

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG. 23, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ed Tucker Distributor, Inc. d/b/a Tucker-Rocky
Distributing

Serial Nos. 75/119,885 and the 75/119,886

Kay Lyn Schwartz of Gardere & Wynne, L.L.P. for Ed Tucker
Distributor, Inc. d/b/a Tucker-Rocky Distributing.

Won T. Oh, Trademark Examining Attorney, Law Office 104.

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

Opinion by Cissel, Administrative Trademark Judge:

On June 17, 1996, applicant applied to register two
trademarks on the Principal Register. Application Serial
No. 75/119,885 sought registration of the mark "MOTOR IN A
BOX" for "prepackaged parts used to assemble a motor for a
custom motorcycle," in Class 12. That language was
subsequently amended to read "motor for a custom motorcycle
sold in a kit of prepackaged parts." Application Serial

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No. 75/119,886 sought registration of "TRANNY IN A BOX" for "packaged parts used to assemble a transmission for a custom motorcycle," in Class 12. That application was subsequently amended to identify the goods as a "transmission for a custom motorcycle sold in a kit of prepackaged parts." Both applications were based upon applicant's assertion that it possessed a bona fide intention to use the marks in commerce on the goods set forth in the applications.

In both instances, the Examining Attorney refused registration under Section 2(d) of the Act. He held that if applicant's marks were used in connection with the goods specified in the applications, they would so resemble the mark "BRAKE-IN-A-BOX," which is registered¹ for "brake structural and replacement parts" in Class 12, that confusion would be likely.

When the refusals to register were made final, applicant filed a Notice of Appeal in each application. Both applicant and the Examining Attorney filed briefs in each case, but applicant did not request an oral hearing in either case. Accordingly, we have resolved these appeals

¹ Registration No. 1,003, 212, issued on the Principal Register to Maremont Corp. on January 28, 1975 based on a claim of first use since January 25, 1972; combined affidavit under Sections 8 and 15 received and accepted; renewed for 10 years on January 27, 1997.

based on the written arguments and records. In view of the fact that the issues in each appeal are almost the same, we are issuing one opinion explaining our ruling in both instances.

Based on careful consideration of the records in both cases and the arguments presented in the briefs, we hold that the refusals to register are appropriate in both cases.

Applicant and the Examining Attorney agree that in resolving the issue of likelihood confusion, we should consider any evidence of record which relates to any of the factors discussed by the Court in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Of particular relevance to the instant appeals is the similarity of the marks with respect to pronunciation, appearance, connotation and commercial impression, as well as the relationship between the goods specified in the applications and those set forth in the cited registration.

The marks in their entireties are similar in appearance, pronunciation and connotation. Because each combines the terminology "IN-A-BOX," which is suggestive in connection with a prepackaged kit of mechanical parts for a vehicle, with the generic term used for the assembly composed of those parts, the commercial impressions these

marks generate are similar. In view of the fact that the word "TRANNY" is a slang term for "transmission," "TRANNY-IN-A-BOX" is quite suggestive of a kit of prepackaged parts used to assemble a transmission; "MOTOR-IN-A-BOX" is suggestive of a motor sold in a kit of prepackaged parts; and "BRAKE-IN-A-BOX" is similarly suggestive as applied to registrant's brake parts. Because of their similarities in appearance, format and connotation, when they are considered in their entirety, if these marks were to be used on related goods, confusion would be likely.

Applicant argues that the dominant portions of the marks in question are the terms "MOTOR," "TRANNY," and "BRAKE," and that the phrase "IN-A-BOX" is weak in source-identifying significance and therefore should be accorded only a narrow scope of protection. In support of its argument, applicant submitted the results of an automated search of applications and registrations wherein a large number of marks include the phrase "IN A BOX."

Additionally, applicant argues that the Patent and Trademark Office allowed an intent-to-use application for the mark "TOP-IN-A-BOX" for a retractable convertible car top including power unit, despite the existence of the cited registration. Although that application was subsequently abandoned, applicant contends that because the

Patent and Trademark Office approved the application for publication, the instant applications should also be allowed. Applicant views the publication of that application as an indication that the Office has recognized the weakness of the term "IN-A-BOX," and has acknowledged that purchasers of these mechanical parts for vehicles look to other components in marks which incorporate the term in order to distinguish among such marks.

None of applicant's arguments is persuasive.

Turning first to applicant's contention that the dominant portions of the marks in question are the words "MOTOR," "TRANNY," and "BRAKE," this is obviously not the case. These are generic words for the products identified in the applications and the cited registration. By themselves, they have no source-identifying significance in connection with these products. It is only when they are combined with the suggestive term "IN-A-BOX" that they can serve as components of these trademarks. The dominant portion of these three marks is clearly "IN-A-BOX," and the fact that all three of these marks are dominated by this suggestive term combined with different generic terms for related products leads us to conclude that these marks are similar.

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As to the marks shown in the search report applicant submitted, it is well settled that such a list cannot be used to support the contention that a term common to the listed marks is weak. To begin with, the computer print-out of the search report made of record by applicant does not make the registrations referred to therein of record. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Furthermore, even if applicant had submitted copies of the registrations listed in the report, it is well settled that such registrations would not establish that the marks therein are in use, much less that consumers are so familiar with their use that they are able to distinguish among such marks by focusing on components other than the ones shared by the marks. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Third-party registrations may be used to establish the meanings of common terms used in them, but they have little bearing on the question of whether confusion is likely among marks which incorporate them. Red Carpet Corp. v. Johnstown American Enterprises, Inc., 7 USPQ2d 1404 (TTAB 1988).

Applicant's argument that by passing a third party's application to publication, the Patent and Trademark Office was acknowledging the weakness of the term "IN A BOX" is

similarly without merit. We simply have no way of knowing what the basis was for approving that application.

Moreover, neither the Examining Attorney who evaluated the instant applications nor the Trademark Trial & Appeal Board is bound by the Examining Attorney's action in connection with that prior application. Each case must be decided on its own merits, and our responsibility is to determine the registrability of the marks in the instant applications based on the records before us.

As discussed above, the marks which applicant seeks to register here are similar to the mark in the cited registration. If these marks were to be used on the products identified in the applications and registration, confusion would clearly be likely because these goods are all related. A motorcycle motor sold in a kit of prepackaged parts, a motorcycle transmission sold as a kit of prepackaged parts, and brake parts are all mechanical components which could be purchased by the same person and used on the same motorcycle.

Applicant argues, however, that its products would move in different channels of trade from the goods specified in the cited registration. This argument is not well taken either. The issue of likelihood of confusion between marks must be determined on the basis of the goods

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as they are identified in the respective applications and registration, without restrictions or limitations that are not reflected therein. In re Elbaum, 211 USPQ 639 (TTAB 1981). In the absence of restricting or limiting language in these applications or the cited registration, we must assume that these mechanical components could be used in connection with the same vehicle, and that they move through the same channels of trade to the same customers. Contrary to applicant's contention, we have no basis upon which to conclude that the customers for any of these goods are different classes of purchasers, or that they are particularly sophisticated.

Further, applicant's contention that confusion is not likely because the registered mark is not famous suffers two fatal flaws. To begin with, it is without factual support. More important, there is no legal authority for the proposition that fame must be established in order to protect a registered trademark against the registration of another mark which is likely to cause confusion with it. To the contrary, fame need not be proven in order to hold confusion likely in circumstances such as the ones with which we are presented in the instant appeals, wherein applicant seeks to register similar marks in connection with related products.

Applicant also argues that the fact that actual confusion has not occurred since applicant began using its marks in July of 1996 is strong evidence that confusion is not likely. We disagree. That this record does not contain evidence of incidents of actual confusion is not determinative of the issue before us on appeal. We have no basis upon which to conclude that there has even been an opportunity for confusion to have occurred. Moreover, the issue is not whether confusion has taken place, but rather, whether it is likely.

In view of the similarity of these marks and related nature of the products set forth in the applications and the cited registration, respectively, we hold that confusion is likely, and therefore the refusals to register under Section 2(d) of the Act are affirmed.

R. F. Cissel

T. J. Quinn

H. R. Wendel
Administrative Trademark Judges
Trademark Trial & Appeal Board

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