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JAN. 29, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Keith Huber, Inc.**

Serial No. 74/**674,575**

Charles S. Cotropia and John A. Harre of Sidley & Austin for
Keith Huber, Inc.

Albert J. Zervas, Trademark Examining Attorney, Law Office 104
(**Sidney I. Moskowitz**, Managing Attorney).

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

Opinion by Hohein, Administrative Trademark Judge:

Keith Huber, Inc. has filed an application to register
the mark "DOMINATOR" for "industrial trucks equipped for
transporting and handling of liquid, solid and semi-solid
materials".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 each of

¹ Ser. No. 74/674,575, filed on May 16, 1995, which alleges dates of
first use of February 9, 1983.

the following marks, which are owned by the same registrant, as to be likely to cause confusion, mistake or deception:²

(i) "PRO DOMINATOR," which is registered for "intake manifolds for internal combustion engines for land vehicles";³ and

(ii) "STREET DOMINATOR," which is registered for "intake manifolds for internal combustion engines for land vehicles".⁴

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the refusal to register in each instance.

Turning first to consideration of the respective goods, the Examining Attorney notes, as a general proposition, that the Board "has consistently held over the years that there is such a definitive relationship between a vehicle and the various accessories, parts and attachments therefor in the mind of the average person that the marketing thereof by different parties

² Although registration was also finally refused in light of the same registrant's ownership of each of the following marks, such marks will not be given further consideration inasmuch as the registrations therefor subsequently were not renewed and hence have expired:

(i) "DOMINATOR" for "carburetors and parts therefor and intake manifold[s] for use in connection with internal combustion engines for land vehicles," which was the subject of Reg. No. 1,050,018, issued on October 12, 1976 and which set forth dates of first use of February 20, 1970; combined affidavit §§8 and 15; and

(ii) "STRIP DOMINATOR" for "intake manifolds for internal combustion engines for land vehicles," which was the subject of Reg. No. 1,050,017, issued on October 12, 1976 and which set forth dates of first use of January 6, 1976; combined affidavit §§8 and 15.

³ Reg. No. 1,553,662, issued on August 29, 1989, which sets forth dates of first use of December 31, 1979; combined affidavit §§8 and 15.

⁴ Reg. No. 1,066,680, issued on May 31, 1977, which sets forth dates of first use of January 22, 1976; renewed.

under the same or similar marks is likely to cause confusion as to source."⁵ In particular, the Examining Attorney maintains that (footnote omitted; *italics in original*):

[M]embers of the consuming public have come to expect that the source of trucks and engine parts is the same when they see the same [or a similar] mark on such goods. This expectation is apparent from the *Hot Rod* magazine advertisement and cover page and the [three use-based third-party] trademark registrations enclosed with the ... final action. The *Hot Rod* advertisement and cover page depict a CHEVROLET truck and engine and a CHEVROLET engine, respectively. Apparently, trucks and engine parts are both promoted in the same advertising medium to the same group of consumers. Moreover, the goods are both promoted *in the same advertisements*. Also, the trademark registrations--which each includes trucks and truck parts--show that the goods are of a type that emanate from a single source. Consumers hence would expect that trucks and engine parts having the same [or a similar] mark would come from the same source.

Thus, for at least the above reasons, the applicant's and registrant's goods travel in the same trade channels. The marketing of applicant's goods therefore is likely to cause confusion as to source with registrant's goods.

We agree with applicant, however, that confusion is not likely in the circumstances of this case. Specifically, while

⁵ The Examining Attorney, in support thereof, cites *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) ["LAREDO" mark for land vehicles and structural parts therefor versus "LAREDO" mark for pneumatic tires]; *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335 (TTAB 1980) ["W" design mark for automobile and truck tires versus "W" design mark for various recreational vehicles]; *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977) [mark "STARFIRE" for automobiles versus mark "STARFIRE" for automotive shock absorbers]; and *International Harvester Co. v. Hull Mfg. Co.*, 157 USPQ 203 (TTAB 1968) [mark "SCOUT" for motor trucks versus mark "SCOUT" for compasses to be affixed to trucks].

the Examining Attorney has also correctly observed that the issue of likelihood of confusion must be determined both in light of the identifications of goods as set forth in the application and cited registration and, absent any limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods,⁶ we agree with applicant that nothing in the record indicates that the customary channels of trade for registrant's intake manifolds for internal combustion engines for land vehicles include those in which applicant's industrial trucks for transporting and handling of liquid, solid and semi-solid materials are usually marketed. Instead, as is implicit in the identification of its goods as being limited to the specific purpose of transporting and handling liquid, solid and semi-solid materials, applicant persuasively points out that (footnotes omitted; *italics and bold in original*):

[T]he trade channels used by Applicant and Registrant to distribute their respective goods are very dissimilar. The goods sold by Applicant are very expensive ..., highly specialized industrial trucks equipped solely for transporting and handling liquid, solid, and semi-solid materials, i.e., wastes. These goods, in accordance with their highly specialized use, are marketed almost exclusively through specialized trade shows ... and trade magazines directed at the industrial and municipal water [sic] markets. In other words, Applicant's goods move through their normal channels of trade to a very narrow field of customers interested in such industrial trucks. Applicant has no distribution network, [and] all sales are direct from Applicant. Even

⁶ 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).

assuming, *arguendo*, that Applicant's goods were not sold only by Applicant, but instead, were sold through distributors of specialized, heavy industrial trucks, i.e., the other channels of trade that would be normal for such goods, Applicant's goods can still not be considered as moving in the same channels of trade as do Registrant's goods.

Registrant's goods (unlike Applicant's) are [typically] sold through automotive supply houses and parts stores and are routinely purchased by retail consumers and mechanics. In addition, Registrant's goods are also advertised and sold through specialty magazines targeted [as the record shows] at automotive enthusiasts and racers.

....

The trade channels in the instant action are [thus] markedly different than those in cases involving **ordinary** vehicles and **ordinary** parts. Ordinary vehicles are sold through large nationwide dealer networks and are heavily advertised both on television and radio and in a variety of magazines and newspapers targeting a broad base of customers. Such broad trade channels increase the probability of overlap with trade channels for ordinary replacement parts sold and advertised in the same manner. Furthermore, auto dealers also typically offer ordinary replacement parts for use in the vehicles they sell in their parts and services departments. None of these channels of trade or advertising are typically used to sell or promote the sale of industrial trucks such as those sold by Applicant. In this case, the narrow channels of trade through which Applicant's goods are (or would be) distributed eliminates any possibility of overlap with the channels of trade for Registrant's goods. Thus, the channels of trade for Applicant's and Registrant's goods are dissimilar and warrant against a finding of likelihood (as opposed to a mere possibility) of confusion as to the source of the goods.

In addition, we concur with applicant that, by their very nature, the respective goods are not the kinds which would

be subject to impulse purchases. Instead, given the expense and deliberation involved, the decisions to purchase applicant's industrial trucks for transporting and handling of liquid, solid and semi-solid materials and registrant's intake manifolds for internal combustion engines for land vehicles would generally be made not only by different individuals (e.g., purchasing agents in the case of the former and mechanics with respect to the latter), but such separate purchasers in any event would also be knowledgeable and discriminating buyers who would exercise a great deal of care in selecting, respectively, a truck which meets governmental, corporate or private waste hauling requirements or a replacement intake manifold for a truck engine. The degree of sophistication of such purchasers, who not only would know their particular needs, but would not expect (at least as shown by the absence thereof on this record) a manufacturer or supplier of specially equipped trucks for transporting and handling liquid, solid and semi-solid materials to furnish intake manifolds or other truck engine replacement parts,⁷ makes the extent of any potential confusion, based solely upon an general relationship between a motor vehicle and its manufacturer's replacement engine parts, *de minimis*.

As noted by our principal reviewing court in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d

⁷ Here, unlike registrant's "PRO DOMINATOR" and "STREET DOMINATOR" marks, which identify a specific product, namely, intake manifolds, applicant's "DOMINATOR" mark "identifies a particular type of truck and its maker in terms of the specific intended use for which it has been adapted by applicant," namely, the transporting and handling of liquid, solid and semi-solid materials, a function which can be accomplished by essentially any brand of heavy-duty commercial truck.

713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (*italics in original*):

[L]ikelihood of confusion must be shown to exist not in a purchasing *institution*, but in "a customer or purchaser." As one of our predecessor courts, the Court of Customs and Patent Appeals, stated in *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967):

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

Here, as indicated previously, not only is there lacking, for the most part, a commonality of purchasers, but as applicant cogently argues (footnote omitted):

The only potential consumers that will have an opportunity to be confused are those that encounter both Applicant's and Registrant's goods. Applicant's goods are marketed to such a narrow, specialized group of consumers that the great majority of individuals encountering them will be well aware of their source. Likewise, the sophisticated and knowledgeable potential consumers of Registrant's ... automobile parts are not likely to mistakenly consider Registrant as the source of a large industrial waste disposal truck, the appearance and function of which is the very antithesis of a ... [general purpose] vehicle. Thus, the number of overlapping potential customers and the likelihood of confusion is so low that the extent of any confusion that may ensue, however unlikely, is minimal.

Finally, even if we were to consider industrial trucks equipped for transporting and handling liquid, solid and semi-solid materials to be so closely related to intake manifolds for internal combustion engines for land vehicles that their sale under the same or substantially similar marks would be likely to

cause confusion, we agree with applicant that its "DOMINATOR" mark is readily distinguishable from registrant's "PRO DOMINATOR" and "STREET DOMINATOR" marks.⁸ The Examining Attorney, in this regard, concedes in his final refusal that the term "DOMINATOR" "is suggestive of strength and quality and leadership in the relevant industry," while the words "PRO" and "STREET" similarly are "weak suggestive terms ... which are common automotive terms."⁹ Consequently, we do not share the Examining Attorney's contention that marks consisting of or containing the term "DOMINATOR," as applied to industrial trucks and automotive

⁸ Although applicant also asserts that its mark and registrant's mark "have been used concurrently for over thirteen years" and that applicant "is unaware of **any** actual confusion arising as to source" (**emphasis in original**) during such period, there is nothing in the record, such as an affidavit or declaration from an officer of applicant having personal knowledge thereof, to support applicant's contention. Accordingly, such assertion has no probative value in this case and will not be further considered. In addition, it should be noted in any event that, as stated in *In re General Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992):

We recognize, of course, that the above [evidence of an absence of actual confusion] is one-sided inasmuch it provides only applicant's experience in the marketplace and not that of registrant. Normally, in the absence of a detailed consent agreement, the registrant has no opportunity to be heard in an *ex parte* proceeding of this type and the Board, therefore, is not in a position to meaningfully assess whether the claimed period of contemporaneous use has provided ample opportunity for confusion to have arisen. See, e.g., *In re Jeep Corp.*, *supra* at 337. The asserted absence of actual confusion, especially over a relatively short period of years, has thus often been asserted to be of "limited influence" or of "dubious probative value". See, e.g., *In re Barbizon International, Inc.*, 217 USPQ 735, 737 (TTAB 1983) and *In re Whittaker Corp.*, 200 USPQ 54, 56 (TTAB 1978), respectively.

⁹ Likewise, in his appeal brief, the Examining Attorney states that registrant's marks "all share the term DOMINATOR preceded by a weak suggestive term: i.e. ..., PRO (for professional) and STREET, which are well-used terms in the automotive arena."

engine intake manifolds, "are highly similar and their commercial impression is the same."

Instead, not only does applicant's "DOMINATOR" mark differ in sight and sound from each of registrant's "PRO DOMINATOR" and "STREET DOMINATOR" marks, but their differences in connotation, with applicant's mark suggesting a truck which is the best equipped of its kind for hauling waste materials while registrant's marks conjure up images of high performance racing equipment, result in marks which, when considered in their entirety, are significantly distinct in overall commercial impression. As applicant convincingly states:

The definition of "DOMINATOR" is "a dominating person or power". WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE UNABRIDGED 672 (G. & C. Merriam Co. 1966). "Dominate", as the root of the word "DOMINATOR," means "to hold supremacy or mastery over by reason of superior power, strength, authority or prowess". *Id.* at 671. In light of the dictionary definition of the word, and the Examining Attorney's [conceded] interpretation of its meaning, the mark "DOMINATOR" should be considered laudatory and highly suggestive and thus is entitled to a more narrow scope of protection than an arbitrary or fanciful mark. See *In re Dayco Products-Eaglemotive, Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *In re General Motors Corp.*, 23 USPQ2d 1465, 1469 (TTAB 1992). "[U]nlike in the case of an arbitrary or unique designation, the addition of other matter to a highly suggestive or laudatory term, whether such matter be equally suggestive ..., may be sufficient to distinguish between them and to avoid confusion in trade." *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 116-17 (TTAB 1978) (citations omitted). The Examining Attorney also considered "PRO," ... and "STREET" to be suggestive terms that have a nexus to motor vehicles and their use. These terms, however, clearly suggest racing use (e.g., ... "PRO" for Pro Stock and

Pro Modified drag racing, and "STREET" for Super Street drag racing) and are [in] no way suggestive of use on an industrial truck used for gathering and transporting various types of waste. Under the reasoning expressed in *Plus Products v. Redken Laboratories, Inc.*, the addition of the suggestive terms[,], "PRO," [and] "STREET," ... to the term "DOMINATOR" is sufficient to distinguish Registrant's marks from Applicant's mark and avoid any likelihood of confusion.

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

R. F. Cissel

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board