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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Automotive Parts Association

Serial No. 75/335,792

Fred S. Lockwood of Cook, Alex, McFarron, Manzo, Cummings & Mehler, Inc. for applicant.

Jodi Lauterbach, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Wendel, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

National Automotive Parts Association has filed an application to register the mark NAPA AUTOCARE "PEACE OF MIND" for "business management supervision in the administration of warranties made by independent dealers in the field of automobile repair."[1]

[1] Serial No. 75/335,792, filed August 4, 1997, claiming a first use date and a first use in commerce date of January 1, 1994. A disclaimer has been made of the word AUTOCARE.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the following registered marks, all of which are owned by the same entity:

> for "vehicle repair and maintenance services performed at applicant automobile dealership" in Class 37; "automobile, van and truck leasing services" in Class 39; and "automobile dealership services" in Class 42;[2]

> for "vehicle repair and maintenance services performed at applicant automobile dealership" in Class 37; "automobile, van and truck leasing services" in Class 39; and "automobile dealership services" in Class 42; [3]

> for "vehicle repair and maintenance services" in Class 37; "automobile, van and truck leasing services" in Class 39; and "automobile dealership services" in Class 42.[4]

The requirement that applicant submit substitute specimens which show use of the mark in the sale or advertising of

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[2] Registration No. 2,081,339, issued July 22, 1997.
[3] Registration No. 2,079,108, issued July 15, 1997.
[4] Registration No. 2,057,554, issued April 29, 1997. A disclaimer is made of the word DEALER.

the services identified in the application has also made final. Both the refusal under Section 2(d) and the requirement for specimens have been appealed. Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Specimens

The specimens of record are printed warranty forms which according to applicant are given to purchasers at the time that services and/or repairs are performed on their vehicles. The warranty is captioned the NAPA AUTOCARE "PEACE OF MIND" NATIONWIDE LIMITED WARRANTY. Statements are found therein that the warranty is made by the independent dealer named on the repair order but "will be honored by any NAPA AutoCare Dealer participating in the program" and that the warranty is not made by applicant (NAPA) or the administrator, Ameraan, Inc. Purchasers are advised to either obtain warranty service from their original repairing dealer or, if farther than 25 miles from this dealer, to go to the nearest participating NAPA AutoCare facility. If not aware of any such NAPA AutoCare facility in the area, purchasers must contact the "Warranty Administrator" for assistance. If necessary, the

Administrator may also authorize repair work at a non-NAPA Auto Care location. At the bottom of the warranty is found the following:

The Examining Attorney maintains that, at best, these specimens show use of the mark in the sale or advertising of warranty services, and not use in the sale or advertising of any type of business management of the independent dealers offering these warranty services. She argues that the specimens are not directed to the consumer of applicant's services, who would be the warranty administrator, but rather to the third party to whom the dealer guarantees its repair services. The mere fact that the "Administrator" is referred to in the warranty is said to be insufficient to create a direct association between the mark and the business management supervision services recited in the application.

Applicant contends that the specimens clearly distinguish between the functions of the dealer who performs the service/repairs and issues the warranty and those of applicant who makes certain the warranty program works properly, with the aid of the Administrator who acts

on behalf of applicant. The display of the NAPA AUTOCARE "PEACE OF MIND" mark on the warranty is said to indicate to customers that applicant is involved, although only to the extent that the warranty program is properly managed.

We find the present specimens acceptable as evidence as use of the mark sought to be registered in the sale or advertising of the management supervision services identified in the application. Although the warranty points to the independent dealer who performed the service/repairs as the person who is extending the warranty to the purchaser, the warranty also sets forth the services performed by the administrator in assisting purchasers who are unable to obtain the warranted service from the original dealer. The administrator is identified as the one who carries out the "nationwide" aspects of the warranty program. We accept applicant's representation that this administrator is acting on behalf of applicant in performing these functions. Thus, the specimens adequately show the use of the mark in connection not simply with the warranty itself, but also with the supervision of the administration of these warranties on a nationwide basis by applicant, acting through a warranty administrator, presumably as part of the Nationwide Warranty Center. The administration services are being extended to the ultimate

consumer as an assurance that the warranties of the individual dealers will be honored. The management supervision evidenced by the specimens involves the fulfillment of the warranties, not the supervision of the administrator performing these functions.

The 2(d) Refusal

Turning to the issue of likelihood of confusion, we take under consideration those of the *Du Pont* factors[5] which are relevant under the circumstances at hand. Two key considerations in our analysis are necessarily the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods in connection with which the marks are being used. See In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Looking to the marks, the Examining Attorney cites the general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks by merely adding or deleting a house mark or descriptive matter. She takes the position that applicant has merely appropriated

[5] In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

the dominant feature of registrant's three marks, namely, the slogan "PEACE OF MIND," and added its house mark NAPA and the descriptive word AUTOCARE thereto.

Applicant contends that the phrase PEACE OF MIND is clearly not the dominant portion of the FIRESIDE YOUR PEACE OF MIND DEALER mark and is questionably the dominant portion of registrant's other two marks. Applicant points to the design features of the registered marks as elements to be considered and further argues that the expression "peace of mind" is so commonplace that it is devoid of service mark significance. Applicant relies upon dictionary definitions of "peace of mind"[6] as support for its contention that the phrase is merely descriptive with respect to the services of both registrant and applicant and thus the common use of this phrase cannot be the basis for a holding of likelihood of confusion.

As a general rule, the addition of a house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion. See In re Apparel

[6] Applicant's further reliance upon Exhibits E-F which have been attached to its brief has been objected to by the Examining Attorney as untimely. We sustain the objection and have not considered these exhibits. The Examining Attorney has also objected to the dictionary definitions introduced by applicant, in that applicant did not specifically request that the Board take judicial notice thereof. We do not find such a request a prerequisite to taking judicial notice of such definitions, however, and we have considered them.

Ventures, Inc., 229 USPQ 225 (TTAB 1986); In re Christian Dior, S.A., 225 USPQ 533 (TTAB 1985); In re C. F. Hathaway Co., 190 USPQ 343 (TTAB 1976). In fact, the addition may actually be an aggravation of the likelihood of confusion, rather than a distinguishing factor. Exceptions are made to this general rule, however, if (1) there are some recognizable differences in the conflicting product marks, i.e., the marks being used for the specific goods or services, or if (2) the product marks are merely descriptive or highly suggestive or play upon commonly used or registered terms, so that the addition of the house mark may be sufficient to render the marks as a whole distinguishable. See In re Christian Dior, S.A., *supra*, and the cases cited therein.

We agree with the Examining Attorney that the phrase or slogan PEACE OF MIND is the dominant feature of the PEACE OF MIND STANDARD EQUIPMENT marks of registrant. The design element is minimal in Registration No. 2,079,108 and even in Registration No. 2,081,339, the “fireside” depiction, although noticeable, would not be the portion of the mark which would be relied upon by purchasers in referring to the source of the services. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). The term STANDARD EQUIPMENT clearly has suggestive qualities

when used in connection with services involving automobiles.

Furthermore, we cannot accept applicant's arguments that the phrase "peace of mind" is so commonplace in general that it must be considered highly descriptive as used in the respective marks. It is true that the phrase falls within the general vernacular and has a recognized dictionary meaning. So do most words which are used as marks. The question is whether the phrase, which conveys a connotation of "freedom from anxiety or annoyance," is merely descriptive as used in connection with vehicle repair services or warranty services connected therewith. Applicant has failed to submit any evidence which might establish such descriptiveness. While the phrase might be construed as suggestive of the desired results of the services, as noted by the Examining Attorney, the marks of registrant employing the phrase are neither merely descriptive nor so highly suggestive that the addition of a house mark by applicant would serve to obviate likelihood of confusion. Nor is there any evidence of record that third parties use the phrase such that it has become commonplace in the automotive field.

On the other hand, we do not find a similar likelihood of confusion with respect to registrant's mark FIRESIDE A

PEACE OF MIND DEALER, regardless of the services with which it is being used. Here the house mark FIRESIDE plainly dominants the mark and the house mark would point to registrant as the source of the services offered thereunder. When the marks FIRESIDE A PEACE OF MIND DEALER and NAPA AUTOCARE “PEACE OF MIND” are viewed in their entireties, we find insufficient similarity in the marks to lead to any likelihood of confusion. While purchasers would encounter the same “Peace of Mind” slogan in both marks, the presence of distinct house marks cannot be ignored.

Accordingly, we turn to a comparison of the services offered under registrant’s two PEACE OF MIND STANDARD EQUIPMENT marks and applicant’s NAPA AUTOCARE “PEACE OF MIND” mark. The Examining Attorney argues that the automotive dealership and repair and maintenance services of registrant and the supervision services in the administration of warranties in the automotive field of applicant are closely related. In support of her position that these services may well be assumed to originate from the same source, she has made of record several third–party registrations showing the offering of both repair services and warranty services by a single entity under the same mark.

Applicant's argument is that its services, when properly understood, will be ascertained as being unrelated to automotive repair and maintenance services per se. Applicant insists that it is the independent dealers who perform the repairs and who provide the warranties to their customers. Applicant, as the overseer of the administrator of the warranty program, is said to have no direct relationship with the customers.

We completely understand that applicant does not itself perform the repair services or extend the warranty related thereto; the independent dealers affiliated with applicant perform these services. Nonetheless, we find the supervision of the administration of this warranty program which is performed by applicant under the mark sought to be registered to be not only directly related to the warranties but also to be a service which is proffered to the same persons to whom the warranties have been extended. Applicant itself has stated that the specimens indicate to "the ordinary customer" that applicant is involved in the proper management of the warranty program. (Reply brief, p. 3). If the warranty forms submitted are true specimens of applicant's use of its mark, then the services being proffered by applicant under the mark are directed to the same persons to whom the warranties have been made.

Applicant's services involve the management of the nationwide warranty program through an administrator such that the warranties made to the purchasers will be fulfilled. Although the independent dealers provide both the repair services and the warranties extended therewith, as the third-party registrations show is often the case, applicant's supervision of the warranty program is inextricably related to these services. If offered under a mark similar to registrant's PEACE OF MIND STANDARD EQUIPMENT marks which are used in connection with repair and maintenance services, we find that confusion on the part of purchasers is likely.

Decision: The refusal to register under Section 2(d) is affirmed with respect to cited Registration Nos. 2,081,339 and 2,079,108. The requirement for substitute specimens is reversed.

H. R. Wendel

D. E. Bucher

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board