

This Opinion is not a
Precedent of the TTAB

Mailed: March 14, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Karapetian

—
Serial No. 87034208

—
Allan Howard Grant of Grant's Law Firm,
for Andrei Karapetian.

Angela Duong, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

—
Before Mermelstein, Ritchie, and Lynch,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Andrei Karapetian ("Applicant") seeks registration on the Principal Register of the mark ASM ALL STAR MOTORSPORTS and design, as shown below, for services ultimately identified as

Catalog ordering service featuring automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Electronic catalog services featuring automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high

performance and racing parts; Retail store services featuring automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Computerized on-line retail store services in the field of automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Conducting virtual trade show exhibitions online in the field of automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts,

in International Class 35¹:



The application disclaims the exclusive right to use the term “MOTORSPORTS” apart from the mark as shown. The application contains the following description: The mark consists of a triangle with a star in the center and the following letters ASM positioned below the triangle and words ALL STAR MOTORSPORTS are positioned below both the triangle and letters ASM.

The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), as likely to cause confusion,

¹ Serial No. 87034208, filed on May 12, 2016, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a) alleging dates of use and of first use on April 1, 2015.

mistake, or to deceive, based on the two registrations below, which are owned by different registrants:

1. The mark ALL STAR AUTO LIGHTS and design, as shown below, for “Wholesale and retail store services featuring automotive headlights,” in International Class 35 (the “156 registration”)²:



The registration disclaims the exclusive right to use the term “AUTO LIGHTS” apart from the mark as shown. The ‘156 registration contains the following description of the mark: The mark consists of a contemporary outline of an automobile, with “All Star” under it, and “Auto Lights” under the words “All Star.”

2. The mark ALLSTAR PERFORMANCE and design, as shown below, for “Wholesale distributorship in the field of high performance and racing automotive parts and accessories,” in International Class 42 (the “628 registration”)³:



² Registration No. 3993156 issued July 12, 2011. Sections 8 and 15 affidavits accepted and acknowledged.

³ Registration No. 2118628 issued December 9, 1987. Sections 8 and 15 affidavits accepted and acknowledged. Renewed.

The registration disclaims the exclusive right to use the term “PERFORMANCE” apart from the mark as shown.

After the Examining Attorney made the refusal final, Applicant filed a request for reconsideration. When the request for reconsideration was denied, Applicant filed this appeal, which is fully briefed. For the reasons discussed herein, we affirm the refusal as to both the ‘156 registration and the ‘628 registration.

I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co.*, 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 services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We consider the *du Pont* factors for which arguments or evidence were presented. The other factors, we consider to be neutral. We conduct our analysis as to each of the cited registrations, as discussed below.

A. The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir.



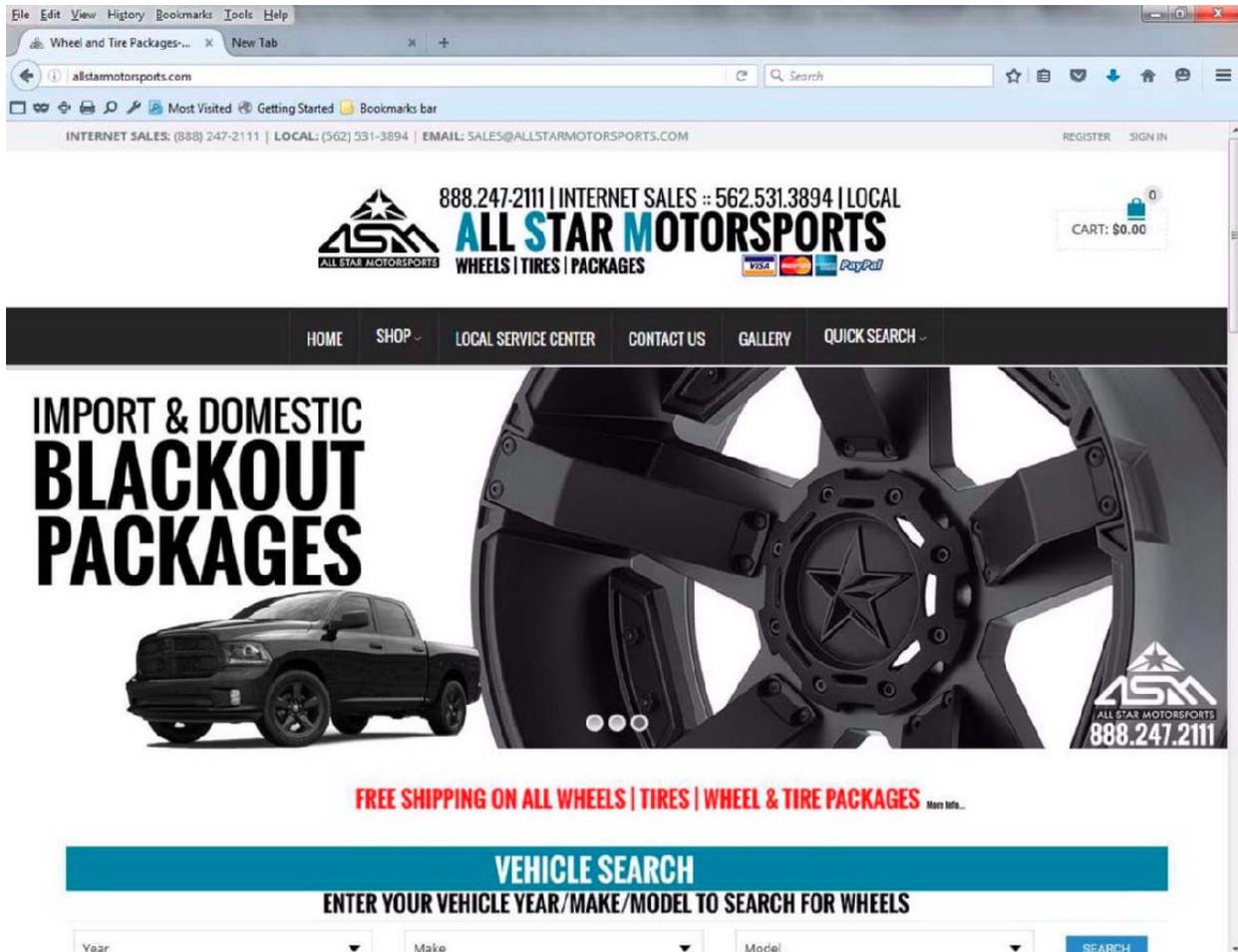
2005). We first consider the mark in the '156 registration, which contains the literal element “ALL STAR AUTO LIGHTS” with a design



resembling the outline of an automobile. Applicant’s mark, contains the literal element “ASM ALL STAR MOTORSPORTS,” with a design of a star in a triangle. Both marks contain the literal element “All Star,” either as a two-word term or as a compound word. In both marks, “All Star” is followed by a term that is descriptive of or generic for automotive goods, and that has been accordingly disclaimed. It is well-settled that disclaimed, generic or descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 41 USPQ2d at 1533-34; *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Applicant’s mark contains the additional literal element, “ASM” which, as presented in Applicant’s mark, appears to simply be an initialism for “All Star Motorsports,” and thus reinforces that wording in the mark. This is reflected in

Applicant's display of the term "ALL STAR MOTORSPORTS" with only the first letter of each word highlighted:⁴



Furthermore, while we recognize that both marks have design elements, it is the wording by which consumers will call for or refer to the respective services. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983)). This is further evidenced by the designs of the respective marks, both of which emphasize the wording therein. Applicant's star design emphasizes the "All Star" aspect of its mark,

⁴ As shown in Applicant's specimen, submitted with the May 12, 2016 application.

a term shared with the registrant of the ‘156 registration. The mark in the ‘156 registration, meanwhile, contains a design that evokes the automotive nature of the goods identified by both Applicant and the registrant of the ‘156 registration.

Applicant referred in its brief to third-party registrations containing the term “All Star.”⁵ The Examining Attorney objected to this reference, however, since copies of the registrations were not made of record. In order to make a third-party registration of record, a copy of the registration, either of the paper USPTO record, or taken from the electronic records of the Office, should be submitted. *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1456 n. 2 (TTAB 1998); and *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006) (citing *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974)). Merely listing such registrations, or referring to them in a brief, is insufficient to make them of record. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998); *see also* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1208.02 (2018). Furthermore, as the Examining Attorney points out, the record should be complete prior to the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Accordingly, we sustain the objection.

Nevertheless, we take judicial notice of the relevant dictionary definition of “all star” as “composed wholly or chiefly of stars or of outstanding performers or participants.”⁶ In this regard, we find the shared term “All Star” (or “Allstar”) to be

⁵ 10 TTABVUE 6.

⁶ Merriam-Webster.com. *See, e.g., In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

somewhat suggestive of automotive services that are promoted as being best in class. Nevertheless, there is no evidence that the term is otherwise weak and entitled to a more narrow scope of protection. The disclaimed wording in each mark – “Auto Lights” and “Motorsports” respectively – contributes to a similar automotive impression. We find that, considering each mark in its entirety, the connotation and commercial impression of Applicant’s mark and the mark in the ‘156 registration are similar.

We therefore find that in comparing the marks as a whole, while the Applicant’s mark and the mark in the ‘156 registration have some dissimilarities in sight and sound, they have many similarities, which are further enhanced by the similarities in both connotation and commercial impression. The first *du Pont* factor favors finding a likelihood of confusion as to the ‘156 registration.

As for the mark in the ‘628 registration, , the mark contains the literal element “Allstar Performance” with a design of a star. As noted above,

Applicant’s mark, , contains the literal element “ASM ALL STAR MOTORSPORTS,” with a design of a star in a triangle. Both marks contain the literal element “All Star,” either as a two-word term or as a compound word. Both marks also contain a term that is descriptive of automotive goods, and that has been accordingly disclaimed. As discussed above, it is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. With regard to the designs, as also discussed above, while we

consider the marks as a whole, it is typically the wording by which consumers will call for or refer to the respective services. *See Viterra*, 101 USPQ2d at 1911. For the reasons discussed above, we do not find the term “ASM” in Applicant’s mark, which is likely to be perceived as an acronym, to significantly distinguish the marks.

We note that both Applicant’s mark and the mark in the ‘628 registration contain a design of a star, which emphasizes the “All Star” term shared by both marks. While the star designs are slightly different, there is no evidence that star designs are weak with regard to automotive services, such that the mark in the ‘628 registration is entitled to a more narrow scope of protection. The shared wording and similar designs contribute to a similar connotation and commercial impression.

We therefore find that in comparing the marks as a whole, despite some dissimilarities in sight and sound, Applicant’s mark and the mark in the ‘628 registration overall appear and sound fairly similar, and the similarities in both connotation and commercial impression contribute to the overall similarity of the marks. Therefore, the first *du Pont* factor favors finding a likelihood of confusion as to the ‘628 registration as well.

B. Services, Trade Channels and Purchasers

When considering the similarity or dissimilarity of the services, we note that services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give

rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association between the providers of the parties' services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). We consider this factor as to each of the cited registrations.

The '156 registration identifies "[w]holesale and retail store services featuring automotive headlights." The '628 registration identifies "[w]holesale distributorship in the field of high performance and racing automotive parts and accessories." In an apparent attempt to limit its application to avoid the inclusion of these specific goods, Applicant's identification, as ultimately amended, identifies

Catalog ordering service featuring automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Electronic catalog services featuring automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Retail store services featuring automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Computerized on-line retail store services in the field of automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts; Conducting virtual trade show exhibitions online in the field of automobile parts namely Wheels, Rims, Tires, and Wheel, Rim and Tire Packages excluding auto lights, high performance and racing parts.

To show that these services are nevertheless related, the Examining Attorney submitted web evidence of retailers that offer both wheels or tires and automotive headlights, showing the services identified by Applicant in the '156 registration offered under the same mark. These include Auto Anything; Jegs; Pep Boys; Summit

Racing Equipment; Enjukuracing; and Lightning Force Performance. The Examining Attorney also submitted third-party websites that advertise the sale of wheels or tires, as identified by Applicant and of high-performance automotive parts and accessories as identified in the '628 registration. These include the following: JC Whitney; CarID; Pep Boys; Summit Racing Equipment; S&W Performance Group; Enjukuracing; Bryant Racing Equipment, Inc.; Smith Family tire & automotive; and Lightning Force Performance.⁷

The Examining Attorney further supported the relatedness of the services by submitting copies of third-party registrations that identify both “retail” and “whole sale” services in connection with various “automotive vehicle parts and accessories” (Registration No. 2937233) or “retail” and “wholesale” services in connection with “vehicles” and vehicle-related services. (Registration No. 5200648).⁸ Copies of use-based, third-party registrations may help establish that the goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

In addition to demonstrating the similarity of the services, these registrations show the similarity of the channels of trade for the application and for both registrations, including via retail and wholesale means of selling automobile parts and accessories. As to the channels of trade, web evidence in the record further shows

⁷ Attached to April 4, 2017 Office Action, at 16, 23; November 8, 2017 Final Office Action, at 7, 12, 16-20, 24-26; June 4, 2018 Denial of Request for Reconsideration at 48, 65-72, 77-78, 80, 84-85.

⁸ Attached to June 4, 2018 Denial of Request for Reconsideration, at 3, 24.

that consumers may expect both retail (or more specifically online retail) and wholesale services of selling automobile parts offered together from a single source.

The web page for Enjuku Racing states “We also wholesale the following manufacturers for dealers that are interested,” going on to list, among others, Volk Racing wheels, which are also listed as available for online retail purchase.⁹ The Examining Attorney also included the following excerpt of a news article from Investor’s Business Daily, which notes that retail chains have increasingly been serving as wholesale distributorships for automobile parts and accessories:

In days of old, auto parts companies mainly lured the DIY – do-it-yourself tinkerer. Professional mechanics and repair shops ordered their parts through dealership parts desks. But the retail chains have been gradually gaining more of the commercial or wholesale market, what the retailers now label the DIFM (do-it-for-me) market.¹⁰

We thus find that the services in the application and those of both cited registrations are related and are likely to travel through similar and even overlapping channels of trade to some of the same classes of consumers, including members of the public as well as to specialists. The second and third *du Pont* factors favor finding a likelihood of confusion.

C. Conditions of Sale

Applicant urges us to consider the sophistication and degree of purchaser care likely to be exercised by purchasers of the automobile parts at issue in this proceeding, arguing that the relevant consumers “are careful, sophisticated

⁹ Attached to June 4, 2018 Denial of Request for Reconsideration at 65-72.

¹⁰ Attached to June 4, 2018 Denial of Request for Reconsideration at 88-90.

purchasers that are unlikely to buy these items on impulse.”¹¹ The Court of Appeals for the Federal Circuit has noted, with regard to retail and wholesale services for automobiles and parts, that an analysis of sophistication must be considered “with respect to users as well as actual purchasers.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (finding a likelihood of confusion and quoting *Octocom Sys. Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Even if we were to assume that some of the relevant consumers may exercise a certain degree of care in selecting automobile parts, especially wholesale purchasers who might be expected to exercise some heightened care in their purchasing decisions, it is nevertheless well-established that even sophisticated consumers are not immune from source confusion where both the goods (or, as here, services) and the marks are similar. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011) (finding that although “it stands to reason wholesale buyers should be accorded a higher degree of purchaser sophistication over the general public in terms of determining susceptibility to confusion,” nevertheless, such consumers “are not immune from source confusion.” (cites omitted)).

Overall, we find this factor to be neutral or to weigh slightly against finding a likelihood of confusion. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (affirming that TTAB properly

¹¹ 10 TTABVUE 19.

considered all potential purchasers for recited services, including both sophisticated and unsophisticated investors, since precedent requires consumer care for likelihood-of-confusion decision be based “on the least sophisticated potential purchasers”).

D. Conclusion

After considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find as to both cited registrations that the marks are similar in sight, sound, connotation, and commercial impression, and that the services are related and travel through similar and at times overlapping channels of trade to both general consumers and to specialists. Even if we find that the universe of overlapping consumers may exercise a certain degree of care in their purchasing decisions, this is outweighed by the similarity of the marks, of the services, and of the channels of trade.

Overall, we find that there is a likelihood of confusion between Applicant’s applied-for mark and the marks in both of the cited registrations.

Decision: The Section 2(d) refusal to register Applicant’s mark is affirmed as to both Registration No. 3993156 and Registration No. 2118628.