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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Sprint Lube Corporation**

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Serial No. 78017580

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**Jeffrey M. Furr** for **Sprint Lube Corporation**.

**John M. Gartner**, Trademark Examining Attorney, Law Office  
102 (**Thomas Shaw**, Managing Attorney).

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Before **Simms**, **Hairston** and **Bottorff**, Administrative  
Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

An application has been filed by Sprint Lube Corporation to register the mark SPRINT LUBE for "retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants" in International class 35 and "vehicle preventative maintenance services, namely, changing oil and air filters in International class 37."<sup>1</sup>

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<sup>1</sup> Serial No. 78017580 filed July 20, 2000 alleging dates of first use of April 24, 1989. The word "LUBE" is disclaimed apart from the mark as shown.

The Trademark Examining Attorney has refused registration 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 the identified services, so resembles the previously registered marks SPRINT for "automobile service station services"<sup>2</sup> and SPRINT 500 for "automotive products, namely, motor oil, automotive lubricants, and transmission fluid,"<sup>3</sup> as to be likely to cause confusion. The cited registrations are owned by different entities.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have submitted briefs on the case. An oral hearing was not requested.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 17 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d), two of the most

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<sup>2</sup> Registration No. 1,323,714 issued March 5, 1985; combined Sections 8 and 15 affidavit filed.

<sup>3</sup> Registration No. 2,225,097 issued June 8, 1999.

important considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services.

Refusal in view of Registration No. 1,323,714

Although applicant's application includes retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants, it is clear from the Examining Attorney's brief that the refusal to register in view of Registration No. 1,323,714 is directed to applicant's vehicle preventative maintenance services, namely, changing oil and air filters. Thus, our determination of likelihood of confusion in connection with this refusal is limited to the relationship between applicant's vehicle preventative maintenance services and registrant's automobile service station services.

In urging reversal of this refusal to register, applicant argues that its vehicle preventative maintenance services are very different from registrant's automobile service station services because its services are done in a quick and efficient manner. Further, applicant contends that the word LUBE is the dominant portion of its mark SPRINT LUBE and serves to set its mark apart from the registrant's mark SPRINT.

It is well established that the issue of likelihood of confusion must be determined on the basis of the goods and/or services as they are set forth in the involved application and the cited registration, and not in light of what such goods and/or services are shown or asserted to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 818 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, registrant's recitation of services contains no limitations with respect to type or nature and therefore we must presume that registrant offers all of the types of services generally offered by automobile service stations, including the services of changing oil and air filters. Indeed, it is common knowledge that automobile service stations offer such services. Moreover, although applicant argues that its vehicle preventative maintenance services are of a type that are done in a quick manner, applicant's recitation of services contains no such limitation. Even if it did contain such a limitation, it would be of no consequence because registrant's services are broadly described and therefore must be presumed to include the services of changing oil and air filters in a

quick manner. Thus, for purposes of our likelihood of confusion analysis, applicant's and registrant's services are considered to be the same. Moreover, the services must be deemed to be sold to the same classes of customers, which in this case would be the general public.

Turning then to the marks, our consideration thereof is based on whether applicant's mark and the registrant's mark, when viewed in their entireties, are similar in sound, appearance, connotation and commercial impression.

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See, *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by a mark. See, *In re National Data Corp.*, 753 F.2d 1056, 224

USPQ 749 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ..."  
224 USPQ at 751.

The word LUBE in applicant's mark is merely descriptive of a feature of vehicle preventative maintenance services. In this regard, we note applicant's disclaimer of the word and the excerpt submitted by the Examining Attorney from The American Heritage Dictionary of the English Language (3d ed. 1996) wherein "lube" is defined as: *To lubricate (a car's joints, for example).*" Because SPRINT is the first word in applicant's mark and is followed by a merely descriptive word, SPRINT is likely to be perceived by consumers as the dominant portion of applicant's mark.

Given the fallibility of consumers' memories and the fact that they are unlikely to encounter marks at the same time or side-by-side, we find that applicant's mark SPRINT LUBE and registrant's mark SPRINT, considered in their entirety, are substantially similar in sound, appearance, connotation and commercial impression.

Even if we were to assume that consumers did note the differences in the marks, they may well believe that

applicant's vehicle preventative maintenance services are a branch of registrant's automobile service station services or are somehow sponsored by or associated with registrant, i.e., the SPRINT automobile service stations are now operating a SPRINT LUBE branch. Therefore, we conclude that consumers familiar with registrant's automobile service station services offered under the mark SPRINT would be likely to believe, upon encountering applicant's mark SPRINT LUBE for vehicle preventative maintenance services, namely, changing oil and air filters, that the services originated with or were somehow associated with or sponsored by the same entity.

Refusal in view of Registration No. 2,250,097

It is clear from the Examining Attorney's brief that the refusal to register in view of Registration No. 2,250,097 is directed to applicant's retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants. Thus, our determination of likelihood of confusion in connection with this refusal is limited to the relationship between applicant's retail store services featuring motor oil, automobile fluids, automobile filters, and automobile lubricants, on the one hand, and registrant's automotive products, namely, motor

oil, automotive lubricants, and transmission fluid, on the other hand.

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 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. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In this case, applicant's retail store services involve the sale of automotive products which are identical to the automotive products marketed by registrant. Thus, applicant's retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants and registrant's automotive products, namely, motor oil, automotive lubricants, and transmission fluid, are clearly complementary, closely related goods and

services. We note that applicant does not dispute that its services and registrant's goods are closely related. In this regard, we note that confusion may result if the same or similar marks are used for goods, on the one hand, and for services involving those goods, on the other. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F. 2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Considering then the marks, applicant asks us to give little weight to the fact that both of the marks begin with the word SPRINT and to focus on the second term in each mark to reach a conclusion that the marks SPRINT LUBE and SPRINT 500 are not likely to cause confusion. However, as we have already discussed, SPRINT is the dominant portion of applicant's mark SPRINT LUBE and therefore is entitled to more weight when considering the respective marks in their entireties. Similarly, SPRINT makes a strong impression in registrant's mark SPRINT 500 because it is the first word in the mark. The word SPRINT dominates both marks, and is therefore more likely to be perceived and recalled as the primary source-indicating feature of the marks. The fact that the final term in the marks is different is not sufficient to avoid a likelihood of confusion.

Again, given the fallibility of consumers' memories and the fact that they are unlikely to encounter marks at the same time or side-by-side, we find that applicant's mark SPRINT LUBE and registrant's mark SPRINT 500, considered in their entireties, are similar in sound, appearance, connotation and commercial impression.

In reaching this conclusion, we have not overlooked applicant's argument that the marks have very different connotations, namely, that applicant's mark SPRINT LUBE connotes a "fast lube", whereas registrant's mark SPRINT 500 suggests the Indianapolis 500 or Daytona 500. Although consumers may well view applicant's mark SPRINT LUBE as connoting a "fast lube", we are not persuaded that consumers would associate SPRINT 500 with the Indianapolis 500 or Daytona 500. Consumers may view the 500 portion of registrant's mark as simply a grade or model designation. In any event, contrary to applicant, we do not view the marks as having vastly different connotations, but instead find that because both marks include the word SPRINT, they suggest something that is quick or fast.

Accordingly, we conclude that consumers familiar with registrant's automotive products, namely, motor oil, automotive lubricants, and transmission fluid offered under the mark SPRINT 500 would be likely to believe, upon

encountering applicant's mark SPRINT LUBE for retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants, that the services originated with or were somehow associated with or sponsored by the same source.

Applicant argues that there has been no actual confusion between its mark and the registrants' marks, and that this shows that confusion is not likely. We are not persuaded by this argument. Applicant has not provided any evidence as to the extent of its use, nor is there any evidence as to either of the respective registrants' use, such that we can determine whether there has been an opportunity for confusion to occur. Moreover, the issue before us is not one of actual confusion, but only the likelihood of confusion.

Finally, to the extent that any of applicant's contentions raise a doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the respective registrants. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1789 (Fed. Cir. 1984).

**Decision:** The refusal to register applicant's mark for "retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants" and

**Ser No. 78017580**

"vehicle preventative maintenance services, namely, changing oil and air filters" is affirmed in both instances.