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Oral Hearing.
June 10, 1997

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 8
GDH/gdh

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re A P.S., Inc.

Sams
Octus

Serial No. 74/591,655

David A. Greenlee, Esq. for A P S., Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 104
(Sidney I. Moskowitz, Managing Attorney).

Before Hanak, Hohein and Walters, Administrative Trademark
Judges

Opinion by Hohein, Administrative Trademark Judge:

A P S., Inc has filed an application to register on
the Principal Register the mark "AMERICA'S PARTS PROS" for
"retail auto parts store services" ¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when applied to its goods, so resembles the
mark "THE PARTS PROS," which is registered on the Supplemental
Register for "distributorship services in the field of

¹ Ser. No 74/591,655, filed on October 27, 1994, which alleges a bona
fide intention to use the mark in commerce The word "AMERICA'S" is
disclaimed

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replacement parts for vehicles,"² as to be likely to cause confusion, mistake or deception. Registration also has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the words "AMERICA'S PARTS," which the Examining Attorney found to comprise a unitary descriptive phrase within the meaning of Section 2(e) of the Trademark Act, 15 U S C. §1052(e).

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the likelihood of confusion refusal, but affirm the disclaimer requirement.

Turning first to the disclaimer requirement, we note that, at the oral hearing, applicant offered to disclaim either the phrase "AMERICA'S PARTS" or the words "AMERICA'S" and "PARTS". The Examining Attorney, as clarification of her position, asserted at the oral hearing that she was not arguing that the words "AMERICA'S PARTS" were a unitary phrase, but rather that, in accordance with Patent and Trademark Office ("PTO") practice, a disclaimer of such words must be in the form of "AMERICA'S PARTS" instead of "AMERICA'S" and "PARTS" separately.

We concur with the Examining Attorney's disclaimer requirement to the extent that, as applied to applicant's retail auto parts store services, it is plain that the geographical term "AMERICA'S" is primarily geographically descriptive, within the

² Reg. No. 1,579,673, issued on January 23, 1990, which sets forth dates of first use of April 15, 1983, combined affidavit §§8 and 15. The word "PARTS" is disclaimed.

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meaning of Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), of such services when they are rendered in the United States of America and it is also clear that the generic term "PARTS" is merely descriptive, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), of applicant's retail store services for auto parts. Accordingly, a disclaimer of the descriptive words "AMERICA'S" and "PARTS" is proper under Section 6(a) of the statute. However, in light of the clarification furnished by the Examining Attorney, we need not determine whether such words form a unitary phrase,³ instead, we need only consider whether PTO practice requires that the disclaimer be of the combined words "AMERICA'S PARTS" or whether it may take the form in which those words are set forth separately.

Inasmuch as we see nothing in PTO practice, as set forth in TMEP Section 1213.09(a)(1),⁴ which requires, in the

³ See, e.g., TMEP Section 1213.06(a), which is entitled "Unitary Matter in General," for a discussion of PTO practice with respect to a disclaimer of unitary matter. We also observe that, as stated in *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1664 (Fed. Cir. 1994) at n. 8, "[w]hile the TMEP does not have the force of law, it sets forth guidelines and procedures followed by the Examining Attorneys at the PTO."

⁴ Such section, which is entitled Standardized Printing Format for Disclaimer, merely provides that:

As of November 9, 1982, disclaimers for marks published for opposition and those registered on the Supplemental Register are printed in a standardized form in the Official Gazette, regardless of the text submitted. Disclaimers are in the standardized format in certificates of registration on the Supplemental Register issued as of that date. Disclaimers are in the standardized format in certificates of registration on the Principal Register issued as of February 1, 1983. The disclaimed matter is taken from the disclaimer of record and inserted into the

absence of a proper requirement for a disclaimer of a unitary phrase, that an applicant's disclaimer of descriptive words take the exact format of that which will be utilized by the PTO when the disclaimer is printed on the certificate of registration, and since in any event applicant has indicated a willingness to submit whatever form of a disclaimer of the words "AMERICA'S" and "PARTS" which will advance the prosecution of its application, we affirm the disclaimer requirement to the extent that applicant will be allowed thirty days from the mailing date of this decision to submit an appropriately amended disclaimer of the words "AMERICA'S PARTS".⁵

standardized disclaimer format for printing and data base purposes. The standardized disclaimer text is as follows

No claim is made to the exclusive right to
use , apart from the mark as shown.

See notice at 1022 TMOG 44 (September 28, 1982) See also In re Owatonna Tool Co., 231 USPQ 493, 495 (Comm'r Pats. 1983) ("[T]he use of the standardized form is solely for the purpose of printing and data base purposes, not for the limitation of registrant's rights.")

For the record only, examining attorneys continue the past practice of accepting disclaimers with additional statements pertaining to reservation of common law rights, although §6 of the Trademark Act of 1946 states that no disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter. Disclaimers with such additional statements can be entered by examiner's amendment. The examining attorney should inform the applicant or attorney who authorizes such an amendment that the disclaimer will be printed in the standardized format.

⁵ As should be apparent from TMEP Section 1213.09(a)(1), whether applicant elects to amend its application to disclaim the separate words "AMERICA'S" and "PARTS" or whether it disclaims their combination, the disclaimer which will appear on the resulting registration will be printed, in accordance with PTO practice, to read: No claim is made to the exclusive right to use AMERICA'S PARTS, apart from the mark as shown.

Turning, then, to the likelihood of confusion refusal, the Examining Attorney points out that:

"[A] mark registered on the Supplemental Register can be used as a basis for refusing registration to another mark under Section 2(d) of the Act." *In re The Clorox Co.*, 198 USPQ 337, 340 (CCPA 1978). The *Clorox* decision was reaffirmed by the Court of Appeals for the Federal Circuit in *In re Research & Trading Corp.*, 230 USPQ 49 (Fed. Cir. 1986), [the court stating:] "It is not material whether or not registration on the Supplemental Register implies that there is a degree of descriptiveness to the mark, as appellant argues. Such registration may be cited under Section 2(d) in a determination of likelihood of confusion, an inquiry separate from that of descriptiveness.

Consequently, and with respect to the marks at issue in this appeal, the Examining Attorney asserts that, not only do they share the term "PROS," but they also have in common the word "PARTS," which "is the generic word for the goods sold by both the applicant and the registrant--automobile parts." The Examining Attorney also observes that "[t]he only difference between the two [marks] is the word 'THE' in the registrant's mark and the word 'AMERICA'S' in the applicant's mark." However, according to the Examining Attorney, because "[t]he word 'THE' generally has no trademark significance" and "[t]he word 'AMERICA'S' is merely geographically descriptive of the origin of the applicant's services," the respective marks are "highly similar when compared in their entireties." Specifically, the Examining Attorney insists that, "[e]ssentially, the applicant has added the word 'AMERICA'S,' a geographically descriptive

term, to the registrant's mark " Such an addition, the Examining Attorney argues, is not sufficient to distinguish the marks.

As to the respective services, the Examining Attorney notes that, not only does applicant's initial brief fail to even address the issue of whether such services are related, but in any event, "[t]he evidence attached to the final refusal shows that the services involved, retail store services and distributorship services, can emanate from a single source and are provided under the same mark". Such evidence consists of copies of 14 use-based third-party registrations which show that, in each instance, the same entity has registered a mark for, on the one hand, retail distributorship services and/or retail store services for various products and, on the other hand, wholesale distributorship services for the same products ⁶ We note, however, that of these registrations, only the one which covers both retail dealership services and wholesale distributorship services in the field of automobiles and trucks is even arguably pertinent for present purposes With respect to all of the other registrations, the goods which are the subjects of the services are, on their face, unrelated to automobile or vehicle parts. Nevertheless, the Examining Attorney maintains that, inasmuch as the marks at issue herein are "highly similar" and the evidence of record demonstrates that the respective services are

⁶ Although the Examining Attorney's evidence also includes copies of numerous use-based third-party applications, such evidence shows only that the applications were filed and, therefore, the evidence is lacking in probative value on the point for which it was offered

"sufficiently" related, confusion as to source or sponsorship is likely.

Applicant, among other things, takes the position that the respective marks have "very substantial differences in sound, appearance, and meaning" and that registrant's mark, by virtue of its registration on the Supplemental Register, is an inherently weak mark which is not entitled to a broad scope of protection. Although applicant never addresses, in either of its briefs, the evidence made of record by the Examining Attorney concerning the asserted relationship between applicant's retail auto parts store services and the cited registrant's distributorship services in the field of replacement parts for vehicles, applicant did argue at the oral hearing that, since distributors primarily sell their goods to retailers, the customers for the respective services are different.⁷ Thus, according to applicant, confusion as to origin or affiliation is not likely to occur

Irrespective of whether, as contended by the Examining Attorney, applicant has added only the geographically descriptive term "AMERICA'S" to the essence of registrant's mark or whether, as asserted by applicant, the marks "AMERICA'S PARTS PROS" and "THE PARTS PROS" are so highly suggestive of the respective services that the geographically descriptive term "AMERICA'S" is

⁷ In particular, applicant pointed out that most of the third-party registrations list "wholesale" distributorship services and urged that the term "wholesale" is indicative of goods which are sold solely to retailers. We additionally observe, however, that while five of the third-party registrations, which are owned by three separate entities, recite both "retail" and "wholesale" distributorship services, such services are in the fields of, respectively, construction equipment, golf course maintenance and playing equipment, and clothing

sufficient to distinguish such marks when considered in their entireties, we think that the evidence of record fails to establish that applicant's retail auto parts store services are so closely related to registrant's distributorship services in the field of replacement parts for vehicles that confusion is likely. It is settled, of course, that while use-based third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods and/or services listed therein are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993) and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6. In the present case, however, none of the registrations shows that the same entity provides both retail auto parts store services and distributorship services in the field of replacement parts for vehicles.

Clearly, unlike the distributorship services rendered by registrant in the field of replacement parts for vehicles, which would principally be directed to retailers and others whose business primarily consists of reselling automobile replacement parts, applicant's retail auto parts store services involve the sale of replacement parts directly to the ultimate consumers thereof, such as shade tree mechanics and other members of the general public. Confusion as to the origin or affiliation of the respective services is therefore not likely simply because the customers for registrant's distributorship services would be

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retail stores and other suppliers to the general public, such as service stations and auto repair shops, which carry automobile replacement parts. Such highly knowledgeable and sophisticated customers are markedly different from the ordinary consumers who typically would patronize applicant's services, namely people in need of a few parts to repair their cars or light trucks. The two groups of purchasers operate in basically different channels of trade and there is essentially no significant overlap between them.⁸

Accordingly, in the absence of evidence demonstrating that the retailers and other suppliers forming the discriminating customer base for registrant's distributorship services in the field of replacement parts for vehicles would also be significant customers for applicant's retail auto parts store services (or vice versa), we are constrained to find that there does not appear to be an appreciable commonality of purchasers and channels of trade. Confusion, therefore, would not be likely to occur. Cf. *In re Fesco Inc.*, 219 USPQ 437, 438-39 (TTAB 1983)

⁸ While, of course, it is possible for professional mechanics and service station operators, as well as the owners of registrant's outlets (in their individual capacity), to purchase automobile replacement parts from applicant's retail auto parts stores, our principal reviewing court in has cautioned, with respect to determinations of likelihood of confusion, that in general.

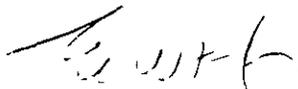
We are not concerned with mere theoretical confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal

Electronic Design & Sales Inc. v Electronic Data Systems Corp, 954 F 2d 713, 21 USPQ2d 1388, 1391 (Fed Cir 1992), citing *Witco Chemical Co v Whitfield Chemical Co, Inc.*, 418 F 2d 1403, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

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[mark "FESCO" and design for "distributorship services in the field of farm equipment and machinery" found not likely to cause confusion with mark "FESCO" for, *inter alia*, "foundry processing equipment and machinery--namely, ... tanks" because "the record does not admit of a reasonable probability of an encounter of opposing marks by the same customers"].

Decision: The refusal under Section 2(d) is reversed, but the requirement for a disclaimer under Section 6(a) is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside as to the affirmance of the disclaimer requirement and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, amends its present disclaimer to one which appropriately disclaims the words "AMERICA'S PARTS".⁹


E. W. Hanak


G. D. Hohein


C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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⁹ See *In re Interco Inc*, 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP §§1213.09(a)(1) and 1213.09(b).