

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Hearing: February 23, 2011

Mailed: August 30, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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AutoZone Parts, Inc.

v.

Dent Zone Companies, Inc.

\_\_\_\_\_  
Cancellation No. 92044502

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Alan S. Cooper of Wiley Rein LLP for AutoZone Parts, Inc.

John M. Cone of Hitchcock Evert LLP for Dent Zone Companies,  
Inc.

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Before Grendel, Cataldo and Bergsman,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Petitioner, AutoZone Parts, Inc., has petitioned to  
cancel the following registrations owned by respondent, Dent  
Zone Companies, Inc.:

Registration No. 2604916 for the mark DENT ZONE (typed  
or standard characters, DENT disclaimed) for "vehicle repair  
and maintenance services, namely vehicle paint blemish

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repair, paintless dent removal, and windshield repair”;<sup>1</sup>

Registration No. 2829174 for the mark shown below



(DENT and AUTO BODY disclaimed) for "providing extended service agreements for vehicle repair and maintenance services, namely paintless dent repair";<sup>2</sup> and

Registration No. 2885624 for the mark shown below



(DENT and AUTO BODY disclaimed) for "vehicle repair and maintenance services, namely paint blemish repair, paintless dent removal and windshield repair".<sup>3</sup>

Petitioner alleges priority and likelihood of confusion as a ground for cancellation. Petitioner specifically alleges that it and its predecessor have continuously used

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<sup>1</sup> Issued August 6, 2002 on the Principal Register, asserting July 11, 1994 as a date of first use of the mark in commerce in connection with the services. Section 8 affidavit accepted.

<sup>2</sup> Issued April 6, 2004 on the Principal Register, asserting December 6, 2000 as a date of first use of the mark in commerce in connection with the services. Section 8 affidavit accepted.

<sup>3</sup> Issued on the Principal Register on September 21, 2004, asserting August 8, 1997 as a date of first use of the mark in commerce in connection with the services. Cancelled under Section 8 effective April 22, 2011.

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the trade name, trademark and service mark AUTOZONE for retail auto parts store services, automotive testing, repair, diagnostic and installation services, since long prior to respondent's dates of first use; that its retail auto parts store services offer products including dent repair, windshield products and related items, that petitioner's AUTOZONE mark has become "exceedingly well-known and a famous mark within the meaning of §43(c) of the Federal Trademark Act" prior to the dates of first use claimed in the challenged registrations; and that respondent's marks, when used in connection with the identified services, so resemble petitioner's AUTOZONE mark as to be likely to cause confusion.<sup>4</sup> Petitioner pleaded ownership of the following registrations:

Registration No. 1550569 issued August 1, 1989 (Section 8 affidavit accepted; Section 15 affidavit accepted; first renewal) for the mark AUTOZONE (typed drawing) for "retail auto parts store services";

Registration No. 1501718 issued August 23, 1988 (Section 8 affidavit accepted; Section 15 affidavit acknowledged;

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<sup>4</sup> Petitioner further asserted a dilution claim under Section 43 of the Trademark Act but did not pursue the claim at trial. Accordingly, it is deemed waived. In addition, in its reply brief on the merits of the case, petitioner indicates that it "reserves the right to petition for cancellation of Registration Nos. 2604916 and 2885624 on the ground of abandonment..." (Reply brief, p. 3, FN 2.) We note, however, that the issue of abandonment was neither pleaded nor tried in this case and thus is not before us.

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first renewal) for the mark shown below, for "retail auto parts store services";



Registration No. 2397635 issued October 24, 2000 (Section 8 affidavit accepted; Section 15 affidavit acknowledged; first renewal) for the mark shown below, for "retail automobile parts and accessories store services"; and



Registration No. 2721079 issued June 3, 2002 (Section 8 affidavit accepted; Section 15 affidavit acknowledged) for the mark AUTOZONE (typed drawing) for "automotive repair services, namely, testing, repair, diagnosis and installation of automotive parts and accessories".

Respondent filed an answer to the petition to cancel wherein it denied the essential allegations thereof.<sup>5</sup>

**Respondent's Registration No. 2885624**

Subsequent to the parties' briefing and oral hearing in this case, respondent allowed its involved Registration No. 2885624 to be cancelled under Section 8 of the Trademark Act. On July 22, 2011, the Board issued an order allowing

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<sup>5</sup> In addition, respondent asserted certain affirmative defenses but did not pursue them at trial. Accordingly, they are deemed waived.

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respondent 15 days in which to show cause why such cancellation should not be deemed to be the equivalent of a cancellation by request of respondent without petitioner's consent, and should not result in entry of judgment against respondent as to that registration as provided by Trademark Rule 2.134(a).

On August 5, 2011, respondent submitted a response to the July 22, 2011 show cause order, along with the declaration of its executive vice chairman, Mr. Troy Good, in support thereof. In its response, respondent declares that at the time for filing a Section 8 affidavit for its Registration No. 2885624, respondent ceased using the mark in that registration and had no intention to resume use thereof.<sup>6</sup> Respondent further declares that the "decision to phase out use of DENT ZONE The Autobody Alternative was not made for the purpose of avoiding a decision"<sup>7</sup> on the petition to cancel but rather was a business decision to brand the services identified thereby under a different mark "to distinguish it from the service contract/affinity club business conducted under the marks DENT ZONE and DENT ZONE The Autobody Guard and Design trademarks."<sup>8</sup> Accordingly, respondent requests that the Board enter judgment against its Registration No. 2885624 solely on the ground of

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<sup>6</sup> Declaration of Troy Good, para. 6.

<sup>7</sup> Id. at 3.

<sup>8</sup> Id.

abandonment.

On August 11, 2011, petitioner filed a response thereto requesting that, based upon respondent's showing, the Board (1) deem its petition for cancellation to be amended to include a claim of abandonment against respondent's Registration No. 2885624; and (2) enter judgment against Registration No. 2885624 on the ground of abandonment.

It is settled that when a respondent concedes that its failure to file a Section 8 affidavit was occasioned by a deliberate business decision made prior to commencement of the proceeding to discontinue use of its mark, and not to avoid judgment on the cancellation, the Board will enter judgment against that registration on the ground of abandonment. *See, for example, Marshall Fields & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989). *See also* TBMP § 602.02(b) (3d ed. 2011) and authorities cited therein. Given the circumstances of this case, and further because petitioner consents thereto, judgment is hereby entered against respondent as to Registration No. 2885624 on the ground of abandonment.<sup>9</sup>

#### **The Record**

By rule, the record consists of the pleadings and the files of the involved registrations. In addition, during

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<sup>9</sup> Petitioner's request to amend its petition to cancel to assert abandonment against respondent's Registration No. 2885624 is moot.

its assigned testimony period petitioner took the testimony deposition, with exhibits, of its vice-president of marketing, Mr. Brett Shanaman. Petitioner further introduced a notice of reliance upon printed copies of its pleaded registrations; printed copies of third-party registrations; and excerpted portions of the discovery deposition of respondent's executive vice chairman, Mr. Troy Good. Respondent, during its assigned testimony period, took the testimony depositions, with exhibits, of Mr. Troy Good and the president of third party Automotive Service International, LLC, Mr. Douglas Hansen.

**General Facts**

The record in this case establishes that petitioner first used the mark AUTOZONE in connection with retail auto parts store services and auto parts and accessories in 1987.<sup>10</sup> Petitioner currently operates approximately 4,050 AUTOZONE auto parts stores throughout the continental U.S. and Puerto Rico.<sup>11</sup> Virtually every type of auto part and accessory is sold at petitioner's stores, including products for use in auto collision repair.<sup>12</sup> Petitioner's sales associates are "trained and encouraged to go the extra mile to assist customers" by offering to test automobile batteries, alternators and starters; providing diagnostic

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<sup>10</sup> Shanaman Testimony, p. 24-34.

<sup>11</sup> Id., p. 12.

<sup>12</sup> Id. at 11-18, 67; Exhibits 1-5.

services that relate to checking engine lights; and installing parts if requested by a customer or if it appears that a customer needs help.<sup>13</sup> Petitioner's stores feature a "LOAN-A-TOOL" program through which petitioner's customers may borrow certain tools, including tools used in collision repair.<sup>14</sup> Petitioner provides a website (autozone.com) offering "how-to" and repair information, various auto parts for sale, and directions to petitioner's physical retail stores.<sup>15</sup> Petitioner's website receives visits from approximately 3.4 million unique visitors per month.<sup>16</sup> Petitioner's physical stores collectively receive approximately 6 million customers per week.<sup>17</sup> Petitioner's customers are the general public, professional automotive installers and personnel from automobile repair shops.<sup>18</sup>

Petitioner's AUTOZONE mark appears on signs on the exterior of petitioner's retail stores, on freestanding signs outside of the stores, on banners, posters and other point-of-sale materials inside the stores, and on products sold in the stores.<sup>19</sup> Petitioner advertises its services and products on its Internet website and third-party websites; in newspapers, magazines and circulars; on radio

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<sup>13</sup> Id. at 18-20, 46-47; and Exhibit 17.

<sup>14</sup> Id. at 20-1, 49, 52; and Exhibits 18, 20.

<sup>15</sup> Id. at 13-18, 55-57; Exhibits 1-5, 23.

<sup>16</sup> Id. at 57.

<sup>17</sup> Id. at 22-23.

<sup>18</sup> Id.

<sup>19</sup> Id. at 34-39; Exhibits 10-15.



and television, including channels such as FOX, the History Channel, and Speed TV.<sup>20</sup>

Petitioner and its related companies annually distribute between 30 million and 100 million circulars to consumers in stores, as newspaper inserts and direct mailers.<sup>21</sup> Petitioner's television advertising reaches approximately ninety percent of the U.S. population 40 times per year.<sup>22</sup> For the past seven years, petitioner's radio advertising has reached approximately ninety-five percent of the U.S. population approximately 100 times per year.<sup>23</sup> Petitioner's combined radio and television advertising of the AUTOZONE mark generates 9.5 billion commercial impressions per year.<sup>24</sup> In addition, petitioner advertises by means of courtside and electronic signage at college and professional sporting events including professional basketball, soccer and baseball, as well as college football at the AutoZone Liberty Bowl.<sup>25</sup>

Petitioner's annual sales of auto parts, accessories and services under the AUTOZONE mark have increased from more than one billion dollars in 1992 to approximately 6.5 billion dollars in 2008 with a cumulative total of over \$75

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<sup>20</sup> Id. at 4-62; Exhibits 16-24.

<sup>21</sup> Id. at 54-55.

<sup>22</sup> Id. at 43.

<sup>23</sup> Id. at 43-47.

<sup>24</sup> Id. at 43-44.

<sup>25</sup> Id. at 40-62; Exhibits 16-24.

billion since 1987.<sup>26</sup> In addition, since 1987 petitioner and its predecessor in interest have spent in excess of \$750 million in advertising and promoting its automotive parts store services and related parts and accessories under the AUTOZONE mark.<sup>27</sup>

In 1994, respondent got into the then-novel business of providing paintless dent repair of hail-damaged vehicles.<sup>28</sup> Paintless dent repair (PDR) is used to repair minor dents to vehicle bodies and differs from the techniques used to repair larger damage to vehicle bodies and uses different tools.<sup>29</sup> Respondent later ceased providing PDR services and shifted its focus to offering fulfillment services to insurance companies, affinity clubs and pre-paid service providers who provide PDR services to vehicle owners. Thus, respondent presently does not provide PDR services directly to the general public, but rather uses its DENT ZONE marks in connection with promotion and sale of its fulfillment services to the above-mentioned customers by arranging PDR services to be performed by a network of independent technicians on behalf of third parties.<sup>30</sup>

#### **Petitioner's Standing**

Because petitioner has properly made its pleaded

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<sup>26</sup> Id. at 62-64; Exhibits 25.

<sup>27</sup> Id. at 65.

<sup>28</sup> Good Testimony, p. 30-40.

<sup>29</sup> Id. at 9-10.

<sup>30</sup> Id. at 6-7, 17-23 30, 40.

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registrations of record, and further has shown, by its use and registration of marks that are at least arguably similar to respondent's marks that it is not a mere intermeddler, we find that petitioner has established its standing to petition to cancel respondent's registrations for its involved marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

**Priority**

It is well-settled that in the absence of any evidence of earlier use, the earliest date upon which a respondent may rely is the filing date of its underlying applications. See Trademark Act Section 7(c), 15 U.S.C. §1057(c). See also *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995). In this case, the applications that matured into respondent's registrations at issue both were accorded filing dates of April 1, 2002. Inasmuch as respondent has neither alleged nor introduced any evidence to support a finding that it made earlier use of its DENT ZONE marks, we find that April 1, 2002 is the earliest date upon which respondent is entitled to rely for purposes of priority.

The filing dates of petitioner's pleaded registrations are as follows: November 20, 1987 for Reg. No. 1501718;

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September 14, 1988 for Reg. No. 1550569; September 8, 1999 for Reg. No. 2397635; and July 9, 2002 for Reg. No. 2721079. Because the filing date of the applications which matured into petitioner's pleaded Registration Nos. 1501718, 1550569 and 2397635 predate the April 1, 2002 filing dates of respondent's underlying applications, petitioner clearly has established its priority as to three of its four pleaded registrations.

In addition, as to petitioner's pleaded Registration No. 2721079, the testimony of Brett Shanaman establishes that petitioner and its predecessor used the AUTOZONE mark in that registration in connection with the automotive repair services recited therein as early as 1987.<sup>31</sup> In its brief, respondent objects to this testimony on the ground that Mr. Shanaman joined petitioner in 2001 and thus lacks direct knowledge of such use. However, respondent never objected during Mr. Shanaman's testimony deposition on the basis of his competency to testify on this issue. Neither did respondent cross-examine Mr. Shanaman regarding his testimony on this issue. As a result, petitioner was not afforded an opportunity to correct the deficiencies raised by such an objection during Mr. Shanaman's testimony deposition. Accordingly, respondent's objection, raised for the first time in its brief, is deemed waived. See

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<sup>31</sup> Shanaman Testimony, p. 33-4; Exhibit 9.

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Trademark Rule 2.123(k) and Fed. R. Civ. P. 32(d)(3)(A). In view thereof, we find that Mr. Shanaman's testimony is sufficient to establish petitioner's priority of use with regard to its pleaded Registration No. 2721079. "Oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." *Powermatics, Inc. v. Globe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). See also *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993).

**Likelihood of Confusion**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We also must bear in mind that the fame of a plaintiff's mark, if it exists, plays a "dominant role in the process of balancing the DuPont factors." *Recot Inc. v. M.C. Becton*, 214 F.3d

1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

Petitioner's AUTOZONE Mark In Registration No. 1550569

We note that petitioner has neither pleaded nor proven that it owns a family of AUTOZONE marks. Therefore, we will concentrate our discussion of the issue of likelihood of confusion on that registration pleaded by petitioner for the mark and services most similar to those in respondent's challenged registrations; namely, petitioner's Registration No. 1550569 for the mark AUTOZONE for "retail auto parts store services". If we find that there is no likelihood of confusion with this registered mark in connection with the listed services, there is no need for us to consider the likelihood of confusion with the other registered marks. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Fame of Petitioner's AUTOZONE Mark

As noted, we are required to consider evidence of the fame of petitioner's mark(s) and to give great weight to such evidence if it exists. *See Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton, supra*; and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir 1992). "Famous marks thus enjoy a wide latitude of legal protection." *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897. This is true as famous marks

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are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. Id. Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." Id. See also *Bose Corp. v. QSC Audio Products Inc.*, *supra*, 63 USPQ2d at 1305.

In this case, we find that petitioner's AUTOZONE mark is famous in the field of retail auto parts store services. Petitioner has used its AUTOZONE mark for over 23 years and now has over 4000 retail auto part stores in the continental U.S. and Puerto Rico. Petitioner advertises in virtually every medium and its advertising and promotional expenditures have totaled over \$750 million since 1987. Petitioner's television advertising reaches approximately ninety percent of the U.S. population 40 times per year and its radio advertising reaches approximately ninety-five percent of the U.S. population approximately 100 times per year. Petitioner's website receives approximately 3.4 million visitors per month. Since 1992 petitioner's net sales have increased over six-fold and totaled 6.5 billion dollars in 2008.

Based on this evidence, we find that petitioner's AUTOZONE mark is famous. We recognize that petitioner has

not placed its sales and advertising figures in context, i.e., we do not know how substantial these figures are in terms of businesses that offer retail auto parts store services. We further recognize that petitioner has not provided direct evidence of recognition of its AUTOZONE mark on the part of consumers. However, we do not believe that is necessary here in view of the volume of sales and advertising expenditures and the fact that petitioner's advertising reaches over 90% of the U.S. population numerous times each year. In this regard, we note that our primary reviewing Court has accepted sales and advertising figures as indicia of the fame and strength of a mark even in the absence of the context for such figures. See *Bose Corp. v. QSC Audio Products Inc.*, *supra*, 63 USPQ2d at 1306.

Similarity of the Marks

We must now determine whether respondent's marks, DENT ZONE (typed or standard characters); and



and petitioner's AUTOZONE mark (typed drawing) when compared in their entireties in terms of appearance, sound and connotation are similar or dissimilar in their overall commercial impressions. See *Palm Bay Imports, Inc. v. Veuve*



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*Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the marks is likely to result. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ2d 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Initially, we find that in respondent's mark DENT ZONE THE AUTO BODY GUARD and design, the dominant feature of the mark is the term DENT ZONE. The wording DENT ZONE is presented in significantly larger characters than the wording THE AUTO BODY GUARD and also appears first in the mark. Thus, the significance of DENT ZONE in respondent's mark DENT ZONE THE AUTO BODY GUARD and design is reinforced by its location as the first portion of the mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark

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which is most likely to be impressed in the mind of a purchaser and remembered"). Further, consumers are often known to use shortened forms of names, and it is foreseeable that respondent's services will be referred to as DENT ZONE. Cf. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: "the users of language have a universal habit of shortening full names - from haste or laziness or just economy of words"). Also, we find that the wording THE AUTO BODY GUARD is in the nature of an advertising tagline emphasizing the dominant element DENT ZONE.

The design adds little impact to the commercial impression of the mark as the oval rings serve as a carrier for the wording and the lightning bolt emphasizes the letter Z in DENT ZONE. The design element also is subordinate to the wording DENT ZONE. Thus, it is the term DENT ZONE that persons would use in calling for respondent's services. To be clear, we do not ignore the wording THE AUTO BODY GUARD and design element in respondent's mark; however, we find that they do not suffice to distinguish the marks in terms of overall commercial impression.

Both of respondent's marks and petitioner's AUTOZONE mark consists of or contain the distinctive term ZONE preceded by a descriptive term which pertains to automobiles; AUTO, in petitioner's case, signifying

automobiles, and DENT, in respondent's case, signifying automobile dent repair. In addition, because both parties' marks include the word ZONE, they consequently are similar in connotation. Petitioner's AUTOZONE mark suggests a place where automobile parts and supplies may be purchased. Respondent's marks DENT ZONE and DENT ZONE THE AUTO BODY GUARD and design suggest a place where dents in automobiles are repaired. Thus, both petitioner's and respondent's marks suggest a place or zone for automobile-related services.

Finally, with respect to the sound of the respective marks, there is some similarity to the extent that they all contain the distinctive term ZONE. While we recognize that there is no similarity between the other words in the parties' marks, this difference is outweighed by the other similarities in the marks.

For the reasons discussed above, and particularly in view of the fame of petitioner's AUTOZONE mark, we find that when the parties' marks are compared in their entireties, they are more similar than dissimilar in appearance, sound and, in particular, connotation and convey similar commercial impressions.

Similarity of the Services

We turn next to a consideration of petitioner's "retail auto parts store services" and respondent's "vehicle repair

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and maintenance services, namely vehicle paint blemish repair, paintless dent removal, and windshield repair" and "providing extended service agreements for vehicle repair and maintenance services, namely paintless dent repair."

It is well established that the services of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they could or would be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); and *Monsanto Company v. Enviro-Chem Corp.*, 199 USPQ 590 (TTAB 1978).

As noted above, petitioner's services, as identified in the relevant registration, are "retail auto parts store services." As shown by the testimony, petitioner offers its services to the general public, primarily do-it-yourselfers, professional automotive installers, and personnel from automobile repair shops. Respondent's services, as identified in the involved registrations, are "vehicle repair and maintenance services, namely vehicle paint

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blemish repair, paintless dent removal, and windshield repair" and "providing extended service agreements for vehicle repair and maintenance services, namely paintless dent repair." As shown by the testimony, respondent's services are offered primarily to insurance companies, affinity clubs and pre-paid service providers who provide PDR services to the general public, namely, vehicle owners.

Comparing the parties' services, we find that they are sufficiently related in the marketplace that confusion is likely to result from contemporaneous use of the marks. In this regard, the testimony establishes that petitioner sells and loans tools and also sells parts used to repair dents in automobiles. Petitioner further made of record twenty-two use-based third-party registrations in which "retail auto parts store services" as well as automobile repair and maintenance services are included in the recitation of services. Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they suggest that the services identified therein are of a type which emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).

In short, both parties are offering services that pertain to the maintenance and repair of automobiles. Petitioner provides tools and parts used, inter alia, for dent repair, while respondent provides paintless dent repair and extended service agreements therefor. Petitioner further has shown that in addition to using the AUTOZONE mark for its retail auto parts services, it has also established prior use of the mark on auto parts and accessories themselves. In addition, petitioner has shown that it offers testing, repair, diagnosis and installation of automotive parts and accessories at its stores. Because of the range of goods and services in connection with which petitioner has used the AUTOZONE mark, persons would be likely to believe that respondent's services related to paintless dent repair offered under the marks DENT ZONE and DENT ZONE THE AUTO BODY GUARD and design are somehow affiliated with or sponsored by petitioner.

Channels of Trade and Classes of Purchasers

We have determined above that respondent's services are related to those of petitioner. In addition, there are no recited restrictions as to the channels of trade or classes of purchasers in either of the challenged registrations or petitioner's registration for AUTOZONE. It is settled that in making our determination regarding the relatedness of the parties' goods and/or services, we must look to the services

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as identified in respondent's involved registrations and petitioner's pleaded registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Because, as identified, the parties' services are unrestricted as to their manner of use, we must assume that respondent's paintless dent removal services and extended service agreements therefor are available to the same consumers at petitioner's retail auto parts store services, i.e., by automobile owners as well as those involved in repairing, maintaining and insuring automobiles.

Furthermore, to the extent that the parties' services may be the subjects of sophisticated purchases, even careful purchasers are likely to be confused by similar marks used in connection with related services. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. 'Human memories even of discriminating purchasers ... are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Therefore, the fact that some purchasers may

exercise care before utilizing these services does not mean there can be no likelihood of confusion. In the present case, the similarity between respondent's marks and petitioner's famous AUTOZONE mark as well as the relationship between the services as identified outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods].

Third-Party Use

The next factor we consider is the number and nature of similar marks in use in connection with similar services. In this regard, respondent submitted the testimony of Mr. Douglas C. Hansen, president of Automotive Services International. Mr. Hansen testified that since 2000, his company has offered automotive services, including repair service, under the mark TECHZONE.<sup>32</sup> However, Mr. Hansen further testified that his company's services primarily involve automotive airbag systems, occupant safety systems, wire harness repair and electrical repair.<sup>33</sup> Further, there is insufficient testimony regarding the nature and extent of

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<sup>32</sup> Hansen Testimony, p. 5, Exhibit 8.

<sup>33</sup> Id. at 6.



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use of the TECHZONE mark by this third party such that we may determine the extent to which the public has been exposed to this mark.

In addition, respondent cites to *AutoZone Inc. v. Strick*, 95 USPQ2d 1790 (N.D. Ill. 2010) in support of its contention that the defendant in that case used "WASH ZONE and OIL ZONE for car wash services since 1994 without any actual confusion."<sup>34</sup> However, the evidence in the district court case is not evidence in this proceeding. Moreover, defendant's use of WASH ZONE and OIL ZONE in the above case and the third-party use of TECHZONE discussed above is not sufficient to show that the public has had such widespread exposure to ZONE marks in the automotive field that petitioner's AUTOZONE mark should be entitled to only a narrow scope of protection. Apart from the fact that this shows at most three third-party uses, the evidence is of very limited probative value as there is no information about the extent of use or promotion of these uses. In short, this limited evidence does not prove that petitioner's AUTOZONE mark is weak and that confusion is unlikely. To the contrary, as we have already found, petitioner's AUTOZONE mark is a famous mark that is entitled to a broad scope of protection.

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<sup>34</sup> Brief, p. 18.

Actual Confusion

The final du Pont factor discussed by the parties is the lack of instances of actual confusion despite over 16 years of use by the parties of their respective marks. Respondent asserts that that the DENT ZONE mark has been used in 20-30 states since the mid-1990s.<sup>35</sup> Respondent further asserts that its business is substantial, currently averaging approximately 100,000 PDR contracts worth \$399 to \$699 per year. Respondent argues that the absence of actual confusion under the facts of this case suggests no likelihood of confusion.

While we acknowledge this factor weighs in respondent's favor, we also note that it is often difficult to adduce reliable evidence of actual confusion. *See, for example, Mallory & Church Corp.*, 25 USPQ2d 1236 (TTAB 1992). Furthermore, 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). Finally, the absence of actual confusion often is outweighed by other factors including, in this case, the fame of petitioner's AUTOZONE mark, the similarities between the marks and related nature of the services. *See, for example, Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001).

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<sup>35</sup> Good Testimony, p. 34.

Summary

When all of the relevant *du Pont* factors are considered, particularly the similarity of the identified services, the range of petitioner's goods and services, the commercial impressions of the marks, and the fame of petitioner's AUTOZONE mark, we find that respondent's use of DENT ZONE and DENT ZONE THE AUTO BODY GUARD and design for its recited services in the field of paintless dent repairs for automobiles is likely to cause confusion with respect to the retail auto parts store services offered by petitioner under its AUTOZONE mark.

**Decision:**

As discussed above, judgment is hereby entered against respondent on the ground of abandonment as to Registration No. 2885624.

The petition to cancel is granted on the ground of priority and likelihood of confusion as to both of respondent's challenged registrations. In view thereof, Registration Nos. 2604916 and 2829174 will be cancelled in due course.