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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cimarron Tire Auto Performance Specialist, Inc.

Serial No. 75/721,622
Serial No. 75/721,624

Anthony L. Rahhal of McAfee & Taft for Cimarron Tire Auto Performance Specialist, Inc.

Curtis W. French, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Chapman, Rogers and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 4, 1999, Cimarron Tire Auto Performance Specialist, Inc. filed two applications, both for the following services, identified as amended: "retail automobile parts and accessories stores featuring automobile tires" in International Class 35, and "automobile maintenance, repair and service" in International Class 37. Applicant claimed dates of first use and first use in commerce of May 10, 1999 for the services in both classes in each application. Application

Serial No. 75/721,624 is for the mark CIMARRON TIRE, and applicant disclaimed the term “tire.” Application Serial No. 75/721,622 is for the mark shown below, and applicant disclaimed the terms “tire” and “auto performance specialist.”

Registration has been finally refused in each application under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant’s mark, when used in connection with its identified services, so resembles the registered mark shown below

for “motor vehicles, namely, automobiles,”[1] as to be likely to cause confusion, mistake or deception.

Applicant has appealed, and briefs have been filed in each application. Applicant did not request an oral hearing in either application.

[1] Registration No. 1,213,237, issued October 19, 1982 to General Motors Corporation, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is April 30, 1981.

In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

We affirm the refusal to register in each application. In reaching this conclusion, we have followed the guidance of the Court in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The Examining Attorney contends that the cited mark and each of applicant's marks, when compared in their entireties, are very similar in sound, appearance and connotation; that the word CIMARRON is the dominant feature of both of applicant's marks; that applicant has merely added the highly descriptive word "tire" in one application, and descriptive words and design elements in its other application, but these do not overcome the similarities of the marks; that the record does not show that CIMARRON has any descriptive significance with regard to the involved goods and services, thus, making it an arbitrary term entitled to wide protection; that the goods and services are related as is evidenced by the fact that "many automobile servicing businesses specialize in servicing specific models of automobiles" (brief, p. 4),

and consumers would be aware of this practice; and that even if the goods and services involved are not casual or impulse purchases, nonetheless, even sophisticated purchasers are not immune from source confusion. The Examining Attorney submitted photocopies of three pages from the Mid-Atlantic Yellow Book under the listing "automobile repairing & service," showing that some automobile repair service shops specialize in repairing and servicing specific automobile makes (for example, "Audi Specialty Services," "Mitsubishi Special Service Center," "Plymouth- Chantilly-Repair & Service," "Porsche Specialist- Autobahn Service Inc.," and "Volvo-Saab-Swedish Import Services").

Applicant urges reversal on the basis that the Examining Attorney improperly dissected each mark, looking only at the word "CIMARRON," and ignoring the stylized lettering of the mark in the cited registration, the word "tire" in one applied-for mark, and all the other words and design features of applicant's second applied-for mark; that applicant's marks, when each is considered in its entirety and compared with the mark in the cited registration, are not similar in appearance, sound, or connotation; that applicant's marks suggest or connote the services applicant provides, while the registered mark

suggests nothing in particular about the goods; that the Examining Attorney has ignored the differences in the respective goods and services, as well as the discriminating consumers who would seek such goods and services; that automobiles are expensive products purchased with care; and that consumers will not confuse the source of applicant's services with the source of registrant's goods.

We turn to a consideration of the registrant's goods and applicant's services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Also, confusion in trade can occur from the use of similar marks for products on the one hand and for services involving those products on the other hand. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); Safety-Klean Corporation v. Dresser Industries, Inc., 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); and Steelcase Inc. v. Steelcare Inc., 219 USPQ 433 (TTAB 1983), and cases cited therein.

Of course, it has been repeatedly held that in determining the registrabilty of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant’s services, “retail automobile parts and accessories stores featuring automobile tires” and “automobile maintenance, repair and service,” and registrant’s “automobiles” are clearly complementary, closely related goods and services. The Examining Attorney submitted evidence from a telephone directory showing that some automobile repair and service shops specialize in

particular makes of automobiles. There can be no doubt as to the close relationship between automobiles and retail automobile parts and accessories stores (featuring tires) and repair and maintenance of automobiles. See In re Jeep Corp., 222 USPQ 333, 334 (TTAB 1984), and cases cited therein; and Winnebago Industries, Inc. v. Oliver & Winston, Inc., 207 USPQ 335, 343 (TTAB 1980). That is, applicant's involved services are commercially closely related to automobiles. See Permatex Company, Inc. v. California Tube Products, Inc., 175 USPQ 764 (TTAB 1972).

With regard to applicant's argument that the respective goods and services are expensive and consumers for both registrant's goods and applicant's services are discriminating purchasers, we agree only to the extent that automobiles are expensive products, and auto parts and auto repair and maintenance are sometimes expensive. Certainly, there are auto parts and even some auto repairs that are not expensive. Even if we assume that all of the involved goods and services are expensive and purchased with care in all circumstances, it is still true that relatively sophisticated or careful purchasers would, because of the similarity of the marks and the relatedness of the goods and services, believe that they come from the same source. See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687

(Fed. Cir. 1993). Cf. Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

We find that the involved goods and services are closely related, and could be sold to similar classes of purchasers, so that if sold or marketed under similar marks, confusion as to source by consumers would be likely.

Turning now to the marks, we consider first applicant's mark CIMARRON TIRE and the cited registered mark . Both applicant's and registrants' marks include the word CIMARRON. The fact that the registrant's mark is in stylized lettering while applicant's is in typed form is not a significant difference; and, in any event, applicant could alter the actual presentation of the mark at any time, including presenting the mark in some type of script lettering, even that form in which the registered mark is presented. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-1848 (Fed. Cir. 2000); and Squirtco V. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Further, applicant's addition of the descriptive/generic word "tire" is not significant. It is generally accepted that when a composite mark incorporates the arbitrary mark of another for closely related goods or services, the addition of suggestive or descriptive words

or other matter is generally insufficient to avoid a likelihood of confusion as to source. See The Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

In terms of connotation, there is no evidence that the term CIMARRON is anything other than arbitrary when used in connection with the involved goods and services. Thus, whatever the term CIMARRON connotes, it would connote the same for automobiles and for applicant's involved services relating to automobiles. The addition of the word "tire" to applicant's mark may suggest a reference to automobile tire services. However, as explained previously, the addition of a descriptive/generic word relating to applicant's services does not alter the meaning of applicant's mark, when considered in its entirety.

We find that applicant's typed word mark and the registered mark are very similar in sound, appearance, connotation, and commercial impression.

Turning next to a consideration of the cited mark and applicant's second mark, C (in a tire-like design) CIMARRON TIRE AUTO PERFORMANCE SPECIALIST and design, it is obvious that there are differences in appearance between these marks. However, when analyzing applicant's mark and the registered mark, it is not improper to give more weight to

a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). The word CIMARRON is the dominant portion of applicant's second mark, and even though it is in a different stylized lettering from that of the registered mark, nonetheless, it remains the dominant, source-identifying portion of the mark.

This identical word in both marks is the portion utilized in calling for the goods and services, and is most likely to be impressed in the purchaser's memory and to serve as the indicator of origin. The differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586,

177 USPQ 573 (CCPA 1973); Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992); and Consumers Building Marts, Inc. v. Mr. Panel, Inc., 196 USPQ 510 (TTAB 1977).

In this case, while registrant's mark shows the word CIMARRON in stylized lettering, and applicant's second mark is a composite mark including other words (all descriptive/generic) and a design, it is the word "CIMARRON" which remains the dominant, memorable feature of applicant's mark. The letter "C" (as the design of a tire), the descriptive/generic words "tire" "auto performance specialist," the rectangular black outline, and the "thick to thin" underline simply do not distinguish applicant's mark from the cited registered mark. The commercial impression created by these marks is similar. See The Wella Corporation v. California Concept Corporation, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and In re South Bend Toy Manufacturing Company, Inc., 218 USPQ 479 (TTAB 1983).

The differences between these marks are not sufficient to overcome the likelihood of confusion. To the extent that purchasers notice the differences in the marks, they may believe that applicant's mark is a revised version of registrant's mark, now used on retail stores for automobile

parts and accessories (featuring tires) and automobile repair and maintenance services. See In re Dixie Restaurants, supra. Thus, we find that the marks are substantially similar.

Any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Finally, regarding applicant's assertion that the registrant used the registered mark to designate an automobile body style through 1988 (see e.g., brief, p. 4), this is, in essence, an argument that the registrant has abandoned use of its involved registered mark. An applicant in an ex parte proceeding cannot attack the validity of a registration cited against it. See In re Dixie Restaurants, supra. If an applicant believes a cited registered mark has been abandoned, its remedy is to file a petition to cancel the cited registration pursuant to Section 14 of the Trademark Act.

Decision: The refusal to register under Section 2(d) is affirmed in each application.