

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 20

TJQ

Mailed: July 14, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Automotive Parts Association

Serial No. 76/175,910

Daniel M. Riess of Cook, Alex, McFarron, Manzo, Cummings & Mehler for applicant.

Jeffrey S. Molinoff, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Quinn, Hairston and Walters, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

The Board, on April 10, 2003, issued a final decision in this case wherein the refusals to register under Section 2(d) of the Trademark Act were affirmed. Upon learning that applicant had requested an oral hearing, but that the request was never received by the Board, the decision was vacated on April 23, 2003. An oral hearing was then held

on June 4, 2003 before the same panel that issued the April 10, 2003 decision.¹

An oral hearing corresponds to the oral summation in a court proceeding after all the evidence is in. TBMP §1216. At the oral hearing, counsel concentrated his arguments, as he did in the brief, on the evidence showing common usage of the phrase "peace of mind." Counsel argued that the usage shows that the cited marks are weak and entitled to only a narrow scope of protection, citing to the case of *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985).

We hereby reissue our original decision (copy attached), now noting, of course, that an oral hearing was held in this case at which applicant's counsel and the Examining Attorney appeared. We will focus our comments, as did applicant at the oral hearing, on the argument based on the commonality of the phrase "peace of mind."

The addition of a house mark to one of two otherwise confusingly similar marks generally will not serve to avoid likelihood of confusion. As pointed out in the original

¹ In the original decision, the Board noted that Exhibit J referenced in applicant's reply brief was not in the record file. (see footnote 3). The Board further noted that an evidentiary submission with a reply brief would be, in any event, untimely. Before the oral hearing was held, applicant submitted Exhibit J (copies of three pages retrieved from applicant's website). The Board reiterates the untimeliness of this submission and, in view thereof, the evidence has not been considered. Trademark Rule 2.142(d). The Board hastens to add, however, that even if considered, the evidence is not persuasive of a different result in this case.

decision, exceptions are made to this general rule if (1) there are some recognizable differences in the conflicting product marks, 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. Id.

Firstly, we stand by our original assessment that the marks, when considered in their entirety, are similar in sound, appearance and meaning. The dominant portion of each of the marks is "PEACE OF MIND" and, in comparing the marks, we have given more weight to this portion of the marks. See: *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Having said this, we reiterate that the marks in their entirety convey similar commercial impressions.

Secondly, we remain of the view that the involved situation does not fall within the exception argued by applicant, that is, "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." *In re Christian Dior, S.A.*, supra.

Applicant's evidence fails to show any third-party registrations of marks employing the subject phrase in the automotive repair field. Further, the evidence does not establish that the phrase "PEACE OF MIND" is merely descriptive of the services involved herein. As we noted before, although the phrase may be somewhat suggestive, the marks of registrant employing the phrase are neither merely descriptive nor so highly suggestive that the addition of applicant's house mark "NAPA" and the descriptive term "AUTOCARE" in applicant's mark serves to avoid likelihood of confusion.

The phrase "peace of mind" is an ordinary figure of speech. Although the evidence shows common, everyday language usage of the phrase, there is nothing in the record to show that there are uses of the phrase as a source identifier. The evidence falls short of establishing that purchasers no longer would look to the phrase as a source distinguishing feature.

Upon further consideration, the Board remains of the view that the marks, when considered in their entireties and as used in connection with the services, are likely to cause confusion.

Decision: The refusals to register are affirmed.