

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 20, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Auto Parts Avenue, LLC
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Serial No. 87804250
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Tommy SF Wang of Wang IP Law Group PC for Auto Parts Avenue, LLC.

Drew Ciurpita, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Cataldo, Wellington and Kuczma, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Auto Parts Avenue, LLC, seeks registration on the Principal Register of the mark AUTO PARTS AVENUE (in standard characters, AUTO PARTS disclaimed), identifying the following goods:

Lights for vehicles; rear lights for vehicles; tail lights for vehicles, in International Class 11; and

Automotive door handles, in International Class 12.¹

¹ Application Serial No. 87804250 was filed on February 20, 2018, based upon Applicant's claim of use of the mark in commerce since January 15, 2007 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), as to both classes of goods. Applicant disclaimed "AUTO PARTS" in response to the Examining Attorney's requirement.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that AUTO PARTS AVENUE, when used in connection with the identified goods, so resembles the mark AUTOMOTIVE AVENUES (in standard characters with AUTOMOTIVE disclaimed), in two registrations issued on the Principal Register to the same entity for

Automobile dealerships; retail store services featuring automotive accessories, in International Class 35,² and

Automotive maintenance and repair, in International Class 37.³

as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and filed a Request for Reconsideration. When the Examining Attorney denied the Request for Reconsideration, this appeal resumed. The Examining Attorney and Applicant filed briefs.⁴ We affirm the refusal to register.

I. 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. (DuPont)*, 476

² Registration No. 3900245 ('245 Reg.) issued on January 4, 2011. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

³ Registration No. 3900325 ('325 Reg.) issued on January 4, 2011. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

⁴ Applicant filed its brief on June 12, 2019, prior to the Examining Attorney's July 30, 2019 denial of Applicant's April 15, 2019 Request for Reconsideration. On October 2, 2019, Applicant filed a "Supplemental Brief" and the Examining Attorney filed his brief thereafter on November 22, 2019. Applicant did not file a reply brief to the Examining Attorney's brief. We thus construe Applicant's "Supplemental Brief" as an early-filed reply brief.

F.2d 1357, 177 USPQ 563, 567 (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 relatedness of the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. Relatedness of the Goods and Services and their Channels of Trade

With regard to the goods and services, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods and services as they are identified in the application and cited registrations. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett Packard*, 62 USPQ2d at 1004).

Because there are no limitations as to channels of trade or classes of purchasers in the recitation of goods or services in either the cited registrations or the application, we must presume that the identified goods and services move in all channels of trade normal for such goods and services and are available to all potential

classes of ordinary consumers of such goods and services. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Applicant's goods are lights, rear lights and tail lights for vehicles in Class 11 and automotive door handles in Class 12. The services in the cited registrations include retail store services featuring automotive accessories, automobile dealerships, and automotive maintenance and repair. The "automotive accessories" that are the subject of the retail store services in the '245 Reg. are broadly worded and may be presumed to include automobile lights and door handles. Similarly, the "Automotive maintenance and repair" services identified in the '325 Reg. are broad enough to include repairing and possibly replacing automobile lights and door handles. Thus, Applicant's automotive goods appear to be related to the automotive services in the cited registrations as identified.

In support of the refusal of registration, the Examining Attorney introduced with her June 9, 2018 first Office Action⁵ and December 31, 2018 final Office Action⁶ printouts from the following third-party internet websites offering both automotive lights and door handles in particular, or automotive parts in general, on the one hand, and online retail store services featuring automotive parts or automotive repair and maintenance services on the other, under the same marks, including: CarID; Auto

⁵ At .pdf 116-188. All citations to the TSDR database in this decision are to the downloadable .pdf version of the documents.

⁶ At .pdf 71-111.

Parts Warehouse; Parts Geek; Advance Auto Parts; Pep Boys; Town Square Auto Parts; Ford; Chevrolet⁷ and Car Quest.⁸ This evidence demonstrates that at least nine third parties identify Applicant's goods and the services in the cited registrations under the same mark.

These websites demonstrate that goods of the type offered by both Applicant in both classes and the services identified in both cited registrations are marketed and sold together online under the same marks. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”). “We find that consumers would readily perceive these types of [goods and] services as being sufficiently related as to be offered by a single business.” *In re Integrated Embedded*, 120 USPQ2d 1504, 1515 (TTAB 2016).

In addition, the Examining Attorney introduced into the record with her June 9, 2018 first Office Action⁹ and December 31, 2018 final Office Action¹⁰ copies of five use-based, third-party registrations for marks identifying automotive parts, as well as retail automotive parts store services and automotive repair services. As a general proposition, although use-based, third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they

⁷ Chevrolet's website also offers automobile dealership services in addition to the services listed above.

⁸ At .pdf 7-14.

⁹ At .pdf 34-115.

¹⁰ At .pdf 10-53.

nonetheless may have some probative value to the extent they serve to suggest that the goods are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

In this case, the totality of the internet and third-party registration evidence demonstrates that the identified goods and services may emanate from the same sources under the same marks. In our likelihood of confusion analysis, these findings under the second *DuPont* factor support a finding that confusion is likely.

Applicant argues (internal citations omitted) that its

goods primarily consist of budget automobile parts sold online through Amazon.com for home repair or replacement. Conversely, Registrant's services consist primarily of automobile dealerships and automobile repair or detailing services which offer retail sale of goods in conjunction with its services. Unlike the Applicant, Registrant engages in the exact type of list price, "middlemen" activities which Applicant seeks to avoid through its online sales of parts for shipment direct to the consumer. Due to the significant differences in the nature of the goods and services involved and the nature in which they are offered to the public, confusion is not likely to occur between Applicant's goods and Registrant's services.¹¹

However, neither Applicant's automotive parts nor the services identified in the cited registrations are so limited. "We have no authority to read any restrictions or limitations into the [applicant's or] registrant's description of goods [or services]." *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009). Nor may an applicant restrict the scope of the services covered in the cited registration by argument or extrinsic

¹¹ 4 TTABVUE 12.

evidence. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). *See also Octocom Sys., Inc.*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”). We must therefore presume that Applicant’s automotive parts and Registrant’s services that sell, repair and maintain them, identified without limitation in all instances as to trade channels, consumers and cost, are available at all price points to all classes of consumers.

Evidence of record discussed above demonstrates that both Applicant’s goods and the services identified in the cited registrations may be encountered by the same classes of consumers under the same marks in at least one common trade channel, i.e., the physical locations and corresponding websites of entities providing automotive parts and automotive repair, maintenance and retail store services. Because the identifications of goods and services in the involved application and cited registration do not recite any limitations as to the channels of trade in which the goods or services are or will be offered under the marks, we must presume that these goods and services are offered in all customary trade channels. *See Citigroup v. Capital City Bank Grp.*, 98 USPQ2d at 1261; *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

We find that the *DuPont* factors of the relatedness of the goods and services, channels of trade and consumers weigh in favor of likelihood of confusion.

B. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of Applicant's and Registrant's subject marks.

DuPont, 177 USPQ at 567. Applicant argues (internal citations omitted) that

The first date of use for Applicant's Mark is January 15, 2007, whereas Registrant's first date of use of its marks date back to 1987. For twelve years, Applicant's Mark and the Registered Marks have coexisted in the minds of consumers without a single reported instance of actual confusion. Even if the Board finds Applicant's Mark and Registrant's mark to be similar for the purposes of likelihood of confusion, the fact that both marks have coexisted in use for over a decade demonstrate the improbability of any actual confusion.¹²

We do not accord significant weight to Applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the respective marks. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an *ex parte* proceeding:

With regard to the seventh *DuPont* factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The

¹² 4 TTABVue 17.

lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

In addition, the standard is likelihood of confusion, not actual confusion. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018). “[U]ncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1163 (Fed. Cir. 2019) (quoting *Majestic Distilling*, 65 USPQ2d at 1205). This especially holds true in an ex parte context, where there is no chance for a registrant to show what opportunity for confusion there has been based on registrant’s use and advertising of its mark. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204-05 (TTAB 2009).

Applicant’s assertion of lack of actual confusion thus carries little, if any, probative value. The seventh and eighth *DuPont* factors are neutral.

Applicant further argues that it has “priority” notwithstanding the later filing date for its involved application and acknowledgement that Registrant made earlier use of the mark in its cited registration. In any event, priority of use is not an issue in an ex parte Section 2(d) refusal of registration. *See, e.g., In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971) (applicant’s argument that its use

antedated a registered mark was effectively an improper collateral attack on the validity of the registration, which should have been made in formal cancellation proceedings). Trademark Act Section 2(d) precludes the registration of a mark which so resembles a mark registered by another as to be likely when applied to applicant's goods, to cause confusion. In view of the express language of the statute, the question of priority of use is not germane to an applicant's right to register in an ex parte context.

C. Similarity/Dissimilarity of the Marks

We consider Applicant's mark AUTO PARTS AVENUE and the registered mark AUTOMOTIVE AVENUES, both in standard characters, and compare them "in their entirety 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 *DuPont*, 177 USPQ at 567). The marks "must be considered ... in light of the fallibility of memory." *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The applied-for mark AUTO PARTS AVENUE and the registered mark AUTOMOTIVE AVENUES are similar in that both contain the term AVENUE[S], and the additional terms AUTO PARTS and AUTOMOTIVE are somewhat similar

in appearance and sound inasmuch as they share the term AUTO. With respect to the meanings of the marks, Applicant has introduced the following dictionary definitions with its April 15, 2019 Request for Reconsideration:¹³

AUTO – of or relating to automobiles;

PART – a portion or division of a whole that is separate or distinct, piece, fragment, fraction or section, constituent;

AUTOMOTIVE – pertaining to the design, operation, manufacture, or sale of automobiles; and

AVENUE – a wide street or thoroughfare, a way or means of entering into or approaching a place.

Based upon these definitions, Applicant’s AUTO PARTS AVENUE mark connotes a wide street or other means of approaching or reaching automobile parts. The registered AUTOMOTIVE AVENUES mark connotes a wide street or other means of approaching or reaching services pertaining to the design, operation, manufacture or sale of automobiles. These meanings or connotations are closely related inasmuch as both marks suggest a means of approaching or reaching goods or services related to automobiles and parts therefor.

The term AUTO PARTS in Applicant’s mark and AUTOMOTIVE in the registered marks are disclaimed and, as is the case here, disclaimed matter is often “less significant in creating the mark’s commercial impression.” *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). However, while a disclaimed term ... may be given little weight ... it may not be ignored.” *M2 Software Inc. v. M2*

¹³ At .pdf 16-27. All definitions retrieved from dictionary.com.

Communications Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006). The dictionary and third-party evidence of record establishes that the terms AUTO PARTS and AUTOMOTIVE are, at best, highly descriptive of the goods and services identified in the involved marks. “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.’” *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)). Nonetheless, even descriptive and generic terms have some impact on the overall commercial impression created by the marks. *See Juice Generation, Inc. v. GS Enters.*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (Board paid insufficient heed to the word JUICE in context of juice bar services).

Based upon the evidence of record, we find that AVENUE[S] is the most distinctive and dominant portion of the marks. As between AVENUE and AVENUES, we see little viable distinction. The term AVENUES in the registered mark will be perceived as the plural form of AVENUE in the applied-for mark and this distinction is not sufficient to prevent likely confusion. *Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (“it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar.”); *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (the singular and plural forms of SHAPE are essentially the same mark) (citing *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (CCPA 1957) (no material difference

between the singular and plural forms of ZOMBIE such that the marks were considered the same mark. Furthermore, there is no evidence of record that AVENUE[S] describes the goods or services at issue. Thus, the term AVENUE[S] appears to be arbitrary as applied to the respective goods and services and is essentially identical in appearance and sound.

Applicant argues (internal citations omitted) that

“AVENUE” is conceptually weak, generic, and descriptive in that it simply refers to a “wide street or main thoroughfare” upon which automobiles traverse. As such, both Applicant’s Mark and Registrant’s Marks consist of disclaimed or generic matter such that they may only be properly evaluated in their entireties. Even where variations are slight, consumers will be able to differentiate marks operating in this industry through subtle but distinct identifiers such as the use of “PARTS” or “MOTIVE” in addition to the goods sold or services offered.¹⁴

First, the evidence of record does not support Applicant’s contentions. While the terms AUTO PARTS and AUTOMOTIVE in the respective marks appear on this record to be, at best, highly descriptive of the identified goods and services, the evidence indicates that AVENUE[S] only somewhat suggests a feature of the goods and services, and therefore, is distinctive thereof. Second, neither mark features the term “MOTIVE,” but AUTO PARTS in Applicant’s mark and AUTOMOTIVE in the registered marks. Finally, in this ex parte proceeding, Applicant is not permitted to overcome a refusal by arguing that the mark in a cited registration is merely descriptive. The Court stated in *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997):

¹⁴ 4 TTABVue 14.

Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration. It is true that a prima facie presumption of validity may be rebutted. *See Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). However, the present ex parte proceeding is not the proper forum for such a challenge. *Id.* ("One seeking cancellation must rebut [the prima facie] presumption by a preponderance of the evidence."); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); TMEP Section 1207.01(c)(v) (1993).

See also Hecon Corp. v. Magnetic Video Corp., 199 USPQ 502, 507 (TTAB 1978) ("Applicant has also contended that the term 'COPYCORDER' is 'particularly descriptive' of opposer's goods and thus is entitled to but a limited scope of protection. Aside from the fact that the term 'COPYCORDER' is, in our opinion, only suggestive as applied to either opposer's or applicant's goods, the assertion of descriptiveness constitutes a collateral attack upon the validity of opposer's pleaded registration and as such cannot be entertained herein in the absence of a counterclaim to cancel the same"). Therefore, inasmuch as the cited marks are registered on the Principal Register, we must assume that it is at least suggestive and we cannot entertain Applicant's argument that the registered mark is descriptive of Registrant's services.

Turning to the marks in their entirety, we find that AUTO PARTS AVENUE and AUTOMOTIVE AVENUES are more similar than dissimilar in appearance and sound. The marks further are highly similar in connotation or meaning. We find, as a result, that the differences between the marks are outweighed by their similarities. Considered in their entirety, we find that the marks convey similar overall commercial impressions. This *DuPont* factor thus supports a finding that confusion is likely.

D. Conclusion

We find that the Applicant's goods identified in Classes 11 and 12 are related to the Class 35 and 37 services identified in the cited registrations and move in at least one common channel of trade to the same classes of consumers. We further find Applicant's mark AUTO PARTS AVENUE and the AUTOMOTIVE AVENUES marks in the cited registrations are more similar than dissimilar, and no evidence of record establishes that the most distinctive portion of the marks, i.e., AVENUE[S], is weak in connection with the goods or services at issue. To the extent we can determine the extent of coexistence of the marks at issue, the closely related nature of the goods and services and their trade channels as well as the similarity of the marks outweighs the asserted absence of actual confusion. We find, therefore, that confusion is likely between Applicant's mark AUTO PARTS AVENUE and the mark AUTOMOTIVE AVENUES in the cited registrations.

Decision: The refusal to register based on likelihood of confusion under Section 2(d) of the Trademark Act is affirmed as to both classes of goods.