and national cable television programs," opposer's witness, Mr. Stampone, was of the opinion that "the Pep Boys name and the Manny, Moe and Jack icons associated with Pep Boys are extremely famous and somewhat invaluable to this company." (Stampone dep. at 19.)

The only information of record about applicant and its mark comes from its responses to opposer's discovery requests.²⁵ Specifically, applicant has indicated that has used its "ROAD BOY" and design mark in the United States exclusively in connection with the goods recited in its opposed application;

in 1995, \$1,828,539,000 in 1996, \$2,056,520,000 in 1997, \$2,398,708,000 in 1998, \$2,394,533,000 in 1999 and \$2,418,468,000 in 2000.

²⁴ Specifically, such expenditures totaled \$11,936,000 in 1985, \$18,601,000 in 1986, \$21,470,000 in 1987, \$27,312,000 in 1988, \$33,512,000 in 1989, \$39,154,000 in 1990, \$41,758,000 in 1991, \$40,346,000 in 1992, \$40,293,000 in 1993, \$40,825,000 in 1994, \$36,614,000 in 1995, \$41,069,000 in 1996, \$41,430,000 in 1997, \$53,189,000 in 1998, \$52,334,000 in 1999 and \$51,153,000 in 2000.

²⁵ While such responses, which as previously noted have been made of record by opposer, curiously indicate among other things that applicant "denies" that "[o]pposer's Pep Boys stores are part of the United States automotive after[-]market," the preponderance of the evidence plainly demonstrates that opposer's retail outlets are part of such market. (Opposer's Request for Admission No. 28 and response thereto.)

Opposition No. 108,772

that applicant was aware of opposer, and that its various "PEP BOYS" marks were being used by opposer in the United States, before applicant selected and first used its applied-for mark; that applicant expects to continue using its "ROAD BOY" and design mark in the United States in the same manner as it presently does, which includes the use thereof on the exterior of boxes for the goods in such a fashion that the mark may be visible on the shelves of retail outlets; and that while some vehicle service retail stores may sell vehicle parts, such retailers typically do not sell goods of the kind set forth in the opposed application. Applicant admits, however, that goods of the type identified in its application can be found in retail stores featuring automotive products and are intended to be sold at such stores, although not exclusively at those outlets.

Similarly, applicant further admits that its goods, including those marketed under its "ROAD BOY" and design mark, are sold in the automotive after-market through such channels of trade as retail stores which feature automotive products, but that such are not the exclusive channels of trade for its goods. Applicant, more broadly speaking, also admits that light fixtures for vehicles, fog lights, headlights for automobiles and light bulbs for land vehicles are all sold in the automotive after-market, but that such products are not sold exclusively in the automotive after-market. Finally, contrary to applicant's contention with respect to the sole evidence which it submitted

on its behalf, there is no admission by opposer that opposer is unaware of any instances of actual confusion.²⁶

Turning first to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that on this record opposer has not shown that applicant's "ROAD BOY" and design mark, when used in connection with light fixtures for vehicles, namely, lights for automobiles, fog lights, headlights for automobiles, and light bulbs for land vehicles, so resembles one or more of opposer's "PEP BOYS" marks, including those with its "PEP BOYS" logo, which opposer uses in connection with its various goods and services as to be likely to cause confusion, mistake or deception with respect to the source or sponsorship thereof. We acknowledge, as a starting point, that with respect to the *du Pont* factors of the similarity or dissimilarity of the goods and/or services and the similarity or dissimilarity of established, likely to continue trade channels, such factors favor opposer. Applicant's goods are related to opposer's goods and services in that the respective products are sold in the automotive after-market through, inter alia, retail stores which, like opposer's retail outlets, feature the sale of vehicle parts and accessories.

²⁶ Although applicant has shown that it requested opposer to admit that opposer "is unaware of any instances of actual confusion that have resulted from the use of (1) trade names, trademarks and/or service marks comprising 'ROAD BOY' by Applicant, and (2) trade names, trademarks and/or service marks comprising 'PEP BOYS' by Opposer," opposer's response thereto was an objection "to this request as assuming facts not in evidence, and as vague and indefinite." (Applicant's Request for Admission No. 1 and response thereto.)

Opposition No. 108,772

Applicant, in fact, admits that vehicle light fixtures, including those which it sells under its "ROAD BOY" and design mark, are sold in the automotive after-market and that such goods can be found in retail stores featuring automotive products and are intended to be sold at such stores.

Nothing in the record demonstrates, however, that applicant's goods would ever be sold under its "ROAD BOY" and design mark in *opposer's* retail automotive parts, accessories and vehicle service and maintenance centers since, obviously, *opposer* would not be expected to foster (or be heard to complain about) a situation which, due to its own actions, would lead to what it contends is a likelihood of confusion with the products and services which it offers under its "PEP BOYS" marks. Moreover, nothing in the record reveals that the products and services which *opposer* markets under its "PEP BOYS" marks have ever been or would be offered anywhere other than through its own retail automotive parts, accessories and vehicle service and maintenance centers.

Nonetheless, it is well settled that the registrability of an applicant's mark must be evaluated on the basis of the identification of goods as set forth in the involved application and the identifications of the goods and/or services as recited in any pleaded registrations of record, regardless of what the record may reveal as to the particular nature of the respective goods and/or services, their actual channels of trade, or the classes of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer

Opposition No. 108,772

Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). It is also well established that, absent any specific limitations or restrictions in the identification of goods as listed in an applicant's application and in the identifications of goods and services as set forth in an opposer's registrations, the issue of likelihood of confusion must be determined in light of consideration of all normal and usual channels of trade and methods of distribution for the respective goods and services. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as identified in the respective application and registrations, neither applicant's "light fixtures for vehicles, namely, lights for automobiles, fog lights, headlights for automobiles, [and] light bulbs for land vehicles" nor opposer's automotive parts, accessories and collateral items contain any restriction or limitation as to the channels of trade or classes of purchasers for such products. The respective goods must therefore be presumed to be available, for example, through third-party retailers of automotive after-market parts, accessories and collateral merchandise, including retailers which, like opposer, additionally offer vehicle maintenance and repair services. Similarly, even if opposer's goods and services

Opposition No. 108,772

are regarded as being marketed, under its various "PEP BOYS" marks, only in its own retail stores, it is common knowledge that consumers of after-market automotive parts, accessories and collateral merchandise, as well as customers for vehicle repair and maintenance services, may cross-shop different retailers thereof, including those providers which offer automotive parts and other merchandise together with vehicle care and repair services.

Moreover, aside from consideration of the broad manner in which applicant's goods and opposer' goods and services are set forth in the respective application and registrations, the record clearly shows that opposer has for many years continuously sold at retail such vehicle lights as fog lights, headlights and light bulbs for land vehicles, and has advertised those goods in conjunction with its other automotive supplies and services. Retail customers, therefore, have become accustomed to finding the kinds of vehicle lights marketed by applicant being offered for sale in opposer's retail automotive parts and accessories stores, and such outlets, almost without exception, also feature vehicle repair and maintenance services. The respective goods and services at issue herein, and the established, likely-to-continue channels of trade therefor, are in short so similar or closely related in a commercial sense that, if such goods and services are sold or advertised under the same or substantially similar marks, confusion as to the origin or affiliation thereof would be likely to result.

Opposition No. 108,772

Applicant maintains, however, that confusion is not likely because, with respect to the *du Pont* factor which concerns the conditions under which and buyers to whom sales are made, "[t]he decision whether to purchase the goods of the opposed application ... would be carefully made" inasmuch as "[a] prudent driver does not haphazardly select headlights. Rather, the purchase is a measured decision in view of the possible consequences of [an] incorrect decision." While clearly, in view of their nature, vehicle lighting fixtures such as fog lights and automobile headlights are not "impulse" items in the sense that they are subject to frequent replacement or, as opposer insists in its reply brief, are so inexpensive as to result in "a low level of care in the purchasing decision," neither is there any evidence of record that the purchase of such goods would be carefully made by sophisticated and highly knowledgeable buyers. Instead, what evidence there is with respect to customers for vehicle light fixtures and the conditions under which sales of such goods are made indicates that fog lights, headlights for automobiles and other vehicle lights would be purchased by ordinary consumers (members of the general public) who would exercise ordinary, reasonably prudent care to select products appropriate for their vehicles. Thus, the conditions under which and buyers to whom sales are made is a *du Pont* factor which, as opposer maintains, favors opposer instead of applicant.

Another *du Pont* factor in its favor, opposer insists, is that there is no evidence in the record that there are similar third-party marks containing the words "BOYS" or "BOY" which are

in use for similar products. However, suffice it to say that the absence of any evidence with respect to the *du Pont* factor of the number and nature of similar marks in use on similar goods does not constitute evidence of absence. There simply is no evidence in the record with respect to such factor; it therefore is not applicable to the issue of likelihood of confusion.

Opposer further contends that another *du Pont* factor in its favor is the asserted fame of its "PEP BOYS" marks. Although, as applicant notes in its brief, there are plainly some problems with the evidence presented by opposer concerning the alleged fame of its "PEP BOYS" marks, on the whole the record is considered sufficient to establish such fame, at least for purposes of likelihood of confusion. This is because the designation "PEP BOYS," which constitutes the entirety or a dominant and distinguishing portion of opposer's "PEP BOYS" marks, has been satisfactorily demonstrated to be famous in the after-market for automotive parts, accessories and collateral items as well as with respect to retail store services which feature such merchandise and with respect to vehicle repair and maintenance services.

Among other things, while the sales and advertising figures offered by opposer cover, in particular, all merchandise sold and advertising expenditures made by opposer and its subsidiaries, and thus include goods sold and advertised under marks other than just its "PEP BOYS" marks (e.g., "SYLVANIA" brand headlights), the failure to break down such amounts to those attributable solely to opposer's "PEP BOYS" marks is not

Opposition No. 108,772

considered fatal to opposer's claim that its marks are famous. The reason therefor is that even if the actual amounts of the sales revenues and advertising outlays which pertain to opposer's own "PEP BOYS" brands of automotive products, accessories and collateral merchandise were somehow not reflective of a substantial portion of its total sales figures and advertising costs, the fact remains that all of opposer's sales and its promotional activities have occurred in connection with the retail automotive parts and accessories store services and vehicle repair and maintenance services which it renders under its various "PEP BOYS" marks.

In addition, while it is curious that, for a number of its registered marks (e.g., "PEP BOYS PARTS USA" and design; "PEP BOYS EXPRESS," with and without design; and "PEP BOYS. LOS AUTOS NOS QUIEREN. LA GENTE NOS ADORA."), opposer has not provided any evidence as to the extent of their use or manner of promotion, so that it is not possible to conclude that such marks in their entirety have individually become famous, it is clear from the record that the designation "PEP BOYS" in its "PEP BOYS" marks is, as indicated above, famous for purposes of whether there is a likelihood of confusion. The record, in this regard, variously shows that in addition to the sales and advertising figures discussed previously, the designation "PEP BOYS" has been continuously used as a service mark in connection with opposer's retail automotive parts and accessories store services for nearly 80 years and has also been extensively so used for many years in connection with opposer's vehicle maintenance and repair

Opposition No. 108,772

services, which are currently rendered at all but 12 of its retail stores. Opposer operates a chain of 629 company-owned stores in 36 states and Puerto Rico, an increase from the 313 such stores which it operated in 17 states as of 1990. In terms of number of stores, opposer presently ranks within the top five among automotive parts retailers and enjoyed a similar and even larger share of such market in 1990. Thus, in the automotive after-market, opposer's sales position places it among the leaders in terms of selling parts and accessories and providing maintenance and repair services. Similarly, as measured by the number of service bays in its stores, opposer ranks among the top five automotive service providers in the country, currently operating over 6500 service bays, and had a similar share of such market in 1990.

Additional evidence of the fame of the designation "PEP BOYS" includes the fact that such has appeared as a service mark on the building façade of all of opposer's retail outlets, in its print advertising and promotional materials, including brochures, catalogs, newspaper ads and direct mail pieces, on its in-store point-of-purchase graphics, and in connection with its national television, radio and Internet advertising. Opposer also has promoted the designation "PEP BOYS" in connection with its sponsorship of several auto racing and drag racing events, including NASCAR's Pennsylvania 500 Winston Cup race, the NHRA's 50 Anniversary Race and, as title sponsor thereof, the Indy Racing League's presentation of the largest spectator event in the world, the Indianapolis 500 auto race. Furthermore, opposer

Opposition No. 108,772

has promoted itself by producing, in the mid-1990s, a catalog by which it advertised, sold and/or gave away licensed logo-bearing merchandise, including items of apparel, bearing its "PEP BOYS" and design mark and its "THE PEP BOYS" and design mark. Opposer, as noted earlier, has for many years been the subject of publicity for various civic activities, which have served to promote the "PEP BOYS" designation, and it also has been mentioned in certain television programs and films. Other evidence of fame is the receipt by opposer of several requests for licenses, which opposer has granted, giving its licensees permission to use the "PEP BOYS" name and/or marks in feature film or entertainment programming that are being produced. Accordingly, while conclusory, the record supports, and nothing therein contradicts, the opinion by opposer's witness, Mr. Stampone, that "after 80 years of promotion ... through hundreds of millions of dollars of national and local advertising in very prominent newspapers and [on] national broadcasts and national cable television programs," the evidence shows that "the Pep Boys name and the Manny, Moe and Jack icons associated with Pep Boys are ... famous" (Id.)

As noted by our principal reviewing court in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992), "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." The Federal Circuit reiterated these principles in

Opposition No. 108,772

Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), stating that "the fifth *DuPont* factor, fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *DuPont* factors," citing, inter alia, *Kenner Parker Toys*, 22 USPQ2d at 1456, and reaffirmed that "[f]amous marks thus enjoy a wide latitude of legal protection." Nevertheless, famous or strong marks, in legal contemplation, are not the same as rights in gross, which would preclude the registration to another of the same or similar mark(s) for any goods and services. For instance, even though famous or strong marks are entitled to a wide latitude of legal protection, the court in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), underscored in its reversal of the Board's finding of a likelihood of confusion that "the Board gave too much weight to certain *DuPont* factors, such as the strength of opposer's mark, and failed to give due weight to countervailing *DuPont* factors, such as the sophistication of purchasers." As set forth in *du Pont*, supra, "[t]he evidentiary elements are not listed ... in order of merit" inasmuch as "[e]ach may from case to case play a dominant role."

Thus, while opposer's heavy reliance upon the fame of its "PEP BOYS" marks is an important and significant factor, along with several others previously discussed, in its favor, such factors are not sufficient to support a finding of likelihood of confusion when another pertinent *du Pont* factor, namely, the similarity or dissimilarity of the marks at issue

Opposition No. 108,772

when considered in their entireties as to appearance, sound, connotation and commercial impression, weighs overwhelmingly in applicant's favor. Opposer argues, however, that applicant's "ROAD BOY" and design mark "is confusingly similar to" opposer's "PEP BOYS" and design marks "in sight, sound and meaning," contending that because applicant's mark "consists of two elements: the terms 'ROAD' and 'BOY,'" opposer's "PEP BOYS" marks are "virtually identical with similar elements that convey the same commercial impression." In particular, opposer further maintains that because "[b]oth Applicant's and Opposer's marks contain BOY/S as the second word of (usually) a two word mark," such fact "weighs in favor of opposer, especially since the term BOY is completely arbitrary as used in connection with either Applicant's goods or the goods and services offered under Opposer's PEP BOYS mark[s]." Opposer also insists that because "[t]he first term of Applicant's mark ('ROAD') is descriptive in light of the automotive nature of Applicant's goods," "it will have little, if any, distinguishing impact on the mark's commercial impression" and "[t]he word 'BOY' thus will predominate." Finally, noting that some of opposer's "PEP BOYS" marks feature "a fanciful design of, and a textual reference to, Pep Boys' founders, 'MANNY, MOE & JACK,'" opposer asserts that applicant "seeks to play off these ... characters by including a design element which depicts two characters of its own in its mark. According to opposer, "[t]he fact that Applicant chose to employ in its mark a fanciful design of two, and not three characters is of no moment" inasmuch as "the design element of

the opposed mark only exacerbates the confusing similarity" thereof with respect to those of opposer's "PEP BOYS" marks which feature the named characters of "MANNY, MOE & JACK" and/or their caricatures.

We concur with applicant, however, that its "ROAD BOY" and design mark is so different in sound, appearance, connotation and commercial impression from opposer's "PEP BOYS" marks as to preclude any likelihood of confusion. The sole similarities therein, namely, the presence of either the word "BOY" or "BOYS" as the second of the literal elements of the respective marks, are outweighed by the numerous differences, in each instance, when the respective marks are considered in their entireties. To state the obvious, the term "ROAD" in applicant's "ROAD BOY" and design mark simply does not sound or look at all like the term "PEP" in opposer's marks, nor do such terms have the same or similar connotation or engender the same or similar commercial impression, even when respectively paired with the words "BOY" and "BOYS."

In particular, not only does the word "ROAD" in applicant's mark sound completely different from the word "PEP" in opposer's marks, but as applicant points out in its brief, its mark visually features "a unique design and a unique style of type that is integral with the words of the mark." Specifically, as applicant accurately notes, while the design between the words "ROAD" and "BOY" in its mark is described in its application as "a silhouette of two men," "[t]here is nothing in any of the marks asserted by Opposer that even remotely resembles" such

design. The faces of the Manny, Moe and Jack caricatures in opposer's "PEP BOYS" and design marks, as applicant further observes, are smiling and "exude warmth and welcome," whereas the heads on the two stick-figures seen in silhouette in applicant's "ROAD BOY" and design mark are merely two small dots. Such figures, moreover, "are not immediately recognizable as people." In addition, as to the unique stylization of its mark, applicant properly points out that while "[e]ach of the letters R, A, D, B, and Y are in a unique style of print," "the 'O' of 'ROAD' and the 'O' of 'BOY' are identical [in style], and comprise a design that is different from the style of print used for the other letters" and which "[t]o some ... may suggest headlights" or fog lights.²⁷ Such features are totally missing from opposer's marks.

Furthermore, we agree with applicant that, in terms of connotation and overall commercial impression, the respective marks are significantly different. Applicant's "ROAD BOY" and

²⁷ Although some of opposer's marks are, of course, registered in a typed format and, thus, are not restricted to a particular manner of display, see, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in a typed format is not limited to the depiction thereof in any special form], such a format does not mean that the marks must be considered in all possible stylized forms. Rather, as indicated in *Jockey Int'l Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235 (TTAB 1992), when a registration sets forth a mark in a typed format, the issue of likelihood of confusion is considered on the basis of all reasonable manners in which the mark could be displayed, citing *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [a party has] ... a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word] could be depicted"]. Here, all of the letters in applicant's mark, including the two letters "O" which are suggestive of headlights or fog lights, are depicted in such unique and uncommon stylizations that it is unreasonable to presume, for purposes of assessing whether there is a likelihood of confusion, that opposer would display its typed format marks in the same or a similar manner.

design mark, as applicant persuasively notes in its brief, "creates an impression of a single boy who likes to be on the road, or who has something to do with the road," while the term "PEP BOYS" in opposer's various "PEP BOYS" marks signifies boys with high energy. Although, on this record, the word "BOY" and its plural "BOYS" appear to be arbitrary or fanciful when used in connection with the parties' goods and services, we find nothing which supports opposer's contention that the word "ROAD" in applicant's "ROAD BOY" and design mark is merely descriptive of applicant's vehicle light fixtures and, hence, such word "will have little, if any, distinguishing impact on the mark's commercial impression" so that "[t]he word 'BOY' thus will predominate." Instead, the word "ROAD" is no more than suggestive when used in connection with applicant's automotive products and serves to distinguish applicant's mark in overall connotation and commercial impression, as well as in terms of sight and sound, from opposer's "PEP BOYS" marks.

Accordingly, notwithstanding the *du Pont* factors, including fame, which favor opposer, we find that there is no likelihood of confusion from the contemporaneous use by applicant of its "ROAD BOY" and design mark in connection with light fixtures for vehicles, namely, lights for automobiles, fog lights, headlights for automobiles and light bulbs for land vehicles, and the use by opposer of any of its "PEP BOYS" marks for its various goods and services inasmuch as such factors are decisively outweighed by the significant differences in sound, appearance, connotation and commercial impression between the

respective marks. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) [Board, in finding no likelihood of confusion between mark "CRYSTAL CREEK" for wine and marks "CRISTAL" for wine and "CRISTAL CHAMPAGNE" for champagne, did not err in relying solely on dissimilarity of marks in evaluating likelihood of confusion and failing to give surpassing weight to other *du Pont* factors, all of which favored a likelihood of confusion; court noted that "we have previously upheld Board determinations that one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks"] and *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) [Board, in finding no likelihood of confusion between mark "FROOTEE ICE" and elephant design for packages of flavored liquid frozen into bars and mark "FRUIT LOOPS" for, *inter alia*, cereal breakfast food, correctly held that "a single *duPont* factor--the dissimilarity of the marks--was dispositive of the likelihood of confusion issue"; court observed that "[w]e know of no reason why, in a particular case, a single *duPont* factor may not be dispositive"].

Turning now to the claim of dilution, Section 43(c)(1) of the Trademark Act, as made applicable to this proceeding by Section 13 of the Trademark Act,²⁸ provides in relevant part that:

²⁸ Applicant argues in its brief that a dilution claim should not be available against an application, like the one involved herein, which was filed prior to the date of enactment of the Trademark Amendments Act of 1999 because Congress had no valid legislative purpose in so providing. Specifically, applicant asserts in its brief that:

The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark . . . , if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to--

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks owner and the person against whom the injunction is sought;

In the Trademark Amendments Act of 1999 (TAA), Congress provided that opposition and cancellation proceedings may be based on claims of dilution. See 15 U.S.C. §§1063(a) and 1063. Congress further provided that claims of dilution may be raised against applications for registrations filed on or after January 16, 1996, even though TAA was not enacted until August 5, 1999. . . . Retroactive application of a new statute must be supported by a valid legislative purpose, and Congress provided no such purpose.

Suffice it to say, however, that because it is beyond the jurisdiction of the Board to determine whether Congress had a valid legislative purpose in making certain dilution claims retroactive, the statutory provision which so provides is accordingly presumed to be valid. In view thereof, and inasmuch as applicant's application, as indicated previously, was filed on July 18, 1996, it is properly subject to a dilution claim. See, e.g., *Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000) and *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703 (TTAB 2000).

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

"Dilution" is in turn defined in Section 45 of the Trademark Act as follows:

The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of--

(1) competition between the owner of the famous mark and other parties, or

(2) likelihood of confusion, mistake or deception.

In view thereof, we must determine in this case whether opposer's "PEP BOYS" marks are famous and distinctive, and if so, whether applicant's use of its mark began after opposer's marks had become famous and whether such use causes dilution of the distinctive quality of opposer's marks, in the sense of the lessening of the capacity of the marks to identify and distinguish goods or services. Here, because there is no testimony or other proof as to the March 16, 1990 date of first use anywhere and June 1, 1990 date of first use in commerce alleged in applicant's application, the earliest date upon which applicant can rely in this proceeding is the July 18, 1996 date of constructive use provided by the filing date of its application. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974);

Opposition No. 108,772

Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); Zirco Corp. v. American Tel. & Tel. Co., 21 USPQ2d 1542, 1544 (TTAB 1991); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Cf. Toro Co. v. ToroHead Inc., 61 USPQ2d 1164, 1174-75 (TTAB 2001).

Opposer, collectively referring to its various registered marks in the singular as "the PEP BOYS mark," insists in its main brief that the record "amply demonstrates that the PEP BOYS mark was famous long prior to the priority date of the opposed application, namely its July 18, 1996 filing date." In particular, as to the asserted fame of its registered marks, opposer urges, after a discussion of the statutory factors which may be considered in determining whether a mark is distinctive and famous, that (underlining in original):

In short, PEP BOYS, in any context, means Opposer, and only Opposer. It is apparent that by any and every measure, Opposer's PEP BOYS mark is "distinctive and famous,["] warranting protection under Section 43(c) of the Lanham Act If "Pep Boys" is not a famous and distinctive mark then no mark merits such label.

Finally, with respect to whether applicant's use of its "ROAD BOY" and design mark causes dilution of the distinctive quality of opposer's registered "PEP BOYS" marks, opposer contends in its main brief that applicant's "ROAD BOY mark is identical or very or substantially similar to the PEP BOYS mark." In view thereof, and inasmuch as "the relevant statute expressly states that 'likelihood of confusion' is *not* required" (italics in original), opposer concludes that, while it "need not make a showing that

customers are likely to believe that ROAD BOY is a Pep Boys product, ... the ROAD BOY mark surely dilutes and whittles away the distinctive quality [of the PEP BOYS mark]--especially when the ... use is in the very field (long) occupied by Pep Boys."

Applicant, on the other hand, contends that opposer's dilution claim must fail inasmuch as, *inter alia*, opposer "did not prove that any of the marks asserted by Opposer became famous before July 18, 1996" and did not show that "customers would ... see the mark ROAD BOY and Design ... as essentially the same" as opposer's various registered "PEP BOYS" marks. Opposer, in its reply brief, takes issue with both of applicant's contentions, reiterating its arguments that the evidence of record proves the requisite fame and distinctiveness of its marks and asserting that applicant's mark need only be similar, rather than the same or essentially identical, to opposer's marks. Specifically, as to the latter, and notwithstanding the Board's statement in *Toro*, supra at 1183, that in order to establish dilution by blurring,²⁹ "a party must prove more than confusing similarity; it must show that the marks are identical or 'very or substantially similar,'" opposer insists in its reply brief that "such a requirement is nowhere found in the statute and is not supported by the legislative history." According to opposer:

Indeed, the legislative history cited in *Toro v. ToroHead*, supra [at 1182], contradicts such a position:

²⁹ We note that there is no contention by opposer that applicant's mark causes dilution of opposer's marks through tarnishment.

Blurring occurs when one or more identical or similar marks are used on dissimilar products without authorization so that the distinctiveness of the famous mark is eroded.

Toro, supra, ... quoting, H.R. Rep. No. 106-250, at 5 (1999) (emphasis supplied). The Congressional Report further states: "If a mark is found to be famous, then the holder is entitled to bring a cause of action against the holder of a[n] identical or similar mark on a dissimilar product." See H.R. Rep. No. 106-250, at 5 (1999) (emphasis supplied). Congress, therefore, did not limit the new cause of action to unauthorized uses of a "very similar mark" or a "substantially similar mark"--it only said "similar marks."

As discussed previously with respect to the issue of likelihood of confusion, we note that with the exception of the mark which consists solely of the words "PEP BOYS," opposer has not bothered to show that each of its various "PEP BOYS" marks was indeed famous prior to the beginning of the constructive use of applicant's mark on July 18, 1996, so as to thereby meet an element of the proof necessary to establish a dilution claim. Nonetheless, in view of our disposition of the dilution claim, we will assume, at least with respect to opposer's "PEP BOYS" word mark for its retail automotive parts and accessories store services and vehicle repair and maintenance services, that such mark is not only famous, and was so prior to the date applicant's constructive use of its mark began,³⁰ but that opposer's "PEP

³⁰ We again note in this regard that opposer and applicant concur that such date is the date by which opposer must prove that its "PEP BOYS" marks are famous for purposes of the dilution claim. To the extent, nonetheless, that the statute should instead be read as requiring proof of fame prior to the beginning of applicant's commercial use of

BOYS" word mark is also distinctive. In particular, our assumptions as to fame and distinctiveness are warranted by, among other things, the evidence of record which shows that such mark has been registered on the Principal Register as an inherently distinctive mark; that the "PEP BOYS" word mark has been in use since at least the 1920s; that, whether measured by amounts of annual sales and promotional expenditures or by market share rankings, the use by opposer of its "PEP BOYS" word mark and the advertising thereof by opposer in all major media, along with the attendant publicity such mark has received, including requests by third-parties for licenses to use the mark in television and movie projects, has been extensive and generally has increased over the years; that the geographical extent of the trading area in which opposer's "PEP BOYS" word mark has been used has expanded to where such is essentially national in scope; and that such mark is highly recognized in the trading areas and channels of trade for the parties' respective goods and services.

We cannot conclude, however, that applicant's use of its "ROAD BOY" and design mark causes dilution of the distinctive quality of opposer's "PEP BOYS" word mark (or, for that matter, any of opposer's other registered "PEP BOYS" marks) because the respective marks simply are not so similar that the capacity of

its mark in commerce, which as alleged in the application (but not proven at trial) would be applicant's claimed June 1, 1990 date of first commercial use of its mark in commerce, we likewise will alternatively assume, at least with respect to opposer's "PEP BOYS" word mark for its retail automotive parts and accessories store services and vehicle repair and maintenance services, that such mark was famous prior to applicant's claimed June 1, 1990 date of first commercial use of its "ROAD BOY" and design mark. However, in light

the latter to identify and distinguish opposer's goods and services is lessened. The sole similarities between the respective marks is that they share the arbitrary or fanciful term "BOY(S)" as the second word of a two-word phrase. It is plain, however, that in light of the substantial differences imparted to applicant's "ROAD BOY" and design mark by the other elements therein, such mark is not "identical or very or substantially similar to the PEP BOYS mark," as contended by opposer, nor is it otherwise so similar thereto as to cause dilution. As was analogously the case in *Toro*, supra at 1183, in which the evidence was found to be insufficient to support a finding of dilution even when the plaintiff's marks were assumed to be famous, here "[a]pplicant's mark adds nontrivial features," including the presence of the word "ROAD" and the unique stylizations of the lettering therein, which appreciably change the look and sound of its mark and confer a significantly different connotation and overall commercial impression from those projected by opposer's marks. Applicant's "ROAD BOY" and design mark is, in short, so different that, as a matter of law, it cannot cause dilution of the distinctive quality of any of opposer's "PEP BOYS" marks.

Decision: The opposition is dismissed.

of our disposition of the dilution claim, this alternative assumption makes no difference in the result in this case.