

06/26/01

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

Paper No. 12
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Atlas Oil Company**

Serial No. 75/**543,197**

Raymond M. Galasso of **Simon, Fakhoury, Tangalos, Frantz & Galasso PLC** for **Atlas Oil Company**.

Melvin T. Axilbund, Trademark Examining Attorney, Law Office 113
(**Meryl Hershkowitz**, Managing Attorney).

Before **Cissel, Quinn** and **Hohein**, Administrative Trademark Judges.
Opinion by **Hohein**, Administrative Trademark Judge:

Atlas Oil Company has filed an application to register the mark "FAST TRACK" for "retail store services featuring gasoline and convenience store items."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "J.J.'S FASTRAC," which is registered for "retail

¹ Ser. No. 75/543,197, filed on August 25, 1995, which is based on an allegation of a bona fide intention to use the mark in commerce.

convenience store services,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods or services and the similarity of the marks.⁴

Turning first to consideration of the respective services, it is readily apparent that they are identical in part with respect to retail convenience store services. Moreover, the record contains evidence, including numerous excerpts from stories obtained from the "NEXIS" database, showing that it is a

² Reg. No. 2,153,115, issued on April 21, 1998, which sets forth dates of first use of August 1, 1997.

³ The Examining Attorney, in his brief, has properly objected to consideration of both an evidentiary affidavit and information about several third-party registrations which were attached as appendices to applicant's brief. As the Examining Attorney correctly notes, the submission of such evidence for the first time with applicant's brief is untimely under Trademark Rule 2.142(d). Accordingly, while the Examining Attorney's objection is sustained, it is also pointed out that even if such evidence were to be considered at this stage, it would make no difference in the outcome of this appeal.

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

common practice for many retail convenience stores to sell gasoline in addition to sundry convenience items. Thus, insofar as applicant's retail convenience store services also feature the sale of gasoline, such services are closely related to registrant's retail convenience store services. Applicant, we observe, does not contend to the contrary and, instead, appears to treat the respective services as if they were in fact identical in all significant respects, given the overlap of its services, as identified in the application, with those recited in the cited registration.

In view of the above, the principal focus of our inquiry is on the similarities and dissimilarities in the marks at issue when considered in their entirety. Nonetheless, as pointed out in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

Applicant maintains that the respective marks are not likely to cause confusion because the presence of the term "J.J.'S" in registrant's mark, which applicant asserts is the dominant portion thereof, results in a mark which is "dissimilar in sight, sound, meaning, and commercial impression" to its mark, which lacks such term. According to applicant:

essential characteristics of the goods [or services] and differences in the marks."

"J.J.'S" is more than a "fairly common and nondistinctive nickname" as asserted by the Examining Attorney. The usage of J.J.'s indicates ownership of the services by a distinct individual which is memorable in the minds of consumers. Appellant's mark is easily distinguished from Registrant's mark due to the ownership term in Registrant's mark. Additionally, Registrant's mark incorporates a novel spelling of the phonetic equivalent of FAST TRACK. These differences in appearance are substantial and serve to distinguish the marks in the minds of consumers.

Appellant further respectfully submits that the marks sound dissimilar. The [Registrant's] mark begins with the repetition of the "J" sound, which serves to distinguish the mark from Applicant's mark. Due to being a substantially longer mark with a distinctive repetition of the "J" sound, Registrant's mark has a dramatically different auditory effect than Registrant's mark, and as a result ..., no likelihood of confusion exists in the case at hand.

Finally, the different meanings and commercial impressions of the conflicting marks underscore that no likelihood of confusion between the marks exists. In Appellant's mark, FAST TRACK, the term FAST modifies the term TRACK and creates the commercial impression of speedy service. On the other hand, ... [Registrant's mark] J.J.'S FASTRAC creates a different impression on consumers. Due to the mark beginning with the possessive of a first name or nick name [sic], a sense of ownership is imparted. While the term J.J.'S is a nickname, its use in connection with the term FASTRAC is not common or nondistinctive. Instead of merely being speedy service, it is a service brought to you personally by J.J. This ownership serves to distinguish Registrant's mark and Appellant's mark. In conclusion, the respective marks ... create very different commercial impressions in the mind of consumers. As a result, the likelihood of confusion between the marks at hand is completely negated.

We agree with the Examining Attorney, however, that this appeal is governed by the general rule that a likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or trade name element. See, e.g., In re Apparel Ventures, Inc., 229 USPQ 225, 226 (TTAB 1986) and In re Riddle, 225 USPQ 630, 632 (TTAB 1985). Here, the absence of the apparent house mark or trade name element "J.J.'S"⁵ from applicant's "FAST TRACK" mark does not serve to avoid a likelihood of confusion since such mark and registrant's "J.J.'S FASTRAC" mark, when considered in their entirety, both create substantially the same commercial impression due to the respective presence of the terms "FAST TRACK" and "FASTRAC." Such terms, in addition to being "phonetic equivalents," as applicant has admitted, are also virtually identical in appearance and connote the same notion of what applicant characterizes as "speedy service." Overall, the respective marks project substantially the same commercial impression and their contemporaneous use in connection with legally identical retail convenience store services is likely to cause confusion as to source or sponsorship.⁶

⁵ The cited registration, we observe, issued to J.J. Fast Stops, Inc.

⁶ It is clear, in this regard, that to potential customers familiar with registrant's "J.J.'S FASTRAC" mark for its retail convenience store services, applicant's "FAST TRACK" mark for its retail store services featuring gasoline and convenience store items would appear to be a shortened form of registrant's mark. See, e.g., In re U.S. Shoe Corp., 229 USPQ 707, 709 (TTAB 1985) [Board noted, in holding that confusion is likely from an applicant's use of mark "CAREER IMAGE" for women's clothing (namely, dresses, blouses, pants, pantyhose, suits, jackets, skirts, shoes and sweaters) and a registrant's use of mark "CREST CAREER IMAGES" on uniforms (consisting of tops, blazers, skirts, pants, dresses, jumpsuits, culottes, hats,

Applicant further contends, however, that confusion is in fact unlikely because, as stated in its brief, it "has been using the trademark 'FAST TRACK' since at least 1998" without any reported incidents of actual confusion with registrant's mark "J.J.'S FASTRAC." While the absence of any instances of actual confusion over a significant period of time is indeed a *du Pont* factor which is indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by registrant under its mark. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for actual confusion to occur. See, e.g., Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

In this case, there is simply no supporting affidavit or declaration from anyone associated with applicant who has personal knowledge as to the asserted period, which appears to be

scarves, ties, vests and aprons), that "[a]pplicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark"]. As to the converse, the Examining Attorney cogently observes that, to customers acquainted with applicant's "FAST TRACK" mark for its convenience store services, the possessive term "J.J.'S" in registrant's "J.J.'S FASTRAC" mark would signify the same "FAST TRACK" brand of convenience store services, even though "offered, sponsored, endorsed or otherwise presented by J.J." See, e.g., In re Apparel Ventures, Inc., supra at 226 [in finding stylized mark "SPARKS BY SASSAFRAS" for women's blouses, skirts and sweaters is likely to cause confusion with mark "SPARKS" for shoes, boots and slippers, Board stated that "[t]he words 'by sassafras' indicate to prospective purchasers that 'sassafras' is the name of the entity which is the source of the 'SPARKS' brand clothing" and that such consumers "do not necessarily know or care which business calls itself 'sassafras,' but they would assume that when 'SPARKS' appears on two similar products that they both come from the same source"].

exceedingly short, of contemporaneous use of the respective marks, including information concerning details of the nature and extent of the sales and marketing activities of applicant and registrant. Aside therefrom, what little information which is available plainly reveals that there has been no real opportunity for any incidents of actual confusion to take place since, as stated in applicant's brief, its "operations and customers are in the Midwest whereas ... registrant's operations and customers are mainly in Texas." Furthermore, the claimed lack of any instances of actual confusion would not appear to be a mitigating factor in any event, since for customers of retail convenience store services, the typical purchase or transaction would be relatively inexpensive and, thus, any actual confusion experienced in the course thereof would not be expected to be reported and therefore come to the attention of applicant and/or registrant. Compare In re General Motors Corp., 23 USPQ2d 1465, 1470-71 (TTAB 1992).

Accordingly, we conclude that purchasers and prospective customers, familiar with registrant's "J.J.'S FASTRAC" mark for retail convenience store services, could reasonably believe, upon encountering applicant's substantially similar "FAST TRACK" mark for retail store services featuring gasoline and convenience store items, that such legally identical services emanate from, or are otherwise sponsored by or affiliated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.