

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

12/22/00

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Cancellation No. 27,236

Auto Wax Company, Inc.

v.

Leon Husisian<sup>1</sup>

Before Chapman, Wendel, and Bucher, Administrative  
Trademark Judges.

By the Board:

Leon Husisian owns Registration No. 1,758,748  
issued on March 16, 1993, on the Principal Register for  
the mark AUTO MAGIC CAR WASH and design for "vehicle  
washing and cleaning services" in Class 37,<sup>2</sup> as shown  
below.

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<sup>1</sup> It is noted that respondent's registration issued in the name of the original applicant, Leon Husisian, as an individual. Mr. Husisian has referred to himself as a joint owner of the mark in his answer to the petition to cancel and in his Section 8 affidavit filed with the Office on February 28, 1998. There is no record of any transfer of interest in the registration recorded with the Assignment Branch of this Office.

<sup>2</sup> The registration states that no claim is made to the exclusive right to use "car wash" apart from the mark as shown. It is noted that the Post Registration Branch canceled respondent's registration under Section 8 on August 30, 2000, but subsequently reinstated the registration on November 2, 2000.



On December 1, 1997, Auto Wax Company, Inc. filed a petition to cancel the AUTO MAGIC CAR WASH registration claiming priority of its registered mark AUTO MAGIC for various car care products,<sup>3</sup> as shown below.

**AUTO-MAGIC**

Petitioner alleges that respondent's mark, AUTO MAGIC CAR WASH and design, when used in connection with his identified services is likely to cause confusion, mistake or deception.

Respondent, in his answer, denies all of the salient allegations.

On September 11, 2000, the Board issued an order to show cause why the cancellation proceeding should not be deemed the equivalent of a cancellation by request of respondent in light of the registration

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<sup>3</sup> Registration No. 814,774, issued September 13, 1966, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed; for AUTO-MAGIC for "auto waxes and polishes" in Class 4; "plastic dye" in Class 6; "motor sealer for use as a finish for motor exteriors, lacquer thinner, tire paint, and motor paint" in Class 16; and "wax remover, tar remover, car shampoo, and white sidewall cleaner" in Class 52.

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having been cancelled because of the insufficiency of respondent's Section 8 affidavit. In response to the show cause order, respondent filed on October 6, 2000, a petition to the Commissioner as well as a response to the Board stating that the cancellation of its registration was the result of two procedural errors made by the Post Registration branch of this Office. As noted previously herein, the registration has since been reinstated by the Post Registration Branch.

Thus, the show cause order having now been discharged, the Board will now consider petitioner's motion for summary judgment filed May 17, 1999.<sup>4</sup> As grounds for the motion, petitioner states that there is no issue of priority in light of petitioner's prior registration; that the literal portions of respondent's mark and petitioner's entire mark are substantially similar; that the goods and services as set forth in the respective registrations are related; that the parties use the same marketing channels with petitioner

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<sup>4</sup> On June 14, 1999 respondent filed a motion to accept his late-filed response to petitioner's motion for summary judgment invoking good cause. His motion is granted, and respondent's late-filed brief is accepted. On July 12, 1999, respondent filed a "motion pursuant to Fed. R. Civ. P. Rule 11" in response to petitioner's opposition to respondent's request that the Board accept respondent's late-filed response to petitioner's motion for summary judgment. Respondent's motion for sanctions is denied as improper under Fed. R. Civ. P. 11(c)(1), and as unwarranted on this record.

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selling its goods to car washes for use by car washes and for the car washes to resell to retail customers; and that petitioner's mark has become famous.<sup>5</sup>

Respondent opposes the motion contending that his application was not refused registration in light of petitioner's prior registration; that petitioner has delayed in bringing this petition and thereby acquiesced to respondent's use of the mark; and that the marks are dissimilar, given respondent's design element.

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, Celotex Corp. v. Catrett, 477 U.S. 317 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving

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<sup>5</sup> It is noted that both parties have argued the guidelines to be followed in determining a likelihood of confusion as set out in Polaroid Corporation v. Polaroid Electronics Corp., 287 F.2d 492, 128 USPQ 411 (2<sup>nd</sup> Cir. 1961). The parties are advised that in cases before the Board, the issue of likelihood of confusion is governed by In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), which enumerated thirteen possible evidentiary factors to be considered in determining a likelihood of confusion. While the factors set out in Polaroid are similar, the relevant du Pont factors that are of record will be discussed herein.

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party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e), and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Petitioner has established that there are no genuine issues of material fact to be tried and that petitioner is entitled to summary judgment as a matter of law; and respondent has not raised a genuine issue of material fact.

As stated previously, in determining whether there is a genuine issue of material fact remains as to likelihood of confusion we look to the factors enumerated in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Here the relevant factors are the similarity/dissimilarity of the marks, as presented in the registrations; the similarity/dissimilarity and nature of the goods and services, as identified in the registrations; and the channels of trade.

*Priority*

Petitioner established continuous use since "the late 1950's",<sup>6</sup> and its ownership of its federal registration for the mark since 1966.<sup>7</sup> Respondent's first date of use, as set forth in its registration, is November 1, 1988.<sup>8</sup> Thus, any issue as to priority has been eliminated.

*Similarity of the Marks*

A comparison of the marks as set forth in the registrations demonstrates their similarity. In viewing the marks as a whole, there is one portion that is clearly dominant in respondent's mark, the literal portion, AUTO MAGIC. See, Giant Food, Inc. v. Nation's

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<sup>6</sup> Petitioner's president, David Miller, avers that it began using its mark in the late 1950's and has used the mark continuously since.

<sup>7</sup> While petitioner has provided a status and title copy of its registration, it is noted that it is stale, having been certified by the Patent and Trademark Office in 1989. We have therefore not considered the registration in determining priority, but rather find priority established through the parties' statements as to when each started using their respective marks.

<sup>8</sup> In a cancellation proceeding in which both parties own registrations, petitioner must establish prior rights in the subject mark, and respondent can defeat petitioner's claim by establishing that, as between the parties, respondent possesses prior rights in the mark sought to be cancelled. See, Brewski Beer Co. v. Brewski Brothers Inc., 47 USPQ2d 1281, 1284 (TTAB 1998). Petitioner established through Mr. Miller's declaration that it began use in the late 1950's whereas respondent's earliest established use is subsequent thereto.

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Foodservice, Inc., 218 USPQ 390, 395 (Fed. Cir. 1983).

This conclusion is reached by noting the size of the wording in relation to the design element; that the generic portion of the mark, CAR WASH, does not distinguish the marks; and that the literal portion is the part of the mark that people will use in referring to respondent's services. Thus, comparing the dominant portion of respondent's mark, AUTO MAGIC, to the dominant portion of petitioner's mark, AUTO-MAGIC, the literal portions of the marks are identical.

*Similarity of the Goods and Services and  
Channels of Trade*

In support of these factors, petitioner has provided, inter alia, a declaration from Lynn Ferrera, the owner of Auto Magic of Western New York, who avers that she distributes car care products manufactured by petitioner to car washes, automotive dealers and automobile detailers who in turn sell these car care products to their retail customers. Through the declaration of its president, David Miller, petitioner establishes that it advertises its goods through printed flyers, brochures, magazine advertisements and other forms of advertising to the car wash industry as well as the ultimate consumer of the car wash services. From the evidence of record (declaration of Lynn

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Ferrera), respondent's services are advertised, at a minimum, through location signs and coupons to retail customers, thereby establishing that the goods of petitioner and services of respondent are advertised and sold to the same class of purchasers.

In response, on the issues of the similarity/dissimilarity of the marks as well as the goods and services, respondent states<sup>9</sup> that respondent first learned of petitioner's mark in 1987<sup>10</sup> at an International Car Wash Association Convention; that he subsequently adopted his mark in 1988, but he is unaware of anyone, including petitioner, who uses a similar design in conjunction with the words AUTO MAGIC; that respondent uses his mark on services while petitioner does not provide services; that petitioner should have known of respondent's name sooner than petitioner acknowledges because the name appears in the International Car Wash Association directory; and that

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<sup>9</sup> While respondent submitted numerous attachments (e.g., copies of a membership directory; a convention guide; and a letter about discovery) to its brief in opposition to petitioner's motion for summary judgment, these are not identified or supported by affidavit or declaration. Further, there are two pages of responses to interrogatories that are not identified and appear to have been the subject of an opposition proceeding rather than the present cancellation proceeding before the Board. We have not considered these attachments due to their lack of authentication.

<sup>10</sup> Respondent's statement appears in his answer to petitioner's interrogatories.

the parties' respective marks create different commercial impressions. Respondent further contends that petitioner, because of its delay in petitioning to cancel respondent's registration has acquiesced in respondent's use of the mark<sup>11</sup>. Suffice it to say that in light of the similarity of the marks, the established relationship between the involved goods and services, and the channels of trade, none of the arguments put forth by respondent raise a genuine issue of material fact.

Accordingly, we find that there is no genuine issue of material fact as to the ultimate issues of priority and likelihood of confusion.

Petitioner's motion for summary judgment is granted, the petition to cancel is granted, and Registration No. 1,758,748 will be cancelled in due course.

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<sup>11</sup> It is noted that respondent did not plead acquiescence as an affirmative defense in its answer. (See, Blansett Pharmaceutical Co. v. Carmrick Laboratories, Inc., 25 USPQ2d 1473 (TTAB 1992).) Inasmuch as petitioner has treated respondent's arguments in its unpleaded defense on the merits, and petitioner did not object thereto, the Board hereby deems the pleading to have been amended by agreement of the parties. See TBMP § 528.07(b). However, respondent has not established its right to summary judgment on its defense of acquiescence.

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