

This Opinion is not a
Precedent of the TTAB

Mailed: October 8, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re 5K Car Store Inc.

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Serial No. 86054033

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Jeffrey D. Myers of Peacock Myers PC,
for 5K Car Store Inc.

Tamara Frazier, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

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Before Zervas, Kuhlke and Mermelstein,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

5K Car Store, Inc. (“Applicant”) seeks registration on the Principal Register of the mark LIFEXTEND (in standard characters) for the following services in International Class 37:

Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors.¹

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¹ Application Serial No. 86054033 was filed on September 3, 2013, based upon Applicant’s allegation of first use and use in commerce on June 23, 2013 under Section 1(a) of the Trademark Act.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified services, so resembles the mark EXTENDALIFE VPI (in typed form, VPI disclaimed) registered on the Principal Register for "reconditioning of electric motors" in International Class 37,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and requested reconsideration. In the request for reconsideration, in addition to arguing against the Section 2(d) refusal, Applicant requested a further amendment to the identification of services set forth above. The Examining Attorney denied the amendment as beyond the scope of the previously accepted amendment to the identification of services, and denied the request for reconsideration. Thereafter, the appeal was resumed. We reverse the refusal to register.

Identification of Services

By way of background, the original identification of services read as follows:

Vehicle reconditioning and safety and damage inspections
and disclosures.

In the first Office action, the Examining Attorney found the identification to be indefinite and required further specificity. In response, Applicant adopted the following identification which was suggested by the Examining Attorney:

² Registration No. 1357182, issued on August 27, 1985, Sections 8 & 15 declaration accepted and acknowledged, renewed. Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (July 2015).

Vehicle reconditioning services.

Thereafter, as noted above, Applicant sought to further amend the identification of services to the following, set forth in its request for reconsideration:

Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors.

The Examining Attorney asserts that the wording in the proposed amendment is not acceptable because it exceeds the scope of the previously accepted identification of services. Specifically, she argues that “‘repair’ and ‘maintenance’ services are defined more broadly than ‘reconditioning services’ and beyond the scope of the previously accepted identification of services.” Ex. Att. Br., 10 TTABVUE 12. She concludes that “the operative identification of services should be the previously accepted amendment, ‘vehicle reconditioning services.’” *Id.*³

Under Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a), an “applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services” The scope of the identification of goods or services is determined by the ordinary meaning of the wording. *See* TMEP § 1402.07(a) (July 2015). Once an applicant amends the identification of goods or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications and restricts the scope of the goods or services to that of the amended language. TMEP § 1402.07(e).

³ In the Final Office action, the Examining Attorney did not address the wording “excluding electric vehicles” in the requested amendment. In the brief, she only addresses this wording in the context of the Section 2(d) refusal, noting that it would not obviate a finding that the services are related. Because she did not expressly accept any part of the amendment and specifically asserts the operative identification is the prior accepted amendment, the refusal is to the requested amendment in whole, not in part. TMEP § 1402.07(d).

The Examining Attorney bases her refusal to accept the amendment on the ordinary meaning of the wording. To that end, she refers to definitions of the terms “recondition,” “vehicle maintenance” and “repair”:

Recondition - “bring into an improved condition”;⁴

Auto Maintenance – “the act of inspecting or testing the condition of car subsystems (e.g., engine) and servicing or replacing parts and fluids”;⁵ and

Repair – “to restore to sound condition after damage or injury; fix.”⁶

Applicant “believes that ‘reconditioning’ subsumes ‘repair’ and ‘maintenance.’” App. Reply Br., 11 TTABVUE 4. However, it is clear from the ordinary meaning of these words, even specifically in the automotive industry, that repair and maintenance are not wholly subsumed by the word reconditioning. As such, the proposed amendment impermissibly broadens the identification of services.

In view thereof, the Examining Attorney’s refusal to accept the proposed amendment is affirmed and the operative identification of services is the previously accepted amendment, “vehicle reconditioning services.”⁷

⁴ Vocabulary.com (www.vocabulary.com/dictionary), March 4, 2015 Office action, TSDR pp. 10-11.

⁵ Wikipedia (<http://en.wikipedia.org>) March 4, 2015 Office action, TSDR p. 7.

⁶ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2014). We grant the Examining Attorney’s request and take judicial notice of this dictionary definition. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁷ The electronic trademark file is corrected to reflect the operative identification “vehicle reconditioning services.” See TMEP §1402.15. Applicant indicated that if the amendment is not accepted it will “petition the Director to reopen the prosecution to address that requirement” and is “willing to amend the services after decision on the appeal to read

Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the Services/Channels of Trade/Consumers

With regard to the services, channels of trade and classes of consumers, we must make our determinations under these factors based on the services as they are identified in the registration and application. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods or services do not have to be identical or even

“Vehicle reconditioning services, excluding electric motors.” App. Reply Br., 11 TTABVUE 4. The Board does not have authority to reopen an application other than for entry of a disclaimer. Trademark Rule 2.142(g). The Director may reopen an application pursuant to a petition upon a showing of sufficient cause for consideration of any matter not already adjudicated. *Id.* *See also* TBMP § 1218 (June 2015) and TMEP § 1501.06.

competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). “[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). *See also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1403–04, 186 USPQ 476, 480 (C.C.P.A. 1975); *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1270 (TTAB 2007). It is sufficient that the goods or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347 (TTAB 2014).

Based on our decision above, we make our analysis on the last accepted amendment namely “vehicle reconditioning services.” Registrant’s services are identified as “reconditioning of electric motors.” As the Examining Attorney noted,

because the wording of the Registrant's identification does not specify the type of motor other than electric, it includes all electric motors, including those for vehicles. Thus, Applicant's attempt to limit the scope of the identification based on Registrant's actual industrial use is ineffective as we must make our analysis based on the scope of the services as identified. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, (765) (TTAB 1986). We recognize that at the time the registration issued in 1985 electric vehicles were not common and the scope of the identification based on ordinary meaning at that time might not have included electric vehicle motors, but it certainly does today. *See In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992) (quoting Examining Attorney brief) (“[D]espite the Applicant’s characterization of computer purchasers as sophisticated consumers, the growing tendency is for computers and computer programs to be purchased and operated by the general public. Business, home and educational use of computers has expanded the computer market to encompass many poorly informed and unsophisticated purchasers ...”).⁸

Based on the identifications, Registrant's services encompass Applicant's services specifically directed to vehicles.⁹ Even if we consider the limiting part of Applicant's identification to exclude electric motors, the evidence supports a finding that consumers are accustomed to seeing reconditioning services for electric and

⁸ Applicant's recourse would have been to petition to partially cancel the registration under Section 18, 15 U.S.C. §1068, to limit the identification to Registrant's actual use. TBMP § 309.03(d).

⁹ We further note examples in the record of single entities providing both industrial and vehicle motor or parts reconditioning and repair services. July 8, 2014 Office action, TSDR pp. 5, 12.

non-electric motors serviced by the same entity. *See, e.g.,* Bret's Autoworks,¹⁰ Denver Transmission,¹¹ MastersTouch Automotive,¹² and Superstitions Motors¹³ all servicing electric and non-electric motors.

In addition, because the services are legally identical and the identification of services in the cited registration is not limited to any specific channels of trade, we presume an overlap in trade channels and classes of purchasers. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (Board "was entitled to rely on this legal presumption in determining likelihood of confusion").

In view of the above, we find the services related and the channels of trade and classes of consumers overlap, and these *du Pont* factors weigh in favor of a likelihood of confusion.

As to the conditions of sale, Applicant's and Registrant's types of services are not the subject of impulse purchasing and would be purchased with a higher level of care but not necessarily with specialized knowledge. However, there is nothing specific in the record about the costs of these services or the purchasing process. *See, e.g., Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1413 (TTAB 2010) (products cost \$14,000 and \$47,000 respectively and testimony established that purchases of both products involve significant study and negotiation). This factor slightly favors Applicant.

¹⁰ (www.bretsautoworks.com) July 8, 2014 Office action, TSDR p. 3.

¹¹ (www.denvertransmissionpro.com) July 8, 2014 Office action, TSDR pp. 9-11.

¹² (www.masterstouchautomotive.com) July 8, 2014 Office action, TSDR pp. 19-23.

¹³ (superstitionmotors.com) July 8, 2014 Office action, TSDR pp. 28-31.

Similarity of the Marks

We consider the marks LIFEXTEND and EXTENDALIFE VPI and compare them “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) *quoting du Pont*, 177 USPQ at 567.

The Examining Attorney asserts that the dominant feature of the Registrant’s mark is EXTENDALIFE because VPI is disclaimed. It is not “improper to give more or less weight to a particular feature of a mark,” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985), and disclaimed matter is typically less significant, *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). However, because there is no evidence as to the significance of VPI, we have no way to evaluate how much or how little weight to give to this term. A disclaimer typically indicates the disclaimed term was found to be merely descriptive, but is it highly descriptive, generic, does its meaning exclude use for vehicles? For example, in *In re Dixie Restaurants, Inc.*, the word was CAFE an obviously generic term for restaurant services. Here, there is no obvious meaning for VPI and nothing in the record to guide us.¹⁴ Nonetheless, we agree, at minimum,

¹⁴ Disclaimed matter is typically weak not because it is disclaimed, but because of why it is disclaimed – usually because it is descriptive or generic. The important fact is the meaning of the disclaimed term in relation to the identified goods or services, not the disclaimer itself. While an examining attorney will only require a disclaimer of unregistrable matter, if an applicant offers a disclaimer of any matter in a mark, the USPTO will accept the disclaimer, even if the matter is registrable. TMEP § 1213.01(a)-(c). Further, the file of the cited registration is not automatically of record in an *ex parte* proceeding. *In re Sela Products LLC*, 107 USPQ2d 1589, 1583 (TTAB 2013) (“there is no equivalent rule for *ex*

the presence of the disclaimer reduces its source-identifying impact for purposes of our analysis.

Applicant argues that the marks are distinct “on the basis of sound, appearance and connotation.” App. Br. 8 TTABVUE 6-7. Specifically as to connotation, Applicant argues that “Registrant’s mark refers to a life in the singular tense, whereas LIFEXTEND does not.” *Id.* Finally, the Examining Attorney and Applicant differ in their view as to the effect of the transposition of the words LIFE and EXTEND. Applicant argues the addition of the A and the letter E is more pronounced than that present in *In re Akzona Inc.*, 219 USPQ (TTAB 1983) (SILKY TOUCH for yarns not confusingly similar to TOUCH O’ SILK for men’s clothing). The Examining Attorney asserts that the transposition is not sufficient to distinguish the marks, and points out that in *In re Akzona Inc.* “SILKY TOUCH connotes a characteristic of the way the goods feel ... whereas the mark TOUCH O’ SILK connotes the material featured in the goods (i.e., men’s clothing made, in part, of silk).” Ex. Att. Br., 10 TTABVUE 6.

“Where the sole significant difference between marks applied to similar goods or services is the transposition of the words which compose those marks and where the transposition of words does not change the overall commercial impression, confusion has been found.” *In re Wine Society of America Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (THE WINE SOCIETY OF AMERICA for wine club membership services

parte proceedings that makes the file of a cited registration of record”). Therefore, unless the term is obviously merely descriptive or generic, we have no way of knowing why it was disclaimed without the file of the cited registration or some other evidence. In this case, the file of the cited registration was not made of record.

confusingly similar to AMERICAN WINE SOCIETY 1967 for newsletter of interest to members).

In this case, the other differences between the marks consist of the following additions to Registrant's mark: (1) the disclaimed term VPI; (2) the letter E (the words LIFE and EXTEND share an E in Applicant's mark); and (3) the addition of the indefinite article A. We find these differences combined with the transposition of terms do create a distinct commercial impression in Registrant's mark. EXTENDALIFE VPI would be viewed as a phrase directed to a specific item, whereas LIFEXTEND would be viewed more as simply a term with a connotation of a more general effect. We further note that both marks are conceptually weak in that they are both highly suggestive of the purpose of the services or desired result of the services. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (CAPITAL CITY BANK for banking and financial services not confusingly similar to CITIBANK for banking and financial services); *In re Shawnee Milling Company*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour not confusingly similar to ADOLPH'S GOLD'N CRUST for coating and seasoning for poultry, fish and vegetables). Suggestive marks are entitled to a narrower scope of protection. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) ("Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts"); *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 160 USPQ 407,

408 (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods”).

In view thereof, we find the marks to be dissimilar and this *du Pont* factor weighs against a finding of likelihood of confusion.

In conclusion, because the marks are sufficiently dissimilar, and the services are not subject to impulse purchasing, confusion is not likely. *See In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006) (BOX SOLUTIONS not confusingly similar to BOX and design in view of weakness of BOX and the goods are not subject to impulse purchasing).

Decision: The refusal to register Applicant’s mark LIFEXTEND under Section 2(d) is reversed.