

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JULY 8, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Raceway Lube Inc.**

Serial No. 74/**635,846**

Steve Bouldin for **Raceway Lube Inc.**

Jacqueline A. Lavine, Trademark Examining Attorney, Law Office
109 (**Deborah Cohn**, Managing Attorney).

Before **Cissel**, **Hohein** and **Walters**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Raceway Lube Inc. has filed an application to register
the mark "RACEWAY LUBE" for "vehicle lubrication and oil change
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

¹ Ser. No. 74/635,846, filed on February 17, 1995, which alleges a bona fide intention to use the mark in commerce. The word "LUBE" is disclaimed.

applicant's mark, when applied to its services, so resembles the mark "RACEWAY," which is registered for "motor oil,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Turning first to consideration of the respective marks, we note, as has the Examining Attorney, that applicant has not raised any argument that the marks are distinguishable nor, in any event, could applicant make a persuasive argument in this respect. While, of course, applicant's "RACEWAY LUBE" mark and registrant's "RACEWAY" mark must be considered in their entirety, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive ... with respect to the involved [services or] goods ... is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

Here, in light of the merely descriptive significance of the term "LUBE" (as confirmed by applicant's disclaimer), the

² Reg. No. 1,136,548, issued on June 3, 1980, which sets forth dates of first use of November 24, 1976; combined affidavit §§8 and 15.

distinguishing element of applicant's mark, when considered as a whole, is the word "RACEWAY," which is identical to registrant's mark "RACEWAY". Consequently, the presence of the merely descriptive term "LUBE" in applicant's "RACEWAY LUBE" mark does not change the commercial impression created by the term "RACEWAY" alone. The respective marks, when considered in their entirety, are clearly so substantially similar in sound, appearance, connotation and commercial impression that, if used in connection with services and goods which are closely related, confusion as to the source or the sponsorship of those services and goods would be likely to occur. See, e.g., In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994) [in finding likelihood of confusion between "ULTRA" mark for gasoline and motor oil and registered "ULTRA LUBE" marks for lubricating oils, greases, and related automotive products, Board gave "more weight to the identical ULTRA portion in registrant's marks, because of the descriptive nature of the word 'LUBE.'"].

Turning, then, to consideration of the respective services and goods, applicant argues that confusion is not likely because its vehicle lubrication and oil change services are different from registrant's motor oil products³ and that

³ While such is indeed correct, we hasten to note that, as pointed out in In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984):

[T]he question to be determined herein is not whether the [services and] goods are likely to be confused but rather whether there is a likelihood of confusion as to the source of the [services and] goods because of the marks used [therewith] See: Chemetron Corp. v. Self-Organizing Systems, Inc., 166 USPQ 495 (TTAB 1970), and cases cited therein, and MRI Systems Corp. v. Wesley-Jessen Inc., 189

registrant "does not offer the same type of service" as applicant does. However, as the Examining Attorney correctly observes, it is well settled that the services and goods at issue need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services and goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Moreover, it is also well established that the issue of likelihood of confusion must be determined in light of the services and goods respectively set forth and the involved application and cited registration and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution therefor. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

USPQ 241 (TTAB 1975). Thus, it is not necessary that the [services and] goods of applicant and registrant be similar or competitive in order to support a finding of likelihood of confusion

The Examining Attorney, in support of her position that "consumers may indeed believe that motor oil and vehicle lubrication and oil change services are related," has made of record, among other things, several third-party registrations, all of which are based upon use in commerce, which show that in each instance the same entity has registered either the same or a virtually identical mark for motor oil or lubricating oil, on the one hand, and automotive service station services or gas station services, on the other hand. While such 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 probable value to the extent that they serve to suggest that such goods and services, which would include vehicle lubrication and oil change services, are of the kinds 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 addition, the Examining Attorney has made of record a number of excerpts of articles from her search of the "NEXIS" computerized database to show that "many companies market both oil and the service of oil changes." The most pertinent of such excerpts are as follows (**emphasis added**):

At Quick Lube, a "full-service" **oil change**, in which all fluids and belts are checked, costs \$28.95; an **oil change** alone is \$23.95. -- Idaho Business Review, February 24, 1977, at 10A;

Among the other moves Denton anticipates: possible link-up of Ashland's Valvoline **lube-oil** brand, and its second-

ranked Instant **Oil Change retail outlets**, with another chain to match the clout of No. 1 Pennzoil's Jiffy Lube brand. -- Platt's Oilgram News, December 10, 1996, at 1;

Ashland Inc. said its Valvoline Instant **Oil Change** division has agreed to provide **oil changes** in 20 Sears Auto Centers in three markets next year. -- Chicago Sun-Times, November 12, 1996 at 44;

In 1987, we analyzed and predicted the takeover of the young quick-**oil-change** business by the major **oil** companies. Today, a mature fast-**oil-change** industry is dominated by Pennzoil, Quaker State, and Valvoline. -- Automotive Marketing, November 1996, at 50;

Based in Irving, Texas, Quaker State is a leading producer of brand-name **motor oil** and lubricants. It runs a nationwide chain of 466 quick **oil-change and service centers** called Q Lube. Most are company owned. -- Investor's Business Daily, October 29, 1996, at B14; and

Belding in Chicago, a unit of True North Communications, continues to handle advertising for Quaker State **motor oil** and the Q Lube chain of **oil-change shops**. -- N.Y. Times, October 16, 1996, §D, at 11, col. 2.

The above evidence merely underscores the facts that, as everyday experience demonstrates, motor oil is essential to the rendering of vehicle lubrication and oil change services, and that such goods and services are frequently available at the same locations. Clearly, motor oil and vehicle lubrication and oil change services are closely related since the former is an integral part of providing the latter. Customers familiar with registrant's mark "RACEWAY" for motor oil would accordingly be likely to believe, upon encountering applicant's substantially identical mark "RACEWAY LUBE" for vehicle lubrication and oil

Ser. No. 74/635,846

change services, that such closely related goods and services emanate from or are otherwise sponsored by or affiliated with the same source.

Decision: The refusal under Section 2(d) is affirmed.

R. F. Cissel

G. D. Hohein

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