

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 7, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brisk America LLC

Serial No. 75/141,467

Robert E. Malm for Brisk America LLC.

Cindy B. Greenbaum, Trademark Examining Attorney, Law
Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Cissel, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, Brisk America LLC, a Nevada limited
liability company, has filed an application for
registration of the mark "TRI STAR" for "spark plugs."¹

The Trademark Examining Attorney issued a final
refusal to register based upon Section 2(d) of the

¹ Serial No. 75/141,467, in International Class 7, filed July
29, 1996, based upon an allegation of a *bona fide* intention to
use the mark in commerce.

Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's proposed mark, "TRI STAR" if used on spark plugs, would so resemble the following four registered marks, owned by Tri Star International, Inc., an Ohio corporation, as to be likely to cause confusion, or to cause mistake, or to deceive:

- (1) "TRI STAR" as applied to "automatic transmissions with torque converters for automobiles and trucks, and parts therefor,"²;
- (2) "TRI STAR and design" as shown below, as applied to "land vehicle automatic transmissions with torque converter and parts therefor,"³;



- (3) "TRI STAR and design" as shown below, as applied to "balanced torque converters for land vehicle transmissions,"⁴;

² Registration No. 1,315,666, issued on January 22, 1985. The registration sets forth dates of first use of August 7, 1981; §8 affidavit accepted and §15 affidavit filed.

³ Registration No. 1,587,687, issued on March 20, 1990. The registration sets forth dates of first use of January 1984; §8 affidavit accepted and §15 affidavit filed.

⁴ Registration No. 1,587,688 issued on March 20, 1990. The registration sets forth dates of first use of January 1985; §8 affidavit accepted and §15 affidavit filed.



- (4) "TRI STAR and design" as shown below, as applied to "land vehicle transmission rebuild kits, sold as a unit." ⁵;



Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

The Marks

We must consider the marks in their entireties -- words and/or designs. Applicant and registrant use

⁵ Registration No. 1,589,876, issued on April 3, 1990. The registration sets forth dates of first use of January 1985; §8 affidavit accepted and §15 affidavit filed.

identical word marks -- "TRI STAR." Further, the dominant feature of each of registrant's design marks is also the literal designation, "TRI STAR." This "TRI STAR" theme is reinforced visually, in that the design features in two of the three registered marks depict "three stars" -- in the framing area of a rounded, oblong carrier device, and again atop three-dimensional-looking star trails. The final registration has "TRI STAR" amidst the depiction of a globe - this one without any separate, three-star visualizations.

We agree with the Trademark Examining Attorney that the word portions of the marks are identical, have the same connotation, and give the same commercial impression. Nothing in the record suggests this matter is in any way even suggestive (much less descriptive) of either transmissions or spark plugs. Accordingly, this mark seems to be arbitrary as applied to these goods. On its face, it would appear to be a relatively strong trademark.

In this regard, the present case is much like the situations in *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) ["LAREDO" for land vehicles and structural parts therefor vs. "LAREDO" for pneumatic tires]; *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977) ["STARFIRE" for automobiles vs. "STARFIRE" for automotive shock absorbers]; and *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 476

(TTAB 1973) ["GEMINI" and "GMINI" for automobiles vs. "GEMINI" for vehicle tires], all of which involved arbitrary marks.⁶

Under this first of the du Pont factors, the identity of words, connotation, and commercial impression weighs heavily against the applicant. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 1566, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The Goods

The Trademark Examining Attorney argues from case law, third-party registrations, and advertisements from a classified directory, that the "...contemporaneous use of the identical words TRI STAR on the applicant's spark plugs and the registrant's automotive transmissions and related components would be likely to cause confusion because the goods are highly related automotive items which are intended to be used together..."

This relationship does not hinge upon any *per se* rule that all auto parts are related. Rather, citing to a variety of cases from this Board and our reviewing court,

⁶ *Contra*, In re Dayco Products-Eagle Motive Inc., 9 USPQ2d 1910 (TTAB 1988) ["IMPERIAL" used by others in the vehicular field as a laudatory designation] and In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992) [the term "GRAND PRIX" is highly suggestive as applied to these goods].

the Trademark Examining Attorney contends that "...likelihood of confusion exists when different parties use the same or similar marks on different types of automotive parts and accessories...[cites omitted]." She goes on to argue:

The fact that the goods of the parties may comprise different types of automotive items is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. See *In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP section 1207.01.

The logic for concluding from the case law that these goods are related, is quoted by the Trademark Examining Attorney as follows:

[Various case holdings cited in *Jeep*] were based upon the facts that the goods in question all comprised automotive parts, accessories, and equipment which could be purchased through the same channels of trade, including dealers, service stations, automotive accessory and supply stores, or the automotive departments of general merchandisers, by the same classes of purchasers, such as mechanics, dealers, and motorists.

In re Jeep Corp., 222 USPQ at 334.

Accordingly, based upon the entire record herein, we conclude that this second important *du Pont* factor also favors the position of the Trademark Examining Attorney.

Trade Channels

We also concur with the Trademark Examining Attorney's conclusions that

neither the applicant nor the registrant has limited its channels of trade or its class of purchasers. It is therefore presumed that the application and registration encompass all goods of the type described, that the goods move in all normal channels of trade, and that the goods are available to all potential customers. In re Elbaum, 211 USPQ 639 (TTAB 1981). Thus, the examining attorney submits that purchasers of the applicant's spark plugs also frequently would encounter the registrant's vehicle transmissions and transmission parts in the same location, such as, automotive repair and service shops.

She has included within the record a sampling of applications and registrations indicating that numerous manufacturers of spark plugs also manufacture and market automotive transmissions and transmission parts under the same mark. We have held in the past that third-party registrations have probative value on the issue of likelihood of confusion to the extent that they serve to suggest that the goods of the applicant and of the registrant are of a type which emanate from a single source. See In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988).

The Trademark Examining Attorney has submitted pages of evidence from The One Book® -- Northern Virginia (1997),

showing that many companies who replace and repair vehicle transmissions also work on tuning, repairing and replacing vehicle engines.

On the other hand, applicant argues that there is no overlap of the trade channels for these goods. The declaration of Daniel P. Vander Lay, solicited for this case by applicant, serves as the basis for this conclusion. What follows is a brief summary of his assertions:

1. Transmission repair and engine repair and maintenance are performed by separate entities inasmuch as transmission repairs are the exclusive province of transmission specialists;
2. "Do-it-yourself-ers" who may indeed purchase and change their own automobile spark plugs cannot walk into an auto parts store to choose a new or rebuilt transmission; and,
3. Sophisticated purchasers in the automotive assembly plants would not be confused, and would be located in totally separate departments of a large manufacturing plant.

First, we cannot help but notice the temporizing contained within the declaration ("...trade channels ... are *almost completely isolated* from one another..."; "General repair shops do not, *in general*, repair transmissions..."; "...the parts stores which sell spark plugs would not, *in general*, be selling transmissions..."). However, the evidence of record from a classified directory in Northern Virginia seems to expose a much larger exception to these

general rules (at least in the Washington D.C. greater metropolitan area) than the declaration would suggest.

The majority of the potential consumers of applicant's spark plugs would be from the broad class of vehicle owners. We are also satisfied from the evidence in the file that the respective goods are related products having potentially overlapping trade channels and classes of purchasers.

Accordingly, we conclude that the du Pont factor dealing with channels of trade again favors the position of the Trademark Examining Attorney.

Conditions of sale

In reviewing applicant's arguments in this case, one cannot help but notice its heavy reliance on the combination of Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d 1388 (Fed. Cir. 1992) and Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir. 1983). We are asked to conclude from Electronic Design that corporate purchasers of spark plugs and transmissions are sophisticated. Then we are asked to conclude from Astra Pharmaceutical that in a large organization like an auto manufacturing plant, the buyer of spark plugs would be a different individual than the one who procures

transmissions. However, we find that this case does not present us with a fact situation like Electronic Design or Astra Pharmaceutical. We agree with the Trademark Examining Attorney that the "goods at issue herein are quite straight-forward. Spark plugs and transmissions are widely available items with which all automobile owners are familiar, and are not at all like the expensive, highly technical and complicated goods and services involved in Electronic Design..." Further, unlike the situation in Astra Pharmaceutical, these goods are not purchased exclusively by experienced corporate personnel cloistered within their own specialized departments of large institutions. Instead, in spite of nation-wide advertising campaigns by the largest spark plug manufacturers aimed at building strong brand identification among consumers for spark plugs, the average motorist may well consider the brand of new spark plugs installed into one's car to be less important than, for example, one's own past experiences with the auto mechanic installing the plugs. If true, given the relatively low price of spark plugs, this indicates that among vehicle owners, purchasing new spark plugs is much closer to being an "impulse" purchase than to being an informed and sophisticated decision-making process based upon careful weighing, comparisons and evaluations.

This cumulative evidence supports the Trademark Examining Attorney's position that ordinary purchasers are accustomed to viewing the same or similar marks on the goods of the type to be sold by applicant and those sold by registrant. Again, this du Pont factor supports a refusal to register under Section 2(d) of the Act.

Strength of Mark

The record fails to indicate that even one other party besides the applicant and the registrant is making use of the mark TRI STAR for any type of goods that may be characterized as auto parts. Hence, it can hardly be argued that this arbitrary matter is in any way intrinsically weak as a source identifier for registrant.

Decision

Based on the substantially identical portions of the marks, the fact that the goods are highly related automotive components that will be used together on the same vehicle, that these goods move in the same trade channels, would be viewed by the same class of ordinary consumers, and that the term, "TRI STAR," is arbitrary in the field of vehicle components, we conclude that purchasers who encounter the marks of the applicant and the registrant on their respective goods would mistakenly

believe that the goods originate from or are in some way associated with the same producer. See Hercules Inc. v. National Starch and Chemical Corp., 223 USPQ 1244, 1247 (TTAB 1984). Hence, the refusal to register is hereby affirmed.

R. F. Cissel

C. E. Walters

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board