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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re paragon AG

Serial No. 75/876,067

R. Scott Keller of Warner Norcross & Judd LLP for paragon AG.

David Gardiner, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hairston, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

A German corporation, paragon AG, seeks to register the mark PARAGON on the Principal Register as applied to goods identified as follows:

"outside air sensors for motor vehicles for measuring air quality; electric and electronic controls for motor vehicles for controlling fresh air quality as a function of the air quality, and parts therefor," in International Class 9, and

"UV-ozone generators and corona-ozone generators for air-ozonisation units for motor vehicles and buildings; air filters and air conditioning units for buildings and motor vehicles," in International Class 11.¹

¹ Application Serial No. 75/876,067, filed December 21, 1999, was based upon applicant's assertion of a *bona fide* intention to use the mark in commerce, and applicant claimed priority of September 14, 1999, pursuant to Section 44(d) of the Trademark

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark under Section 2(d) of Trademark Act (15 U.S.C. §1052(d)) on the ground that applicant's mark, when applied to applicant's goods, so resembles two trademarks owned by the same party, namely, the composite mark PARAGON REPRODUCTIONS and design as shown below:



previously registered on the Principal Register for a "full line of mechanical engine parts for automobiles," in International Class 7, and for a "full line of structural parts for automobiles,"² in International Class 12, as well as the mark PARAGON VINTAGE previously registered on the Principal Register for:

"automotive engine replacement parts, namely, engine pulleys, air filters, oil filters, exhaust manifold, crank case vent tubes, carburetor gaskets, radiator

Act, based upon a German application. On January 24, 2001, applicant perfected its Section 44 basis for registration by submitting a certified copy of German Reg. No. 399 56 475.6, along with an English language translation thereof.

² Registration No. 2,154,457, issued to Paragon Reproductions, on May 5, 1998. The word "Reproductions" is disclaimed apart from the mark as shown.

caps, chokes, pre-formed and/or fitted molded crank case hoses, pre-formed and/or fitted molded radiator hoses; pre-formed and/or fitted fuel lines," in International Class 7, and

"automotive replacement parts, namely, mirrors, wheel trim, hood latches, shift boots, luggage racks, windshield wipers, grills, bumpers, clutches, pre-formed and/or fitted brake lines, pre-formed and/or fitted transmission lines," in International Class 12,³

as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the case, but applicant did not request an oral hearing.

We affirm the refusal to register.

The evidence of record includes: (1) the Trademark Examining Attorney's submission of copies of the bibliographic data from dozens of federal registrations purporting to show a relationship between registrant's broadly-stated automotive parts and applicant's listed controls, filters and HVAC components for automobiles; (2) applicant's submission of copies of registrant's webpages; (3) applicant's submission of promotional brochures describing applicant's smart air-quality sensors; and (4)

³ Registration No. 2,148,448, issued to Paragon Reproductions, on April 7, 1998. The word "Vintage" is disclaimed apart from the mark as shown.

applicant's submission of the declaration of Klaus Dieter Frers, chairman of the board of applicant, in support of applicant's request for reconsideration of December 26, 2001.

Our likelihood of confusion determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors of In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to consider the marks. Registrant's first cited mark, PARAGON REPRODUCTIONS and design, is dominated by the large-lettered word, PARAGON. By contrast, the abstract geometric design provides no handle in asking for registrant's auto parts. Finally, while we compare the marks in their entirety, the word REPRODUCTIONS in registrant's mark is much smaller in size than the word PARAGON, it is located in a subordinate position to the word, PARAGON, and is correctly disclaimed as generic or

highly descriptive matter for automobile replacement parts manufactured by registrant. Similarly, in registrant's second cited mark for PARAGON VINTAGE (typed drawing), the word "Vintage" is disclaimed apart from the mark as shown. Hence, for quite rational reasons, the lead word PARAGON is considered dominant in this second cited mark as well. Of course, PARAGON constitutes applicant's entire mark. Accordingly, we find that applicant's mark is confusingly similar to registrant's marks as to appearance and connotation.

As to the du Pont factor dealing with the number and nature of similar marks in use on similar goods, there is no evidence in the file that the term "Paragon" is weak or even suggestive as applied to components for automobiles. Hence, we must conclude that it is a strong source-indicator in the field of automotive components - whether vintage or state-of-the-art.

We now turn to the issue of the similarity or dissimilarity and nature of the respective goods. Due to radically different treatment of extrinsic evidence submitted by applicant, the Trademark Examining Attorney and applicant's counsel have reached opposite conclusions as to whether applicant's goods are related to registrant's goods.

In making a determination herein on this and related du Pont factors (e.g., channels of trade), we have no choice but to consider the goods as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ["Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"]; In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ["The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"].

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a

relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989).

Here, applicant's goods involve electronic sensors, electronic controls and components for air conditioning and air filtration, and each of these specifically for installation in automobiles. While applicant's declarant states that it "sells these air quality sensors to automotive manufacturers and other original equipment manufacturers (OEMs) in the automotive field," and that its "sensors are not sold in retail channels" and "have never been part of the original equipment in Corvette automobiles," (Frers declaration, p. 2), applicant's identification of goods within the application is not so limited, and we cannot read such limitations into the identification of goods. Furthermore, the identifications of goods in the cited registrations represent a full line of engine, mechanical and structural parts for automobiles. Granted, registrant's webpages do show that it machines, rebuilds and inventories components solely for Chevrolet Corvettes of model years 1957 to 1982. It then sells these components from a single business location or over the

Internet, directly to individuals restoring these classic Corvettes. However, as noted by the Trademark Examining Attorney, the registrations neither restrict the channels of trade nor do they limit these parts to Corvette automobiles.

Then viewing the respective identifications of goods without regard to the extrinsic evidence submitted by applicant, the Trademark Examining Attorney points out that our precedent supports the conclusion that applicant's automotive parts are sufficiently related to registrant's automotive goods and structural parts that when sold under similar marks, confusion is likely.⁴ Although applicant has

⁴ These Board cases do not articulate a *per se* rule as to the relationship of automobiles and/or automobile components, but they do demonstrate the range of such goods where the use of identical or quite similar marks resulted in a finding of likelihood of confusion. See Monarch Mufflers, Inc. v. Goerlick's, Inc., 148 USPQ 20 (TTAB 1965) [MONARCH for brake linings for automotive use vs. exhaust mufflers for motor vehicles]; AP Parts Corp. v. Automotive Products Associated Limited, 156 USPQ 254 (TTAB 1967) [AP for clutches, brakes, steering joints, tie-rod joints, and suspension joints for land vehicles, aircraft or watercraft vs. mufflers for explosive engines]; Sieberling Rubber Co. v. General Battery and Ceramic Corp., 167 USPQ 766 (TTAB 1964) [identical HOLIDAY mark on automobile storage batteries vs. pneumatic rubber tires and automobile floor mats]; In re Market Tire Co. of Maryland, Inc., 171 USPQ 636 (TTAB 1971) [ADMIRAL for vehicle tires vs. automobile radiator antifreeze]; In re Uniroyal, Inc., 177 USPQ 29 (TTAB 1973) [KODIAK for vehicle tires likely to cause confusion with KODIAK and design for antifreeze and KODIAK for automobile heaters]; In re Magic Muffler Service, Inc., 184 USPQ 125 (TTAB 1984) [MAGIC for vehicle parts, namely, mufflers vs. motors for motor vehicles]; In re Trelleborgs Gummifabriks Aktiebolag, 189 USPQ 106 (TTAB 1975) [T and design for, *inter alia*, hoses, namely, rubber hoses and inner tubes for tires and pneumatic, semisolid and solid tires likely to cause confusion with T and design for, *inter alia*, motor oil, oil additives and fuel additives]; In re Engine Supply, Inc.,

made a compelling argument that, in the realities of the marketplace, these respective goods are not closely related, as discussed above, we must consider the issue of likelihood of confusion based upon the goods as identified in the application and in the cited registrations.

In addition, there is some evidence in the form of third-party registrations to suggest that the same source may provide both air filters, air conditioning units and electronic controls for regulating air quality in motor vehicles, as well as various other replacement mechanical parts for automobiles. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) [Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"]. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

225 USPQ 216 (TTAB 1985) [SPARTAN for tires vs. engines, transmissions and component parts for motor vehicles]; In re Jeep Corporation, 222 USPQ 333, 334 (TTAB 1984) [LAREDO for land vehicles and structural parts therefore vs. pneumatic tires]; and In re Red Diamond Battery Co., 203 USPQ 472 (TTAB 1979) [RED DIAMOND for storage batteries likely to cause confusion with DIAMOND for pneumatic rubber automobile and vehicle tires].

Hence, in determining the similarity or dissimilarity and nature of the respective goods, we find that applicant's air filters, air conditioning units and electronic controls for regulating air quality in motor vehicles, are related generally to registrant's full line of engine replacement parts for automobiles (in the '457 registration) and specifically to registrant's air filters⁵ (in the '448 registration).⁶

Finally, even taking into consideration the fact that purchasers of applicant's high-tech products are likely to be sophisticated purchasers, this would not eliminate the likelihood of confusion when the word PARAGON is the sole or dominant matter of the respective marks as used on the goods of applicant and of registrant. Octocom Systems, 16 USPQ2d at 1787.

⁵ We also acknowledge that registrant's air filters are engine parts while applicant's air filters are air conditioner components placed between the exterior of the automobile and the interior of the passenger cabin. However, even accepting this distinction, we find them to be related goods as that concept is used in evaluating likelihood of confusion under the Lanham Act.

⁶ Section 7 of the Trademark Act and the relevant case law of our reviewing court mandate that we give full force to registrant's broad identification of goods. Nonetheless, we note that when filing a new application for the instant mark, applicant's chances of obtaining a federal trademark registration would be greatly improved if it were to narrow its identification of goods consistent with the Frers' declaration and/or if it were to submit a consent from the owner of the cited registrations to applicant's use and registration of its PARAGON trademark for the goods identified herein.

In this case, we rely upon the fact that the marks are quite similar, there is no evidence that the term "Paragon" is weak or even suggestive, the goods as identified in the cited registrations and the instant application are the type that could well originate from a single source, and both are incorporated into motorized vehicles without limitation. Accordingly, our analysis leads us to conclude that there is a likelihood of confusion.

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.