

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marvin Behar and Leslie E. Smith, Joint Applicants

Serial No. 75/159,724

Marvin Behar and Leslie E. Smith, *pro se*.¹

K. Margaret Le, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Seeherman, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Joint applicants, Marvin Behar and Leslie E. Smith,
filed an application for registration of the mark "PORTA-
RACK" for "a spacer and positioning rack for magnetically
attaching to the top of an automotive vehicle."²

¹ Although at the time of final decision applicants appear to be without counsel, they were represented by counsel throughout the prosecution of this application, from the initial filing of the trademark application through the filing of the *ex parte* appeal brief before this Board.

² Serial No. 75/159,724, filed September 3, 1996, alleging dates of first use of August 26, 1996.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark "PORTA-RACK" when used on these portable magnetic cushioning racks, so resembles the registered mark, "PORT-O-RAC," as applied to a "load rack for pickup trucks," as to be likely to cause confusion, or to cause mistake, or to deceive.³

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.

Under the first of the *du Pont* factors, we examine closely the sound, appearance, meaning and overall commercial impression of the two marks. As the Trademark Examining Attorney points out, the visual and aural similarities are striking. In turn, the applicants point out the different vowel (applicant's middle letter "A" instead of registrant's middle letter "O"), the number of

³ Registration No. 1,192,510 issued on March 23, 1982. The registration sets forth dates of first use of May 19, 1980; §8 affidavit accepted and §15 affidavit filed.

hyphens (applicant's single hyphen versus registrant's two hyphens), as well as registrant's different, phonetic spelling of the generic word "rack" (spelled " R·A·C "). However, it is a well-established principle that likelihood of confusion should not be judged based upon a side-by-side comparison of the marks. Instead, we must take into account that over a period of time, people in the marketplace for goods such as these have an imperfect recall of marks. See Geigy Chem. Corp. v. Atlas Chem. Indus., Inc., 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971) ["HYDRONOL" so resembles "HYGROTON" when applied to diuretics that confusion is likely]. When considered in this manner, we find that consumers are unlikely to note or remember the slight differences delineated by applicants.

Furthermore, the fact that these marks have substantially identical commercial impressions weighs heavily against applicants. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 1566, 223 USPQ 1289, 1290 (Fed. Cir. 1984) ["MARTIN'S" for wheat bran and honey bread likely to be confused with "MARTINS" for cheese].

We turn next to the goods of the respective parties. By its own terms, registrant's load rack is limited to use on pick-up trucks. Applicants argue that the goods are

different, asserting that registrant's truck rack is a rigid and substantial product designed for carrying heavy loads and is built expressly to fit the stake pockets on the outer edges of the truck's cargo bed. By contrast, applicants' portable magnetic cushioning racks seem less substantive and can be adapted for a variety of uses in connection with shielding the body of a car from roof-top loads or even dings and scratches on the side panels. In any case, we note that it is touted primarily as a temporary cushioning and carrying device for the roof of a car.

Clearly, one would never confuse registrant's heavy-duty, permanent type of rack with applicants' product for temporary usage. However, we are concerned herein not with whether two types of goods can be distinguished, but rather whether it is likely that consumers will assume that such products emanate from the same source if they are sold under similar marks.

In spite of the differences in construction and flexibility of use, applicant's own specimens suggest that one specific use for applicant's racks is to "protect ... pickup beds ... " In this regard, we are satisfied from the evidence in this file that applicant and registrant are

marketing products having similar functions. They are after-market items that the owner of a motor vehicle uses for hauling extra-large loads -- on the top of a car using applicants' goods, or in the bed of a truck using either applicants' or registrant's goods.

The potential consumers of registrant's load rack for trucks as well as for applicant's portable cushioning rack would both be from the broad class of motor vehicle owners. Owners of pick-up trucks with load racks may well own cars and require the rack offered by applicants. Moreover, as noted above, pick-up truck owners could purchase both applicants' and registrant's products for use with their pick-up trucks.

In the absence of a specific limitation in the registration certificate, we must assume that registrant's load racks travel in the usual channels of trade for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Accordingly, we must conclude that such closely related items for similar purposes reach the same class of purchasers by moving through the same trade channels (e.g., automotive supply stores, stores featuring truck accessories and parts, mail-order catalogues, or on-line sites, etc.).

Applicants have repeatedly taken the position -- during the prosecution of this application before the Trademark Examining Operations and again during this *ex parte* appeal before the Board -- that registrant is no longer using its mark on the goods identified in its registration. However, Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. Accordingly, during this *ex parte* prosecution, applicants will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's non-use of the mark). See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988). Inasmuch as applicants have not taken action to have this cited registration cancelled, the Trademark Examining Attorney was warranted in disregarding this argument by applicant as these

allegations of registrant's non-use are irrelevant to our instant determination in this *ex parte* case.

In conclusion, given the strong similarities in the sound, appearance and meaning of these two marks, the fact that the goods are related, the identity of consumers and the overlapping channels of trade, it is likely that one acquainted with registrant's load racks for trucks sold under the mark PORT-O-RAC, upon seeing applicants' goods sold under the mark PORTA-RACK, would immediately assume these portable magnetic cushioning racks also originate with registrant.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.

E. J. Seeherman

P. T. Hairston

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board