

This Opinion is Not a
Precedent of the TTAB

Hearing: October 14, 2020

Mailed: November 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Simoniz USA, Inc.
—

Serial No. 87865135
—

John C. Linderman of McCormick, Paulding & Huber, LLP, for Simoniz USA, Inc.

Lyal L. Fox III, Trademark Examining Attorney,¹ Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Lykos, Larkin, and Lebow,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Simoniz USA, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark SIMONIZ CERAMICSHIELD for “Paint sealant for exterior surfaces of vehicles” in International Class 2.²

¹ Trademark Examining Attorney Dana L. Dickson examined the involved application, issued the final refusal to register from which this appeal was taken, and filed the appeal brief of the United States Patent and Trademark Office (“USPTO”). Trademark Examining Attorney Fox was assigned to the case following the completion of briefing and appeared on behalf of the USPTO at the oral hearing. We will refer to them both as the “Examining Attorney.”

² Application Serial No. 87865135 was filed on April 5, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark and first use of the mark in commerce at least as early as March 14, 2018.

The 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 it so resembles (1) the registered standard character mark PLATINUM CERAMIC SHIELD (CERAMIC disclaimed), and (2) the registered composite word-and-design mark shown below (CERAMIC disclaimed)



both owned by the same registrant ("Registrant") and both covering goods identified as a "Clear coating protectant containing ceramic nanoparticles for use on vehicles" in International Class 2,³ as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. The appeal is fully briefed,⁴ and counsel

³ Registration No. 5470824 of the standard character mark issued on May 15, 2018, while Registration No. 5476633 of the composite mark issued on May 22, 2018.

⁴ Citations in this opinion to the briefs and other materials on appeal, including the evidence made of record by Applicant in connection with remand of the application to the Examining Attorney following the completion of briefing, refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

for Applicant and the Examining Attorney appeared at a video hearing before the panel on October 14, 2020. We reverse the refusal to register.

I. Procedural Background and Record on Appeal⁵

A long and winding road leads to our door for final decision of this case. We summarize its major twists and turns below because they provide useful background for our analysis of the merits of the appeal.

In her first Office Action, the Examining Attorney refused registration of Applicant's mark on the basis of the cited registrations of PLATINUM CERAMIC SHIELD and PLATINUM CERAMIC SHIELD and design.⁶ She made of record TSDR pages regarding the cited registrations,⁷ an entry from the MERRIAM-WEBSTER DICTIONARY showing no listing for the term "simonize," and dictionary definitions of the words "platinum," "ceramic," "shield," "sealant," and "protectant."⁸

Applicant traversed the refusal in its response to the first Office Action,⁹ and made of record pages from the USPTO's Trademark Electronic Search System ("TESS") database regarding third-party registrations of, and applications to register, SHIELD-formative marks for various goods in which the word had been disclaimed,

⁵ Citations in this opinion to the application record through the request for reconsideration and its denial are to pages in the USPTO's Trademark Status & Document Retrieval ("TSDR") database.

⁶ June 11, 2018 Office Action at TSDR 1.

⁷ *Id.* at TSDR 2-7.

⁸ *Id.* at TSDR 8-13.

⁹ August 9, 2018 Response to Office Action at TSDR 23-25.

either alone or in combination with other words.¹⁰ Applicant's arguments succeeded, as the application was approved for publication for opposition and scheduled for publication in the USPTO's Official Gazette.¹¹

A few days before the scheduled date of publication, however, the Examining Attorney and her Managing Attorney requested, pursuant to Trademark Rule 2.84(a), 37 C.F.R. § 2.84(a), that the USPTO Director restore the Examining Attorney's jurisdiction over the application for purposes of issuing a subsequent office action.¹² The request was granted by the Commissioner for Trademarks, and jurisdiction over the application was restored to the Examining Attorney.

The Examining Attorney then issued an Office Action in which she reinstated and made final the original refusal to register based on the cited registrations. She made of record webpages that she claimed showed that the word "sealant" in the identification of goods in the application was essentially synonymous with the word "protectant" in the identifications of goods in the cited registrations,¹³ and webpages that she claimed showed use of the word "platinum" to indicate products of superior quality.¹⁴

Applicant appealed and requested reconsideration, making of record TESS database pages regarding the same third-party registrations of, and applications to

¹⁰ *Id.* at TSDR 2-22.

¹¹ September 26, 2018 Notice of Publication at TSDR 1.

¹² November 26, 2018 Administrative Response at TSDR 1.

¹³ December 14, 2018 Final Office Action at TSDR 14-18.

¹⁴ *Id.* at TSDR 2-13.

register, SHIELD-formative marks for various types of coatings in which the word had been disclaimed, either alone or in combination with other words.¹⁵

The Examining Attorney denied the request for reconsideration, making of record additional webpages displaying the word “platinum” and other words in what she asserted were product grade hierarchies,¹⁶ the registrations and applications resulting from a search of the USPTO’s XSearch database that she claimed showed that the combination of CERAMIC and SHIELD was extremely rare in registered and applied-for marks,¹⁷ an entry from the COLLINS DICTIONARY defining the word “simonize” as “to polish with or as with wax,”¹⁸ a definition of the word “polish” from the MERRIAM-WEBSTER DICTIONARY,¹⁹ and a Wikipedia entry regarding “paint sealant.”²⁰

The appeal was resumed and was fully briefed. Applicant then requested an oral hearing, 11 TTABVUE, but before the Board could schedule one, Applicant requested that the Board remand the application to the Examining Attorney “so that Applicant may introduce additional evidence in support of the Application,” 14 TTABVUE 2, consisting of copies of registrations of marks comprising or including Applicant’s house mark SIMONIZ, a declaration of Applicant’s President William Gorra (“Gorra

¹⁵ June 13, 2019 Request for Reconsideration at TSDR 12-32. It was unnecessary for Applicant to make the same evidence of record twice.

¹⁶ July 10, 2019 Denial of Request for Reconsideration at TSDR 2-13, 49-52.

¹⁷ *Id.* at TSDR 14-23, 25-46.

¹⁸ *Id.* at TSDR 24.

¹⁹ *Id.* at TSDR 47.

²⁰ *Id.* at TSDR 48.

Decl.”),²¹ and a complete definition of the word “simonize” from the COLLINS DICTIONARY, all attached as exhibits to the remand request. *Id.* at 7-42. The Board granted the request, 15 TTABVUE 1, and the application was remanded to the newly-assigned Examining Attorney for consideration of the new evidence. He found it unconvincing, and continued and maintained the final refusal.²²

The appeal was then resumed for the second time, 17 TTABVUE, and the panel conducted the oral hearing, at which Applicant and the Examining Attorney argued the merits, but also discussed the prosecution history, disagreeing about whether the application was actually published in the USPTO’s Official Gazette prior to the restoration of jurisdiction. Following the hearing, Applicant filed a document entitled “Motion to Correct the Record,” 24 TTABVUE 1, in which Applicant summarized the disagreement, and to which Applicant attached what it described as a copy of a page from the October 16, 2018 edition of the Official Gazette purporting to show publication on that date. *Id.* at 2-5. We need not resolve the dispute regarding publication or consider Applicant’s self-styled motion because whether or not the application was published is not germane to our disposition of the appeal, to which we now turn.

II. Analysis of Likelihood of Confusion Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the

²¹ We will cite the Gorra Declaration by paragraph number (e.g., “Gorra Decl. ¶ 4”).

²² April 6, 2020 Final Office Action at TSDR 1.

goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Applicant focuses in its appeal brief almost exclusively on the first *DuPont* factor, 7 TTABVUE 9-24, concluding that “SIMONIZ CERAMICSHIELD’ is not likely to cause confusion with the marks of the Cited Registrations since the marks are sufficiently *dissimilar with respect to appearance, sound, connotation, and commercial impression.*” *Id.* at 24 (emphasis in original). The Examining Attorney also devotes most of her brief to the first factor, 9 TTABVUE 6-20, although she also briefly discusses the second factor. *Id.* at 20-21.²³

²³ The Examining Attorney also states that the “similarity of the trade channels for the goods” is among the factors that “are most relevant,” 9 TTABVUE 6, but she does not discuss the third *DuPont* factor in her brief.

“[W]e confine our analysis of the issue of likelihood of confusion to that between Applicant’s mark and Registrant’s [PLATINUM CERAMIC SHIELD] mark in standard characters” in Registration No. 5470824 (the “824 Registration”). *In re Allegiance Staffing*, 115 USPQ2d 1319, 1325 (TTAB 2015). “If confusion is likely between these marks, there is no need for us to consider the likelihood of confusion with [Registrant’s composite] mark[],” but “if there is no likelihood of confusion between Applicant’s mark and [PLATINUM CERAMIC SHIELD] in standard characters, then there would be no likelihood of confusion with” the composite mark. *Id.* (citing *In re Max Capital Grp., Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010)).

A. Similarity or Dissimilarity of the Goods

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir 2018) (quoting *DuPont*, 177 USPQ at 567); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). The goods need not be identical but “need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “Apparently conceding the issue, Applicant did not address th[is] *du Pont* factor[] in

its brief, so we offer only a brief explanation of our conclusion” on it. *In re Morinaga K.K.*, 120 USPQ2d 1738, 1740 (TTAB 2016).

“We begin with the identifications of goods and services in the registration and application under consideration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *5 (TTAB 2019). The goods identified in the application are “paint sealant for exterior surfaces of vehicles,” while the goods identified in the registrations are a “clear coating protectant containing ceramic nanoparticles for use on vehicles.” The Examining Attorney argues that the goods “are overlapping and used for the same purpose (protective use on exteriors of vehicles),” 9 TTABVUE 21, because both are applied to the exteriors of vehicles, and the word “[s]ealant means ‘a substance that is put on a surface in order to protect it from air, water, etc.’; and ‘protectant’ means ‘a protecting agent.’” *Id.*²⁴ Applicant implicitly agrees, as it describes both sets of the identified goods as “protective coatings in Class 2” in several places in its appeal brief. 7 TTABVUE 11-14. We find that the second *DuPont* factor supports a finding of a likelihood of confusion.

B. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “Similarity in any one of these

²⁴ June 11, 2018 Office Action at TSDR 12-13 (MERRIAM-WEBSTER DICTIONARY). The Examining Attorney also made of record a few webpages showing that vehicle “sealants” and “protectants” have similar purposes. December 14, 2018 Final Office Action at TSDR 14-18.

elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).²⁵

1. Summary of Arguments²⁶

Because Applicant and the Examining Attorney essentially agree that the first *DuPont* factor is dispositive of the issue of likelihood of confusion, we summarize their key respective arguments below.

²⁵ The Examining Attorney argues that “[n]otably, **when, as here, the goods of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding that confusion is likely decreases.**” 9 TTABVUE 7 (emphasis in original) (citing *Cai*, 127 USPQ2d at 1801). Although we find above that the goods are related, the record does not support a finding that they are “identical or virtually identical,” so we do not find that the degree of similarity between the marks required for confusion to be likely is reduced.

²⁶ Because we focus solely on Registrant’s standard character mark, we do not summarize arguments specific to the composite word-and-design mark in the other cited registration.

a. Applicant's Arguments

With respect to the words CERAMIC and SHIELD in the cited mark and the compound word CERAMICSHIELD in its mark, Applicant argues that

the common wording between the marks that the Examining Attorney focuses on in determining the marks are confusingly similar, is wording that is either: (1) disclaimed as being merely descriptive ("CERAMIC"); or (2) commonly used, and disclaimed in a number of third party marks . . . for similar goods to those covered by Applicant's marks and the marks of the Cited Registrations, i.e., protective coating in Class 2, and, thus, descriptive or, at the very least, highly suggestive ("SHIELD").

7 TTABVUE 11-12. Applicant also argues that a dictionary definition of "shield" made of record by the Examining Attorney shows that "shield" is descriptive. *Id.* at 14-15.

Applicant contends that "the Examining Attorney minimizes the significance of the wording 'PLATINUM' and 'SIMONIZ' appearing at the beginning of the marks of the Cited Registrations and Applicant's marks, respectively," *id.* at 12, and that the marks are not confusingly similar because "the common element of the marks, i.e., 'CERAMIC SHIELD,' is weak because it is descriptive of the named goods, thus, it is unlikely that consumers will be confused, as the overall combinations have no other commonality." *Id.* Applicant claims that "because the shared wording is weak and descriptive, consumers recognize the wording 'SIMONIZ' and 'PLATINUM,' notably appearing at the beginning of the marks, as the dominant portions of the marks and are able to distinguish between the marks," *id.* at 16, and that "the words 'PLATINUM' and 'SIMONIZ,' appearing at the beginning of the marks are the

dominant portions of the respective marks, and bear no similarity to one another in meaning, appearance, or connotation.” *Id.* at 18.

Applicant objects to the Examining Attorney’s “new evidence purported [sic] to show that the word ‘SIMONIZE’ which, notably, is not the wording in Applicant’s mark, is a verb meaning ‘to polish with or as with wax,’” *id.*, incorrectly arguing that such evidence was not properly made of record when the Examining Attorney denied Applicant’s Request for Reconsideration, *id.* at 22-23, and arguing alternatively that a full page from the cited dictionary “notably indicates, just after where the Examining Attorney’s printout ends, that the ‘Word origin of ‘simonize’ is ‘SIMONIZ, a trademark for a metal polish’ referring to Applicant’s trademark.” *Id.* at 23.²⁷

Applicant devotes much of its reply brief to a discussion of the dictionary evidence regarding the word “simonize.” 10 TTABVUE 4-7. Applicant’s reply brief concludes as follows:

In the present case, the common element of the marks, i.e., “CERAMIC SHIELD,” is weak because it is descriptive of the named goods, thus, it is unlikely that consumers will be confused, because the overall combinations have no other commonality. More importantly, the non-common element SIMONIZ in Applicant’s mark is a trademark and serves as a source identifier as the Examining Attorney originally stated. The non-common element PLATINUM in the cited marks is not a source identifier, but is a grading term as Examining Attorney’s multiple citations prove.

²⁷ The Examining Attorney was entitled to make evidence of record in denying Applicant’s request for reconsideration. *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 715.03 (Oct. 2018). The Examining Attorney objected to the materials attached to Applicant’s brief in response to the alleged untimely evidence, 9 TTABVUE 15, and requested that the Board disregard them. That objection is moot because Applicant subsequently secured a remand of the application to make the referenced materials of record.

Lest it be overlooked SIMONIZ will never be confused with PLATINUM.”

Id. at 9.

b. The Examining Attorney’s Arguments

The Examining Attorney argues that “because the word portions of these marks all consist of a sequence of three words, the last two of which are ‘**CERAMIC**’ and ‘**SHIELD**’ appearing either with or without a space between them, the marks, overall, appear and sound very similar.” 9 TTABVUE 7.²⁸ She claims that “[w]ith respect to this shared wording, the marks are identical in sound and virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion.” *Id.* at 9. She further argues that because of the meanings of the words CERAMIC and SHIELD that are common to the marks, the “marks are very similar in meaning” because they “evoke a nonmetallic mineral that provides a protective cover.” *Id.* at 8.

The Examining Attorney claims that the words CERAMICSHIELD and CERMAIC SHIELD are the dominant portions of the both marks because “the more distinctive phrase in the applied-for and registered marks is ‘**CERAMIC SHIELD**’ and ‘**CERAMICSHIELD**’ notwithstanding the fact that registrant disclaimed the word ‘**CERAMIC**,’” *id.* at 13, and Applicant’s “arguments ignore the inherent weakness of the first elements of the applied-for and registered marks which are, at best suggestive.” *Id.* at 14. According to the Examining Attorney, “the wording

²⁸ All bolding in the Examining Attorney’s discussion of the marks or their components was supplied by the Examining Attorney.

‘**PLATINUM**’ in the registered marks is suggestive of a certain level of quality, and the wording ‘**SIMONIZE**’ means ‘to polish with or as with wax.’” *Id.* She contends that

Although applicant spells the word “**SIMONIZE**” in the applied-for mark as “**SIMONIZ**,” consumers will still perceive the wording “**SIMONIZ**” as suggesting “**SIMONIZE**.” Because the word “**SIMONIZ**” has no dictionary definition but is the phonetic equivalent of the word “**SIMONIZE**,” consumers will likely perceive the word “**SIMONIZ**” as suggesting “**SIMONIZE**.” The word “**SIMONIZ**” is therefore suggestive of the intended purpose of applicant’s goods.

Id.

The Examining Attorney argues in the alternative that even if Applicant holds rights in the mark **SIMONIZ**, this “does not mean that **SIMONIZE** has no dictionary definition,” or “bar it from becoming a term with a meaning that is generally understood by the public and defined in English language dictionaries, as established by the inclusion of the term **SIMONIZE** in Collins Dictionary online.” *Id.* at 17.

The Examining Attorney concludes that “[b]ecause the wording ‘**CERAMIC SHIELD**’ within the registered mark is wholly encompassed within applicant’s mark, purchasers are likely to believe that **SIMONIZ CERAMICSHIELD** and **PLATINUM CERAMIC SHIELD** identify two product lines that both emanate from **CERAMIC SHIELD**,” *id.* at 18, “because the wording ‘**PLATINUM**’ is often used in the marketplace to indicate within a line of similar services or products those which are of superior quality (and which are also commonly more expensive).” *Id.* at 18-19. She claims that “[a]lthough the additional wording in the applied-for and registered marks (specifically, **SIMONIZ** and **PLATINUM**), is non-descriptive, consumers

might still be confused and conclude that **SIMONIZ CERAMICSHIELD** and **PLATINUM CERAMIC SHIELD** identify two product lines that both emanate from **CERAMIC SHIELD.**” *Id.* at 19.

2. Analysis of Similarity or Dissimilarity of the Marks

The marks must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). Because Applicant and the Examining Attorney disagree sharply regarding the dominant portions of the involved marks, and because the Examining Attorney’s arguments under the first *DuPont* factor rely heavily on the premise that CERAMIC SHIELD is the dominant portion of each mark, we will begin by determining the marks’ dominant portions.

Applicant’s mark SIMONIZ CERAMICSHIELD begins with Applicant’s house mark SIMONIZ, which the record shows is the subject of several registrations for various coating products for automobiles, and related goods, 14 TTABVUE 7-9, 15, 21-22, has been in use in connection with paint sealants, polishes, and cleaners for over 100 years, is the oldest brand of car-care products and services in the United States, and has been associated with substantial sales revenues over the past 20 years. Gorra Decl. ¶¶ 4-5, 9. As the first part of Applicant’s mark, the SIMONIZ house mark is presumptively the portion “which is most likely to be impressed upon the mind of a purchaser and remembered,” *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9

USPQ2d 1895, 1897 (TTAB 1988), particularly given its long and extensive use for the sort of goods identified in the application, and the Examining Attorney did not show otherwise.

We are not persuaded by the Examining Attorney's argument that Applicant's house mark SIMONIZ "is suggestive of the intended purpose of applicant's goods," 9 TTABVUE 14, because it "is the phonetic equivalent of the word 'SIMONIZE,' *id.*, which the Examining Attorney claims "means to polish with or as with wax." *Id.* (citing the COLLINS DICTIONARY). The Examining Attorney's claim is based on that single dictionary entry, which also states that the origin of the putative verb "simonize" is "SIMONIZ, a trademark for a metal polish." 14 TTABVUE 34. We note in that regard that the Examining Attorney also made of record the results of a search for the word "simoniz" in the MERRIAM-WEBSTER DICTIONARY, which stated that "[t]he word you've entered isn't in the dictionary."²⁹ In any event, the issue before us is not whether "simonize" is the generic name of any goods or services, but rather whether SIMONIZ CERAMICSHIELD is confusingly similar to PLATINUM CERAMIC SHIELD. For purposes of that issue, the record does not support a finding that when SIMONIZ appears in Applicant's mark, it has any non-source identifying significance.

The record shows that the compound word CERAMICSHIELD in Applicant's mark is highly suggestive, if not descriptive, in connection with the identified goods. The Examining Attorney made of record a definition of "ceramic" as "of or relating to

²⁹ June 11, 2018 Office Action at TSDR 8.

the manufacture of any product (such as earthenware, porcelain, or brick) made essentially from a nonmetallic mineral (such as clay) by firing at a high temperature; *also*: of or relating to such a product,”³⁰ and the word was disclaimed in both of the cited registrations because it describes an ingredient of a “clear coating protectant containing ceramic nanoparticles for use on vehicles.”³¹

Applicant’s specimen of use states that Applicant’s “paint sealant for exterior surfaces of vehicles” is a “Proprietary Glass/Ceramic Compound Mixture”:



32

The word CERAMIC is not disclaimed in Applicant’s mark even though it appears to describe an ingredient of the goods, presumably because it is part of the compound word CERAMICSHIELD, and the TMEP provides that “[i]f a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required.” TMEP Section 1213.05(a). Nevertheless, the dictionary definition and

³⁰ June 11, 2018 Office Action at TSDR 10 (MERRIAM-WEBSTER DICTIONARY).

³¹ *Id.* at TSDR 2-7.

³² April 5, 2018 Application at TSDR 3. A specimen of use may be evidence that a term is descriptive of the relevant goods or services. *See, e.g., In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017).

Applicant's specimen show that CERAMIC has little, if any, ability to identify source when used in connection with Applicant's goods.

With respect to SHIELD, the Examining Attorney also made of record a definition of the word in its verb form as "to protect with or as if with a shield: provide with a protective cover or shelter,"³³ and we take judicial notice that in its noun form, "shield" means, among other things, "something or someone that protects or defends" and "a device or a device or part that serves as a protective cover or barrier."³⁴ When CERAMIC and SHIELD are joined in the compound word CERAMICSHIELD in Applicant's mark, the combination strongly suggests that Applicant's "paint sealant for exterior surfaces of vehicles" provides a protective cover for the exterior vehicle surfaces through the use of a ceramic-based mixture.

The position of the word SIMONIZ at the beginning of Applicant's mark, its status as Applicant's longstanding house mark, and the fact that it modifies the weak compound word CERAMICSHIELD that follows it, collectively provide rational reasons to find that SIMONIZ, not CERAMICSHIELD, is the dominant portion of Applicant's mark. *Detroit Athletic Co.*, 128 USPQ2d at 1049.

Within the mark PLATINUM CERAMIC SHIELD in the '824 Registration, the first word PLATINUM modifies the words CERAMIC SHIELD in essentially the same way in which Applicant's house mark SIMONIZ modifies the compound word

³³ June 11, 2018 Office Action at TSDR 11 (MERRIAM-WEBSTER DICTIONARY).

³⁴ MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on November 3, 2020). "The Board may take judicial notice of dictionary definitions, including online dictionaries, definitions in technical dictionaries and translation dictionaries that exist in printed format," *In re Omniome, Inc.*, 2020 USPQ2d 3222, *2 n.17 (TTAB 2019).

CERAMICSHIELD in Applicant's mark. The Examining Attorney made of record evidence that the word "platinum" may suggest a higher or premium level of quality when it is used in connection with motor oils, bleaches, liquid gels, carwashes, painter's tape, dish soaps and detergents, basketball backboards, software plugins, carpet cleaning solutions, carpet and upholstery detergent, trash bags and garbage can liners, flooring, and mattresses,³⁵ but no evidence that PLATINUM has such a laudatory meaning for a "clear coating protectant containing ceramic nanoparticles for use on vehicles." In its reply brief, however, Applicant stated that "PLATINUM in the cited marks is not a source identifier, but is a grading term as Examining Attorney's multiple citations prove," 10 TTABVUE 9, and at the oral hearing Applicant's counsel characterized PLATINUM as a grade designation.

In the mark in the '824 Registration, the word CERAMIC has been disclaimed as descriptive of an ingredient of the registrant's "clear coating protectant containing ceramic nanoparticles for use on vehicles," and, as in Applicant's mark, when CERAMIC appears before SHIELD, the resulting phrase strongly suggests that the registrant's goods, like Applicant's, will provide a ceramic-based protective cover for vehicles.³⁶ Indeed, the Examining Attorney acknowledges that in view of the

³⁵ December 14, 2018 Office Action at TSDR 2-13; July 10, 2019 Denial of Request for Reconsideration at TSDR 2-13, 49-52.

³⁶ In their briefs, Applicant and the Examining Attorney dispute the impact of third-party registrations of marks containing the words CERAMIC and SHIELD. We need not resolve their dispute because we find that the other materials in the record discussed above establish the highly suggestive, if not descriptive, meaning of the combination of those words in connection with the involved goods.

dictionary definitions of “ceramic” and “shield,” both marks “evoke a nonmetallic mineral that provides a protective cover.” 9 TTABVUE 8.

In the context of Applicant’s argument as a whole, its characterization of PLATINUM as a “grading term,” 10 TTABVUE 9, or a grade designation, is effectively a concession that it is not as distinctive as SIMONIZ. The word PLATINUM has not been disclaimed in either of the cited registrations, however, and, as noted above, the Examining Attorney acknowledges that PLATINUM is “non-descriptive,” 9 TTABVUE 19, when used in connection with the goods in the ’824 Registration. Accordingly, we find that the word PLATINUM is inherently distinctive when it appears in the PLATINUM CERAMIC SHIELD mark in the ’824 Registration, and that it is, at most, highly suggestive of the identified goods, such that it has source-identifying significance in its lead-off position in the mark because it modifies the weaker phrase CERAMIC SHIELD, which we have found above to be highly suggestive, if not descriptive, of the goods. The position of the suggestive word PLATINUM at the beginning of the mark in the ’824 Registration, its inherent distinctiveness, and the relatively weaker nature of the phrase CERAMIC SHIELD that it modifies, provide rational reasons to find that PLATINUM, not CERAMIC SHIELD, is the dominant portion of the mark in the ’824 Registration. *See Detroit Athletic Co.*, 128 USPQ2d at 1049-50.

We turn now to the required comparison of the SIMONIZ CERAMICSHIELD and PLATINUM CERAMIC SHIELD marks in their entirety, giving more weight in the comparison of the marks to their respective dominant lead words SIMONIZ and

PLATINUM than to their weaker common elements, the words CERAMIC and SHIELD.

The marks have some similarities in appearance, sound, and connotation and commercial impression because of the common presence of the words CERAMIC SHIELD. The Examining Attorney argues that “[w]ith respect to this shared wording, the marks are identical in sound and virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion.” 9 TTABVUE 9. We disagree that the presence of these common elements, and the resulting similarities in sound and appearance, are sufficient to make the marks confusingly similar when they are considered in their entireties and greater weight is given to the marks’ respective dominant portions. The cases cited by the Examining Attorney in support of this argument all involved marks that contained **only** identical common elements, not marks whose common elements were accompanied by other elements,³⁷ and they do not support a claim that the marks, in their entireties, are confusingly similar because they contain common elements that are identical in appearance and sound.

The Examining Attorney similarly argues that the marks have very similar commercial impressions because “consumers are likely to perceive **SIMONIZ** as the previously anonymous source of the **CERAMIC SHIELD** goods offered at different

³⁷ *Seaguard Corp. v. Seaward Int’l, Inc.*, 222 USPQ 48, 51 (TTAB 1984) (finding that SEA GUARD and SEAGUARD were “in contemplation of law, identical.”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (finding that BEEFMASTER and BEEF MASTER were “practically identical”); *Stock Pot, Inc. v. Stockpot Rest., Inc.* 220 USPQ 52, 52 (TTAB 1983) (finding that there was “no question” that the marks STOCK POT and STOCKPOT were confusingly similar), *aff’d*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

levels of quality, including a **PLATINUM** level of quality,” *id.* at 17, and that “[a]lthough the additional wording in the applied-for and registered marks (specifically, **SIMONIZ** and **PLATINUM**), is non-descriptive, consumers might still be confused and conclude that **SIMONIZ CERAMICSHIELD** and **PLATINUM CERAMIC SHIELD** identify two product lines that both emanate from **CERAMIC SHIELD**.” *Id.* at 19. The Examining Attorney cites a non-precedential decision of the Board, *In re My Other Bag Inc.*, Serial No. 85521133 (TTAB Nov. 16, 2015), in support of the latter argument. *Id.* We are not bound by that decision, *see, e.g., Stawski v. Lawson*, 129 USPQ2d 1036, 1048 (TTAB 2018), but it does not support the Examining Attorney’s position in any event.

In *My Other Bag*, the Board affirmed a refusal to register MY OTHER BAG . . . for tote bags based on a likelihood of confusion with the mark THE OTHER BAG BY ALDO for similar goods. The Board found the “initial phrase ‘THE OTHER BAG’ to be the dominant feature of” the cited mark, 14 TTABVUE 6 (Serial No. 85521133), and further found that the “remaining wording ‘BY ALDO’ is more likely to be perceived by consumers as a tag line or house mark, and as such, fails to obviate the likelihood of confusion,” *id.*, and that “[w]hile the possessive determiner ‘MY’ in Applicant’s mark and the definite article ‘THE’ in Registrant’s mark may sound different and have different meanings, their significance is minimized by the subsequent, identical and more distinctive phrase ‘OTHER BAG,’ notwithstanding Applicant’s and Registrant’s disclaimers of the word ‘bag.’” *Id.* at 7. The Board cited a line of cases holding that the addition of a house mark to another mark may not

make confusion unlikely. *Id.* at 6-7 (citing *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985); *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007)). The instant case is not analogous to either *My Other Bag* or the cases that it cited.

The *Chica* case, which was discussed by the Examining Attorney at the oral hearing and by Applicant in its appeal brief, 9 TTABVUE 19-21, illustrates why. In *Chica*, the Board affirmed a refusal to register the mark shown below for jewelry



over the registered mark shown below for the same goods



The Board found that the marks were confusingly similar because both marks

contain the identical word CORAZON, which is translated as 'Heart.' It is the only word in registrant's mark and it is the first word in applicant's mark. The only other words in applicant's mark are the phrase 'BY CHICA.' These words are translated as 'By Girl.' Applicant's corporate name is Chica, Inc. As such, to many consumers, applicant's mark for the identical word 'Corazon' followed by the phrase 'BY CHICA' will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON.

Chica, 84 USPQ2d at 1848-49. The Board noted that in a similar case, it had “held that: ‘those familiar with only applicant’s mark [SPARKS BY SASSAFRAS and design] would, upon encountering the registered mark [SPARKS] on related goods, assume that all ‘SPARKS’ products come from a single source, and that that source was in some instances further identified with the words ‘by sassafras.’” *Id.* at 1849 (quoting *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986)).

Here, Applicant has added its house mark SIMONIZ to the compound word CERAMICSHIELD, but to fall within the line of cases discussed in *My Other Bag*, including *Chica* and *Apparel Ventures*, the cited mark would have to consist **solely** of CERAMICSHIELD or its equivalent CERAMIC SHIELD, and the PLATINUM CERAMIC SHIELD mark in the ’824 Registration consists of more than just the words CERAMIC SHIELD that also appear as a compound word in Applicant’s mark.

Given the nature of the cited mark, and our finding that the words CERAMIC SHIELD in the cited mark are highly suggestive, if not descriptive, of the goods, we reject the Examining Attorney’s arguments that consumers might “conclude that **SIMONIZ CERAMICSHIELD** and **PLATINUM CERAMIC SHIELD** identify two product lines that both emanate from **CERAMIC SHIELD**,” 9 TTABVUE 19, and that “consumers are likely to perceive **SIMONIZ** as the previously anonymous source of the **CERAMIC SHIELD** goods offered at different levels of quality, including a **PLATINUM** level of quality.” *Id.* at 17.

The lead words PLATINUM and SIMONIZ in the marks “are their dominant portion and are likely to make the greatest impression on consumers,” *Detroit Athletic*

Co., 128 USPQ2d at 1049, and they are entirely dissimilar in appearance, sound, and connotation and commercial impression. Given the weakness of the terms CERAMIC SHIELD and CERAMICSHIELD, the similarities between the marks engendered by the common presence of the terms are outweighed by the dissimilarities driven by the dominant lead elements SIMONIZ and PLATINUM, which, as the first portions of the marks when they are viewed, heard, and recalled, are the portions “which may make the greatest impression on the ordinary buyer” regarding the source of the respective goods. *Id.* (quoting 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:42, at 23-245 (5th ed. 2018)). We find that the first *DuPont* factor does not support a finding of a likelihood of confusion.

C. Conclusion

Although the goods are related, the marks are sufficiently different when considered in their entireties to make confusion unlikely. *See In re Medline Indus., Inc.*, 2020 USPQ2d 10237, *13 (TTAB 2020) (citing *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998); *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991)). We find that a consumer with a general recollection of the cited standard character mark PLATINUM CERAMIC SHIELD who subsequently encounters Applicant's mark SIMONIZ CERAMICSHIELD is not likely to believe that Applicant's goods originate with, or are authorized or sponsored by, the owner of the cited mark.

Decision: The refusal to register is reversed.