

THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB

Mailed: March 14, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In-N-Out Burgers
v.
Fast Lane Car Wash & Lube, L.L.C.

Opposition No. 91183888
to application Serial No. 77234104

Robert J. Lauson of Lauson and Tarver LLP for In-N-Out Burgers.

Richard L. Schnake of The Law Firm of Neale & Newman LLP for
Fast Lane Car Wash & Lube, LLC.

Before Quinn, Cataldo and Hightower,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Fast Lane Car Wash & Lube, L.L.C. ("applicant") filed an application to register the mark IN & OUT CAR WASH, with "CAR WASH" disclaimed, on the Principal Register in standard characters, for "automobile cleaning and car washing; automobile washing; car washing; vehicle washing" in International Class 37.¹ Applicant filed the application based on use in commerce,

¹ Application Serial No. 77234104 was filed on July 19, 2007 and published for opposition in the *Official Gazette* on January 8, 2008.

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pursuant to Trademark Act § 1(a), 15 U.S.C. § 1051(a), asserting first use anywhere and in commerce as of April 15, 2005.

Registration has been opposed by In-N-Out Burgers ("opposer") on grounds of (1) priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and (2) dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).² Opposer, in its second amended notice of opposition, alleges that since as early as 1948, it has continuously used in interstate commerce the mark IN-N-OUT BURGERS in connection with drive-through restaurant services, and obtained a registration for its IN-N-OUT mark (Reg. No. 1085163) in connection with restaurant and carry-out restaurant services on February 7, 1978. Since that time, opposer has obtained registrations for marks containing the wording "IN-N-OUT" in standard characters as well as composite marks incorporating an arrow design and the wording "IN-N-OUT BURGER" for various menu items (Reg. Nos. 1522799, 1525982, 1101628, and 1101638) and promotional goods (Reg. Nos. 2217307, 1514689 and 1960015). Opposer also owns a composite mark incorporating an arrow design and the wording "IN-N-OUT BURGER" for financial sponsorship of race cars and

²Opposer also pleaded (1) mere descriptiveness based upon its assertion that the mark directly conveys information concerning the function, characteristics, qualities, purpose and underlying use of applicant's services within the meaning of Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1), and (2) that applicant's use of its mark in connection with the services set forth in the application is not use in "commerce" within the meaning of Trademark Act § 45, 15 U.S.C. § 1127. However, these claims are deemed waived because opposer failed to argue and present evidence with regard thereto at trial or in its briefs.

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race car drivers (Reg. No. 3367471³), and has subsequently acquired⁴ ownership of a registration for IN & OUT in standard characters in connection with motor vehicle body repairing and painting, which has been used in commerce since February 1981 (Reg. No. 1780587).

Opposer alleges that as a result of such use, its marks have achieved a high degree of public recognition and renown, and have received extensive media attention. Opposer alleges, therefore, that applicant's use of its IN & OUT CAR WASH mark in connection with car wash and related services will likely lessen the capacity of opposer's marks to identify and distinguish opposer's services and goods, regardless of the presence or absence of competition between the parties, and is likely to cause confusion, mistake and deception.

In its answer, applicant has denied all of the salient allegations in the second amended notice of opposition.⁵

³ Opposer filed the application for Registration No. 3367471 on November 14, 2006, alleging a date of first use in commerce of 1985, and it matured to registration on January 15, 2008.

⁴ Opposer acquired ownership of Registration No. 1780587 on March 13, 2009, after commencement of this proceeding. See Assignment Reel/Frame 3952/0116.

⁵ Also, in its answer to the second amended notice of opposition, applicant asserts as affirmative defenses matters that are more in the nature of amplifications of its denials of opposer's claims and have been so construed. In addition, the exhibits to applicant's answer to the second amended notice of opposition are not evidence on behalf of applicant, except to the extent that they were identified and introduced in evidence during applicant's period for the taking of testimony. Trademark Rule 2.122(c); and TBMP §317 (October 2012).

The Record

By rule, the record includes the pleadings and the file history of the subject application. Trademark Rule 2.122(b), 37 CFR § 2.122(b). In addition, the parties introduced the following testimony and evidence:

Opposer's evidence

1. Opposer's Notice of Reliance comprising ("Opp. NOR"):
 - a. Transcript and exhibits from the discovery deposition of applicant's co-owner and Managing Member, Greg Byler, taken on August 26, 2011 ("Opp. Byler Test.").
 - b. Transcript and exhibits from the discovery deposition of opposer's Vice President and General Counsel, Arnold Wensinger, taken on September 6, 2011 ("Opp. Wensinger Test.").
 - c. Transcript and exhibits from the testimony deposition of Mr. Byler, taken on October 27, 2011 ("App. Byler Test.").
 - d. Transcript and exhibits from the video conference testimony deposition of Mr. Wensinger, taken on September 21, 2010 ("App. Wensinger Test.").
 - e. Applicant's response to opposer's request for admissions.
 - f. Applicant's response to opposer's first set of interrogatories and requests for production of documents.
 - g. Applicant's response to opposer's second set of interrogatories and requests for production of documents.
 - h. Applicant's supplemental responses to opposer's first set of interrogatories and requests for production of documents.⁶

⁶Portions of the responses and documents have been designated "confidential." In this decision, we have endeavored to discuss those portions of the parties' testimony and evidence that truly contain confidential information only in general terms.

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- i. Publicly available articles, documents, Internet materials and books relied upon to demonstrate opposer's use, fame, and association with cars and car-culture.
2. Opposer's Notice of Reliance in Rebuttal comprising ("Opp. Rebuttal NOR"):
 - a. Publicly available articles and Internet materials relied upon to demonstrate the fame of opposer's marks through unsolicited word-of-mouth marketing.
 - b. DVD entitled "California's Gold: In-N-Out Burger" relied upon to demonstrate the fame of opposer's marks through unsolicited word-of-mouth marketing.
 - c. Third-party registrations relied upon to demonstrate that certain of applicant's types of services are offered alongside opposer's types of services.
 - d. Third-party Internet evidence relied upon to demonstrate that certain of applicant's types of services are offered alongside opposer's types of services under common law marks.

Applicant's evidence

1. Transcript and exhibits from the trial deposition of Mr. Byler, taken on October 27, 2011 ("App. Byler Test." in opposer's 1(c) above).
2. Applicant's Notice of Reliance comprising ("App. NOR"):
 - a. Excerpts from transcript and exhibits from the video conference deposition of Mr. Wensinger, taken on September 21, 2010 ("App. Wensinger Test." in opposer's 1(d) above).
 - b. Specific requests from applicant's first request for admissions to opposer, deemed admitted because of opposer's failure to respond.
 - c. Opposer's responses and objections to applicant's third set of interrogatories to opposer.
 - d. Opposer's first supplementation of its responses and objections to applicant's second set of interrogatories to opposer.

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- e. Opposer's responses and objections to applicant's second set of interrogatories to opposer.
- f. Opposer's supplementation of its responses and objections to applicant's revised first set of interrogatories and requests for production.
- g. Opposer's responses and objections to applicant's revised first set of interrogatories to opposer and applicant's first revised request for production.
- h. Publicly available Internet documents and articles relied upon to demonstrate the extent of actual recognition of opposer's marks, and that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States.
- i. Third-party registrations relied upon to demonstrate that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States, and the extent to which opposer is engaged in substantially exclusive use of its marks.
- j. Official TTAB records for opposer's oppositions against third-party marks relied upon to demonstrate that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States, and the extent to which opposer is engaged in substantially exclusive use of its marks.
- k. Official records from civil action proceedings in various U.S. district courts involving opposer, relied upon to demonstrate that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States, and the extent to which opposer is engaged in substantially exclusive use of its marks.⁷

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief.

⁷In response to an inquiry made by the Board, applicant's attorney has advised the Board that Exhibit 887 of applicant's Notice of Reliance was not made part of the record, and requested the Board to decide the case based on the existing record.

Evidentiary Matters

Before addressing the merits of the case, certain evidentiary matters require our attention. Opposer has objected to applicant's reliance on survey evidence, third-party registrations, and prior oppositions initiated by opposer against third parties. We note that none of the evidence sought to be excluded or restricted with regard to the purpose for which it has been submitted is outcome determinative. Therefore, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say that we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

The Parties

Opposer

Beginning in 1948, opposer began a regional chain of IN-N-OUT BURGER drive-through restaurants, which at the time of trial number 262 restaurants, exclusively within the states of California, Nevada, Utah, Arizona and Texas. Opp. Brief at p. 4; Opp. Wensinger Test. at 35, 134, 136-37. Opposer also sells gift cards, apparel, and collectibles through its store locations, catalogs and website. Opp. Brief at p. 4; Opp. Wensinger Test. at 88-91, 113-14, Exs. 640-644; App. Wensinger Test. at 36.

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Opposer additionally is involved in the financial sponsorship of race cars and race car drivers,⁸ Opp. Wensinger Test. at 85, Ex. 637; App. Wensinger Test. at 49-51, Ex 10, as well as motor vehicle body repairing and painting through its controlled licensee. Sec. Amend. Opp. at para. 9; Opp. Wensinger Test. at 98-99, Ex. 649.

Applicant

Applicant began using its IN & OUT CAR WASH mark in commerce in April of 2005. App. Byler Test. at 7. Applicant is in the car wash business and owns two car wash facilities, the Joplin, Missouri facility that opened in 2005 and the Springfield, Missouri facility that opened in 2007. Applicant also is in the business of providing consulting services to car wash operators. *Id.* at 3-4, 7; Opp. Byler Test. at 23.

Mr. Byler had initially selected the mark "Fast Lane Car Wash & Lube" for applicant's business, but decided on IN & OUT CAR WASH instead because a "Fast Lane Car Wash" already existed nearby. App. Byler Test. at 26-27; Opp. Byler Test. at 26. Mr. Byler derived the concept of a faster car wash in response to a common complaint from consulting clients that car wash services operate slowly, so he sought a mark that conveyed a message of quick car wash services. App. Byler Test. at 3, 13-15, 26-27; Opp. Byler Test. at 55-57. He ultimately selected the IN & OUT CAR WASH mark because it suggests to consumers that their cars

⁸Mr. Wensinger has testified that opposer's financial sponsorship of race cars and race car drivers is not actually a service that opposer provides to customers, but is used to promote brand recognition for its restaurant services. App. Wensinger Test. at 53.

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will be washed quickly, and that applicant's car wash services include the inside and outside of a vehicle. App. Byler Test. at 27; Opp. Byler Test. at 27. The only clearance search that Mr. Byler conducted when deciding on the IN & OUT CAR WASH mark was a search for available domain names, which only revealed a similar mark for a car wash in Canada. App. Byler Test. at 27-28; Opp. Byler Test. at 27-28. Mr. Byler had no knowledge of opposer until after applicant's car wash opened in Joplin, when a customer visiting from California asked him if he had ever heard of In-N-Out Burger.⁹ *Id.* at 24-26; Opp. Byler Test. at 29.

Applicant's car wash services feature cleaning services for the interior and exterior of vehicles, including detail cleaning. App. Byler Test. at 5, 28-30; Opp. Byler Test. at 25. The polishing services that applicant offers may involve rubbing some scratches off a car's painted surface; however, applicant's car wash services do not include repair of scratches, dent removal, windshield repair, or paint touchup. App. Byler Test. at 30-31; Opp. Byler Test. at 25-26.

Until May 2008, applicant also provided lube services at its Joplin location, which involved basic maintenance of vehicles in a short amount of time, such as oil changes, fluid checks, transmission services, air filter changes, and tire setting. App. Byler Test. at 18; Opp. Byler Test. at 24-25.

⁹It is worth mentioning that the Mr. Byler's testimony about the conversation with this customer does not indicate that the customer was confused as to the source of applicant's car wash or believed applicant's car wash services were in any way related to opposer's drive-through restaurant services. Without testimony from the customer herself, which does not exist in the record, we cannot rely on the conversation for any other purpose than as evidence as to when Mr. Byler first learned of opposer.

Standing

In determining whether opposer has established its standing to bring this proceeding, we first consider whether opposer has proven that it is the owner of valid and subsisting registrations for its pleaded marks. In this case, opposer introduced a copy of Registration No. 1780587 under Trademark Rule 2.122(d)(1) with its second amended notice of opposition on January 4, 2010.¹⁰ Sec. Amend. Opp. at para. 9. Opposer indicates it submitted copies of its other nine pleaded registrations with its original and two amended notices of opposition. However, no copies of opposer's other pleaded registrations were made of record with its pleadings. Opposer further submitted a copy of its pleaded Registration No. 3367471 with its notice of reliance.

In its answer to the second amended notice of opposition, applicant admits to opposer's ownership of several of its pleaded registrations, but not to their status. Sec. Amend. Answer at paras. 2-9. As a result, applicant's admissions are insufficient to prove that opposer's pleaded registrations are valid and subsisting. In addition, applicant made of record copies of opposer's pleaded Registration Nos. 1085163, 1522799, 1525982, 1101628, 1101638, and 2217307 showing status and title

¹⁰ Opposer submitted its second amended notice of opposition to plead ownership of this registration, acquired by assignment as discussed above.

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to opposer as of 2007, and 3367471, showing status and title to opposer as of 2009. App. NOR. at 874-891. We observe that applicant submitted these registrations as part of the official records of lawsuits involving opposer and third parties during its assigned testimony period in November 2011 to demonstrate that the marks in opposer's pleaded registrations are not famous. However, none of this evidence calls into question opposer's ownership of these registrations or their status as of the date the referencing documents were created. Indeed, in their respective summaries of the record in their briefs, both opposer and applicant assert that opposer's pleaded registrations are of record and so treat them. (Opp. Brief at 2; App. Brief at 8).

We therefore accept that opposer's pleaded Registration Nos. 1780587, 1085163, 1522799, 1525982, 1101628, 1101638, 2217307 and 3367471 are valid and subsisting and that, as a result, opposer has established its standing with regard to the marks protected thereby and the goods or services recited therein.¹¹ See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1026-1027, 213 USPQ 185 (CCPA 1982).

¹¹ Because neither party made of record copies of opposer's pleaded Registration Nos. 2285823 and 2291183, we will not consider them in our determination herein.

Priority of Use

Priority is not in issue in an opposition if an opposer establishes that it is the owner of a subsisting registration on the Principal Register. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Otter Products*, 105 USPQ2d 1252, 1254-55 (TTAB 2012), and cases cited therein. Because opposer established ownership of its above-listed registrations, priority is not an issue with respect to Registration Nos. 1085163, 1522799, 1525982, 1101628, 1101638, 2217307, 3367471 and 1780587.

We note that opposer has acquired rights to the mark in Registration No. 1780587 by assignment as a result of a purchase and license back agreement. Opposer is correct, and applicant does not dispute, that rights in this registration accrue to opposer. *Visa, U.S.A., Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982). Therefore, opposer has established priority with respect to this registration, notwithstanding its acquisition by opposer subsequent to the commencement of this proceeding.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. Du Pont de Nemours & Co.*, 476

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F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Family of marks not asserted

We begin by observing that opposer does not contend that all or a portion of the marks in its pleaded registrations constitute a family of marks. Therefore, we will determine the issue of likelihood of confusion based on the individual marks that are the subject of opposer's registrations of record.

Opposer's Registration No. 1780587

In our analysis, we will concentrate our discussion of the issue of likelihood of confusion on opposer's registration of record which is most similar to that of applicant, namely, Registration No. 1780587 for the mark IN & OUT (typed or standard characters) reciting "motor vehicle body repairing and painting" in International Class 37. If likelihood of confusion is found between the application at issue and this registration, it will be unnecessary to determine whether confusion is likely as to the remainder of opposer's registrations of record. Conversely, if likelihood of confusion is not found between the involved application and this registration, we would also find

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that confusion is not likely with opposer's remaining pleaded registrations, for the marks IN-N-OUT; IN-N-OUT and arrow design; and IN-N-OUT BURGER and arrow design, reciting:

"restaurant services and carry-out restaurant services;"

"milk and French fried potatoes for consumption on or off the premises;"

"lemonade and soft drinks for consumption on or off the premises;"

"cheeseburgers, hamburgers, hot coffee and milkshakes for consumption on or off premises;"

"watches;"

"decals in the nature of bumper stickers, publications in the nature of house organs, gift certificates;"

"backpacks;"

"coffee mugs and thermal mugs;"

"shirts, baseball caps, letterman's jackets, and cooks aprons;" and

"financial sponsorship of race cars and race car drivers."

Fame of opposer's IN-N-OUT marks

We note that opposer has argued and introduced testimony and evidence that its IN-N-OUT marks are famous for its restaurant services and menu items. While, as discussed above, we are concentrating our likelihood of confusion analysis on opposer's Registration No. 1780587 for the mark IN & OUT (typed or standard characters) reciting "motor vehicle body repairing

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and painting," we nonetheless address opposer's assertions regarding fame of its marks as to restaurant services and the menu items served therein.

Fame plays a dominant role in the likelihood of confusion analysis due to the fact that famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," by widespread critical assessments and through notice by independent sources of the products and services identified by the marks, as well as by the general reputation of the branded products and services. *Bose*, 63 USPQ2d at 1305-06, 1309.

Although raw numbers of product and service sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the

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substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Upon careful review of the record in this case, we find that although opposer has established that its marks are strong and have gained notoriety for its restaurant services and menu items, we are not persuaded that opposer's IN-N-OUT marks are famous for any of its goods or services.

Opposer's sales

Opposer operates 262 restaurant locations within five states, California, Nevada, Utah, Arizona and Texas, and does not have facilities in any other state. Opp. Brief at p. 4; Opp. Wensinger Test. at 35, 134. Opposer's only means for selling food is its 262 restaurant locations. Opp. Wensinger Test. at 113-114. However, opposer sells gift cards, apparel, and collectibles through its store locations, catalogs and website. Opp. Brief at p. 4; Opp. Wensinger Test. at 88-91, 113-14, Exs. 640-644; App. Wensinger Test. at 36.

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Opposer states that because it is a private company, it is not required to, and does not, release annual sales figures.¹² Opp. Brief at p. 4. Therefore, opposer simply relies on Mr. Wensinger's testimony that opposer's sales figures on record are "significantly lower than actual," and that sales are routinely underrepresented when ranked alongside other nationally famous brands. Opp. Brief at p. 4; Opp. Wensinger Test. at 31-32, Ex. 608. For example, Mr. Wensinger explained that QSR Magazine ranked opposer only 48th nationally in overall sales in 2005, but that this rank is likely much lower than opposer's actual rank in yearly sales because opposer's sales per location are the highest in the United States. *Id.* Mr. Wensinger further testified that even though opposer's sales are strong, they are not near the level of sales of a restaurant chain such as McDonalds. Opp. Wensinger Test. at 129-30. With respect to its merchandising products, Mr. Wensinger testified that, for instance, less than 1% of its gross sales of logo merchandise were to consumers in Missouri and Arkansas (states in which opposer does not operate restaurants) between the years 2004 to 2008. App. Wensinger Test. at 37, 41-43.

Opposer does not offer any evidence to support its asserted sales figures or that its sales per location are indeed the

¹² We note that opposer had the option of releasing its sales figures under protective order and seal of confidentiality. See TBMP § 412 (October 2012).

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highest in the United States. Moreover, Mr. Wensinger's testimony does not provide any market share context represented by its sales, making it very difficult for us to determine whether they are substantial for the purpose of determining fame. To the contrary, testimony that its system-wide sales are not near McDonald's comparable sales, and that its merchandise sales to Missouri and Arkansas only represent less than 1% of its gross merchandise sales, all indicate that opposer's sales are made to a limited market share of the general consuming public in the United States.

Opposer's marketing and advertising

Mr. Wensinger testified that opposer's current advertising budget is just under \$10 million per year, and that it has spent a minimum of \$6.5 million per a year on conventional advertising over the past ten years. Opp. Brief at 5; Wensinger Test. at 21. Mr. Wensinger also testified that opposer's advertising is nationwide, through promotion for sporting events that are picked up for national broadcasts, as well as advertising on AM radio stations, social media outlets, opposer's website, and interstate highway billboards seen by drivers from all across the country. Opp. Brief at 5; Wensinger Test. at 23-25, Exs. 605-606.

Closer examination of Mr. Wensinger's testimony and related exhibits, however, indicate that opposer's radio and television

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advertising for 2005, which Mr. Wensinger testified is representative of opposer's media plan for the past ten years, appears to be limited to geographic areas local to opposer's business locations, such as Los Angeles, Las Vegas, and Phoenix. Opp. Wensinger Test. at 23-25, Ex. 605. Similarly, opposer's interstate billboards promote specific store locations and are strategically placed in close proximity to the respective locations with directional information. Opp. Wensinger Test. at 26, Ex. 606. Based on the evidence, consumers must be within the physical range of opposer's marketing efforts for exposure to the advertisements. While non-local travelers to the area may be exposed to the advertisements, we cannot speculate as to the market share of the general consuming public in the United States that those travelers represent.

The same is true for Mr. Wensinger's testimony and evidence that opposer has 2,000,000 fans or "likers" on Facebook. Opp. Wensinger Test. at 28. There simply is no supporting evidence as to where those fans are located and what share of the relevant consuming public they represent for us to determine the question of fame. Presumably, a significant portion of opposer's Facebook fan-base represents consumers local to opposer's business establishments who are specifically familiar with opposer. It is impractical for us to determine fame based on the marketing evidence before us.

Opposer's word-of-mouth marketing

Mr. Wensinger testified that opposer focuses on the quality of its products and customer experience, which results in the word-of-mouth advertising that opposer seeks. Opp. Wensinger Test. at 38-39. For that reason, Mr. Wensinger testified that opposer's reputation is national in scope, even global with brand recognition reaching as far as Japan, the United Kingdom and Australia. Opp. Wensinger Test. at 46-47. However, Mr. Wensinger's testimony is wholly unsupported and speculative without evidence of specific context and reference.

Unsolicited media attention and celebrity recognition

The record demonstrates that opposer is the subject of very favorable and unsolicited attention from media sources and celebrities, and includes the following representative sample:

1. Ed Levine, *The Burger Takes Center Stage*, N.Y. Times, Jan. 15, 2003. Opposer's NOR, para. 5, Ex. 705 (See para. 3);
2. Raymond Sokolov, *The Best Burger*, Wall St. J., March 10, 2007. Opposer's NOR, para. 6, Ex. 706 (See para. 19);
3. *Winning Weight*, People Mag., Oct. 16, 2006. Opposer's NOR, para. 7, Ex. 707 (See para. 1);
4. Editorial board information page of Glamour Mag. in Nov., 2007. Opposer's NOR, para. 9, Ex. 709;
5. Monica Eng, *Fast Food that Even a Foodie Could Love*, Chicago Tribune, Oct. 4, 2005. Opposer's NOR, para. 10, Ex. 710 (See paras. 3-16);

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6. Deb Peterson, *Local Pals Make Movie for Texas Film Festival*, St. Louis Post-Dispatch, Feb. 16, 2008. Opposer's NOR, para. 11, Ex. 711 (See para. 4); and
7. Bruce Horovitz, *In-N-Out Burger Gives Ad Business to Seattle Agency*, L.A. Times, Oct. 11, 1989. Opposer's NOR, para. 13, Ex. 713 (See paras. 1-9).

While the evidence certainly indicates that opposer has received favorable mention and recognition beyond its regional presence, it is not an indication of how significant that recognition is with the general consuming public overall. Consumers who do not read the specific articles, do not watch the specific Internet videos, and do not observe the celebrity attention that opposer and its marks receive cannot be presumed to be familiar with opposer and its marks. Again, opposer has not provided any evidence whatsoever demonstrating the level of recognition the general consuming population in the United States has of its marks.

As we noted in a case with some similarities (but a better developed record on fame):

Opposer certainly has enjoyed considerable success with its restaurants. Opposer's sales in the period 1986-1992 exceed \$3.3 billion, with 1992 sales of over \$614 million. Opposer traditionally spends 4% of its gross sales revenues on advertising. Opposer's figures for the period 1983-1990 show that opposer spent almost \$247.5 million on advertising, with expenditures in 1990 of \$39.2 million.

The evidence of record, when taken as a whole, indicates that opposer's star marks are well known in its specific area of operation, namely California, Arizona, Oregon and Nevada. In other words, the

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evidence does not establish that opposer's marks are nationally famous. Rather, opposer has established local notoriety in its trading area.

Carl Karcher Enters. Inc. v. Stars Rests. Corp., 35 USPQ2d 1125, 1130 (TTAB 1995).

Similarly, the totality of opposer's evidence in this case falls short of convincing us that opposer's IN-N-OUT marks are famous. While opposer undoubtedly enjoys a devoted following and business success, at least within its areas of operation, it has not clearly shown a level of recognition for its mark which would justify the heightened scope of protection afforded truly famous marks.

Decisions of other courts

Finally, opposer relies on a decision by the Supreme Court of the Philippines and the Bureau of Legal Affairs findings that opposer's IN-N-OUT mark is famous. Opp. Brief at 6. However, a "decision by another court based upon a different record is not evidence in this proceeding." *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1665 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). By statute, this Board has the duty to decide the right to federal registration in an opposition. 15 U.S.C. § 1067(a). "This duty may not be delegated by the adoption of conclusions reached by another court on a different record. Suffice it to say that an

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opposition must be decided on the evidence of record.”

Citigroup Inc., 94 USPQ2d at 1665.

Again, in view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of opposer, the party asserting that its marks are famous, to clearly prove it. Based on the evidence presented by opposer, we cannot conclude that its marks are famous for purposes of a likelihood of confusion analysis.

Inherent distinctiveness and mark strength

In addition to the fame or renown of a mark, we also consider the inherent distinctiveness of the mark, *i.e.*, where it fits in the continuum described as ranging from generic through fanciful. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ2d 759, 764 (2d Cir. 1976). While “the lines of demarcation ... are not always bright,” *id.*, it is axiomatic that those marks which are highly distinctive are usually entitled to a broader scope of protection, while marks falling towards the other end of the spectrum typically enjoy little or no protection.

We find in this case that both opposer’s and applicant’s marks are suggestive in that they both convey a message about the respective services. That is, the marks both indicate to

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the prospective customer that the services are performed quickly, in particular that the customer can drive "in and out." App. Byler Test. at 27; Opp. Byler Test. at 27; Opp. Wensinger Test. at 78; App. Wensinger Test. at 12-13, 28, 30; App. NOR at para. 4, Ex. 804 (para. 53 therein); Opp. Brief at 21. In this respect, while both marks are inherently distinctive, they are less distinctive than purely arbitrary or fanciful marks. As a result, any similarity of the marks is less likely to cause confusion than would be the case if the marks were arbitrary or fanciful. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) ("Where a party chooses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.").

Third-party registrations for similar marks

In our determination of the strength of opposer's marks, we have also considered applicant's evidence and arguments that "countless" marks containing various permutations of the terms "in and out" are in use by third parties. In this regard, applicant submitted third-party evidence in the nature of numerous registrations for marks consisting in whole or in part of the terms "in and out" for a wide variety of goods and services. However, the probative value of this evidence is limited because applicant presented no evidence concerning the extent to which these third-party marks are used in commerce.

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See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Moreover, a review of the third-party registrations reveals that none recite goods or services that are particularly similar to those at issue in this case, and most recite goods and services that are quite different. Thus, applicant's evidence does not establish that there is widespread use of similar marks on related goods and services such that opposer's marks are weak and entitled to only a narrow scope of protection. This factor, therefore, is at best neutral or somewhat favors a finding of likelihood of confusion.

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression

We now turn to the first *du Pont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Id.* In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *See, e.g., In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); and *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.4 (TTAB 1987).

With these principles in mind, we begin our analysis by noting that applicant's IN & OUT CAR WASH mark fully incorporates as its distinctive portion opposer's mark, IN &

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OUT. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. See, e.g., *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and *In re S. Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUG for toy doll carriages and LITTLE LADY for doll clothing).

The wording IN & OUT in both marks is identical in appearance and sound. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. See *In re White Swan Ltd.*, 8 USPQ2d at 1535 (TTAB 1988); and *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007). The marks also share the same connotation of quick services, i.e., getting "in and out" without delay.

However, because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the test for similarity cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just on part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); and e.g., *Franklin Mint Corp. v. Master Mfg. Co.*, 667

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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.").

Applicant contends that its mark, in its entirety, engenders a different commercial impression than that of opposer's mark. Applicant states that the wording "CAR WASH" in its mark is a significant distinguishing factor because the "in and out" element of the respective marks is weak. App. Brief at 26-27. However, the wording "CAR WASH" in applicant's mark clearly is generic for its services in this case, and thus incapable of functioning as an indicator of source to distinguish the source of its services from those of opposer. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); and *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). Thus, notwithstanding the suggestive nature of the wording IN & OUT, it is the dominant wording in applicant's mark and the sole feature of opposer's. Our primary reviewing court instructs us that "[t]here 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 consideration of the marks in their entireties." See *In re National Data Corp.*, 224 USPQ at 751. For instance, "that a particular feature is descriptive or generic with respect to

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the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." *Id.* at 244 USPQ 751.

We find, therefore, that the dominant and distinctive portion of applicant's mark is identical to opposer's mark and that, when viewed in their entireties, the marks IN & OUT and IN & OUT CAR WASH are more similar than dissimilar in appearance, sound, connotation and overall commercial impression. As a result, this *du Pont* factor favors a finding of likelihood of confusion.

The similarity or dissimilarity and nature of the services in the application and the services in opposer's registration

In determining whether services are related, this *du Pont* factor requires that we must consider the services as they are identified in the respective descriptions in the application and registration. *See, e.g., Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). It is not necessary that the services of applicant and opposer be similar or competitive to support a holding of likelihood of confusion. It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in

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some way associated with the same source. *Miss Universe L.P. v. Community Mktg. Inc.*, 82 USPQ2d 1562, 1568 (TTAB 2007).

Here, applicant is seeking to register its mark for "automobile cleaning and car washing; automobile washing; car washing; vehicle washing."¹³ Meanwhile opposer, through its licensee, is engaged in "motor vehicle body repairing and painting."¹⁴

Opposer relies on twenty-four¹⁵ third-party registrations and Internet evidence from eleven third parties to demonstrate that car washing services originate from the same source as vehicle body repairing and painting services. Opp. Brief at 20; Opp. Rebuttal NOR at paras. 17-40, 41-51, Exs. 817-840, 841-851. We note that a number of the third-party registrations are owned by foreign entities, and many of these in addition recite myriad goods and services in multiple classes. Because these

¹³ Opposer also argues that its services are related to applicant's oil change services. Opp. Brief at 20. However, since the application at issue does not recite oil change services, any relationship between oil change services and motor vehicle body repairing and painting services is irrelevant to our determination herein.

¹⁴ Opposer further argues that it is the original drive through restaurant, it sponsors auto race cars and drivers, and its image and advertisements are immersed in "car culture," and that, as a result of these activities, its core goods and services are related to those of applicant. Opposer points out in addition that both it and applicant rely upon automobile traffic for their business. Nonetheless, opposer acknowledges that it does "not have its associates wash any vehicles at [its] restaurants" and further that its sponsorship of race cars and drivers does not relate to car wash services. Wensinger Test. at 15-16, 52. In any event, we are not relying upon opposer's registrations reciting these goods and services and, as a result, the issue of their relationship to applicant's recited services is not before us.

¹⁵ The twenty-four third party registrations represent nineteen owners that identify both car washing or cleaning services and vehicle repair or painting services.

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registrations are not based on use in commerce they have no probative value in showing the relatedness of the services, and they have not been considered. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). However, opposer's evidence includes approximately fifteen third-party registrations owned by fourteen different entities that are based on use in commerce and recite services including those identified by both parties herein.

We observe that third-party registrations are of very limited probative value on the issue of likelihood of confusion because they are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973). See also *In re theDot Communications Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011). However, opposer additionally made of record the following Internet evidence in support of the relatedness of the services:

1. Anthony's Car Wash and Detail Centers, at www.anthonyscarwash.com (last visited Nov. 16, 2011) (featuring car wash, detail, automotive, paint and body services). Opp. Rebuttal NOR at para. 41, Ex. 841.
2. Collision Masters, at www.collisionmasters.us/Index.html (last visited on Jan. 16, 2011) (no specific services identified other than collision). Opp. Rebuttal NOR at para. 42, Ex. 842.
3. Starbright Auto Body, at www.yelp.com/biz/starbright-auto-body-phoenix (last visited Jan. 16, 2011) (no

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- specific services identified other than auto body). Opp. Rebuttal NOR at para. 43, Ex. 843.
4. Tidal Wave USA, at www.tidalwaveusa.com (last visited Jan. 16, 2011) (relevant exterior services include detailing, hand waxing, swirl free-buffing and scratch removal, headlight restoration, overspray/graffiti removal, paintless dent repair, bumper repair, "clear bra" paint protection film). Opp. Rebuttal NOR at para. 44, Ex. 844.
 5. The Yard, at www.superiorcarcare.com/yard.html (last visited Jan. 16, 2011) (relevant services include hand car wash, hand wash & wax, exterior detail, interior detail, color sanding & paint correction, bumper repair, scratch repair, paint touch up, wheel & rim repair, paintless dent repair, windshield replacement, paint protection film). Opp. Rebuttal NOR at para. 45, Ex. 845.
 6. Arapahoe Collision and Mechanical, at www.arapahoeauto.com/services.php (last visited Jan. 16, 2011) (detailing services include steam clean, blow out air vents, clean windows & mirrors, leather treatment, steam clean, buff, polish and wax exterior; collision repair services include mechanical repairs, paint matching, paintless dent removal, brake service, oil and filter changes). Opp. Rebuttal NOR at para. 46, Ex. 846.
 7. T&J Auto Body, at www.tandjautobody.com (last visited Jan. 16, 2011) (no specific services listed other than fixing cars). Opp. Rebuttal NOR at para. 47, Ex. 847.
 8. My Premium Car Wash, at www.mypremiumcarwash.com (last visited Jan. 16, 2011) (relevant services include hand wash, auto detailing, power washing, pressure cleaning). Opp. Rebuttal NOR at para. 48, Ex. 848.
 9. Preston Auto Body, at www.sprestonautobody.com (last visited Jan. 16, 2011) (no specific services listed other than collision repair). Opp. Rebuttal NOR at para. 49, Ex. 849.
 10. Berardi's Detailing, at www.berardisdetailing.com (last visited Jan. 16, 2011) (relevant services listed include auto detailing, auto body repair, auto painting,

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car repair, auto glass replacement, paintless dent removal). Opp. Rebuttal NOR at para. 50, Ex. 850.

11. River City Auto Body, at www.rivercityautobody.net (last visited Jan. 16, 2011) (no specific services listed other than repairs). Opp. Rebuttal NOR at para. 50, Ex. 850.

Based on the information available from the evidence of record, five of the above sources state that they offer car washing, cleaning or detail services in addition to auto repair or paint services. However, the probative value of such Internet documents is limited. While they can be used to demonstrate what the documents show on their face, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed. See TBMP § 704.08(b) and authorities cited therein. Thus, the Internet evidence made of record by opposer does not prove that the five above-noted entities actually provide car washing and cleaning services as well as car repair and painting services, but simply that the third parties responsible for the Internet postings of record state that such services are available therefrom.

A party may increase the weight given website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. *Id.* However, opposer does not provide such testimony. Rather, Mr. Wensinger testified that, "the primary business of a car wash business is distinct from the primary business of a paint and body shop . . .," and

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the washing of a vehicle would be incidental to the repair or painting of a vehicle. App. Wensinger Test. at 114. Thus, the testimony made of record in this case tends to support a finding that the parties' services are unrelated, and does not support opposer's evidence.

Determinations are reached based on the evidence of record. In this case, the evidence falls short of establishing that applicant's car wash services are in fact related to opposer's services. As a result, this *du Pont* factor favors a finding of no likelihood of confusion.

Channels of trade and classes of consumers

As is readily apparent, neither party's recitation of services contains any limitations as to their channels of trade or the purchasers to whom its services are marketed. As a result, and in accordance with our established case law, we must presume that applicant's services move in all channels of trade that are normal therefor and are available to all the usual purchasers thereof.

However, and as discussed above, opposer has failed to introduce sufficient evidence to support a finding that its services under its mark are related to applicant's services in its involved application. As such, we cannot presume that the channels of trade for its services are the same as or overlapping with those in which applicant's services may be

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encountered. *Cf. 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.").

Further, aside from incidental sales of opposer's ancillary merchandise in the State of Missouri in which applicant is located, neither the nature of the services themselves nor the evidence of record supports a finding that such services travel in common trade channels or are made available to the same customers.

Actual confusion

The final *du Pont* factor discussed by the parties is the lack of instances of actual confusion. Opposer acknowledges that there have been no instances of actual confusion. App. Wensinger Test. at 16-20. Applicant asserts that the absence of actual confusion for seven years at the time of trial suggests no likelihood of confusion. However, as has been said many times, it is not necessary to show actual confusion in order to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Furthermore, it has often been recognized that such

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evidence is very difficult to obtain. See *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012). Thus, while evidence of actual confusion would mitigate in favor of a finding of likelihood of confusion, the absence thereof is not as compelling in our determination. As a result, this *du Pont* factor is neutral, or at best, slightly favors applicant.¹⁶

Balancing the factors

We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as the parties' arguments with respect thereto. In balancing the relevant factors, we conclude that despite the similarities between the parties' marks, there is insufficient evidence that applicant's "automobile cleaning and car washing; automobile washing; car washing; vehicle washing" services are related to opposer's "motor vehicle body repairing and painting," or that the services are offered in common channels of trade to the same classes of consumers. Based on the foregoing, opposer has not proved likelihood of confusion.

Dilution by Blurring

¹⁶ We further note that while the "territorial separation" of the regions in which opposer and applicant operate may be relevant to the absence of actual confusion, because both the involved application and cited registration are unrestricted as to their geographic scope, the question of geographic limitations is otherwise irrelevant to our determination herein.

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Opposer claims that use of applicant's mark would be likely to "lessen the capacity of [o]pposer's ... marks to identify and distinguish [o]pposer's services and goods." Sec. Amend. Opp. at para. 13. In order to prevail on a claim of dilution, opposer must prove, as a threshold matter, that its mark became famous prior to applicant's first use. Trademark Act § 43(c)(1). As we have noted in other cases, "[f]ame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving "fame" for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

As noted, we do not find opposer's marks famous for likelihood of confusion purposes. Since it is even harder to prove fame for dilution purposes, we need go no further; because opposer has not established that its marks are famous, it cannot prevail in its dilution claim.

Decision: The opposition to the registration of applicant's mark is dismissed.