

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

Mailed:
February 10,
2004
Paper No. 17
RFC

Hearing:
August 14, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Malco Products, Inc.**

Serial No. 76260899

Reese Taylor of Renner, Kenner, Grieve, Bobak, Taylor & Weber for Malco Products, Inc.

Doritt Carroll, Trademark Examining Attorney, Law Office 106 (Meryl Hershkowitz, Managing Attorney).

Before **Cissel**, Rogers and Bucher, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-identified applicant applied to register the mark shown below



Ser. No. 76260899

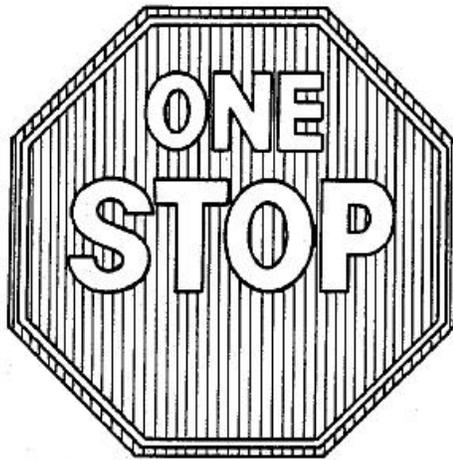
on the Principal Register for "power steering fluid, chemical additives for fuel and diesel fuel treatment, fuel injection cleaner chemical additives, octane booster fuel chemical additive, in International Class 1; carburetor and choke cleaning preparations, automobile wax, cleaning preparation for automobile brakes and parts therefore, in International Class 3; and automatic transmission fluid, in International Class 4." The application was based on applicant's assertions that its predecessor first used the mark in commerce in January of 1971, and that applicant uses it now.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that the mark applicant seeks to register, as applied to the goods specified in the application, so resembles the following two registered marks that confusion is likely.



Ser. No. 76260899

is registered¹ for "automotive electrical switches, automotive electrical connectors, automotive electrical assembly units, automotive speaker wire, automotive electrical sockets, automotive fusible links, automotive electrical terminals, automotive electrical wiring units, automotive electrical primary wire, automotive electrical pigtails in the nature of connectors, and automotive electrical harnesses"; and



is registered² for "screws, clamps, lugs and rings," in

¹ Reg. No. 1,435,345, issued on the Principal Register on April 7, 1987 to Echlin, Inc., a Connecticut corporation. Affidavits under Sections 8 and 15 of the Act accepted and acknowledged, respectively. The drawing is lined for the colors red and yellow.

² Reg. No. 1,452,907, issued on the Principal Register on August 18, 1987 to Echlin, Inc., a Connecticut corporation. Affidavits under Sections 8 and 15 accepted and acknowledged. The drawing is lined for the color red.

Ser. No. 76260899

Class 6, and for "electrical equipment and parts, namely solderless connectors, test clips, insulated clips, charging clips, connectors, wire joints, line taps, wire splices, grommets, cable ties, box connectors, circuit breakers and testers, ground clips, conduit fittings, wire; preinsulated terminals, splices, spades and disconnects for wire gauges; switches and switch panels," in Class 9.

Applicant responded to the refusal to register with argument that confusion between its mark and the cited registered marks is not likely because the marks are "readily distinguished on the basis of appearance and sound." (February 7, 2002 response, p. 2) Applicant also argued that its goods are not related to the goods specified in the cited registrations. In this regard, applicant contended that registrant's "targeted consumers are wholesalers and repair shops, while applicant's consumers are the average, everyday car owner," so that applicant's customers are unlikely to encounter registrant's specialized products, and, to the extent that some wholesalers or repair shop employees familiar with registrant's mark might encounter the products bearing applicant's mark, such people are sophisticated with respect to their knowledge of the products and services sold in the automotive field, and accordingly, they would

not be confused as to the source of the goods sold under registrant's and applicant's marks.

The Examining Attorney was not persuaded by applicant's arguments, however, and the refusal was made final in the second Office Action. Submitted with that action in support of the refusal to register were copies of a number of third-party registrations wherein marks are registered for both various automotive fluids and car parts. One such example is the mark "MOROSO," which is registered³ for, inter alia, chemical fuel additives, namely gasoline anti-knock fuel additives and octane booster fuel additive; non-chemical fuel additives, namely, gasoline anti-knock fuel additives and octane booster fuel additive; automotive lubricants; battery disconnect switches; cable terminals; starter switches; starter switch cables; switch panels and toggle switches; jumper terminals; battery connectors; battery junction boxes; battery quick connect plugs and quick disconnect flush mount battery cable connectors, flush mount battery cable connectors, battery relocation trays,; cables, terminals, clamps and grommets; lights for vehicles, such as low-oil warning lights and tachometer lights and flashing lights; and wire ties for

³ Reg. No. 2,136,866, issued on the Principal Register to Moroso Performance Products, Inc. on February 17, 1998.

Ser. No. 76260899

use with land motor vehicles. Another example is the mark "ACDelco" and design, which is registered⁴ for antifreeze; automobile cooling system rust inhibitors; automobile cooling system leak sealants; brake fluid; coolants for vehicle engines; power steering fluid; automotive electrical ignition switches; electrical air bag switches; electrical switches; batteries; electrical wire sets comprised of electrical cable, electrical connectors and voltage regulators. Similar third-party registrations owned by other vehicle manufacturers such as Ford, automotive parts dealers such as NAPA, and general merchandisers such as Sears were also submitted by the Examining Attorney.

Applicant responded to the final refusal to register with additional argument that confusion is not likely between its mark and the cited registered marks. Attached as an exhibit to applicant's response was the declaration of Stuart Glauberman, applicant's president, stating that

⁴ Reg. Nos. 2,440,150, issued on the Principal Register to General Motors Corp. on April 3, 2001; and 2,445,739, issued to General Motors Corp. on April 24, 2001.

for the fifteen years he had been president of applicant, he was unaware of any instances of actual confusion between applicant's mark and the cited registered marks.

The Examining Attorney treated applicant's response as a request for reconsideration of the final refusal. After reconsidering the refusal in light of applicant's request, however, she maintained the refusal to register.

Applicant then timely filed a Notice of Appeal, followed by its appeal brief. The Examining Attorney filed her brief on appeal and applicant filed a reply brief, along with a request for an oral hearing before the Board. As indicated above, both applicant and the Examining Attorney presented arguments at the hearing on August 14, 2003.

Based on careful consideration of the record and the arguments before us, as well as the Act and the legal precedents on the issue of likelihood of confusion under Section 2(d), we find that the refusal to register is well taken. Confusion is likely because the marks create similar commercial impressions and the goods identified in the cited registrations are related to those specified in the application.

The marks create similar commercial impressions because each is dominated by the design of an octagonal

traffic stop sign on which the word "STOP" is shown on a red background.

Applicant argues that the marks are readily distinguishable because the additional word "ONE" is shown in the cited registered marks directly above the word "STOP." Applicant contends that the addition of this word changes the connotation of these marks from that of an ordinary stop sign, which, in connection with applicant's goods, suggests that the goods "stop" bad things from happening to your car, whereas the two-word term "ONE STOP" in the cited registered marks conveys the suggestion that all of a customer's needs can be met in a single shopping trip.

While pensive reflection and thoughtful analysis of these two marks could result in a purchaser of these products eventually making such distinctions, in view of the nature of the goods specified in both the application and the cited registration, it is unlikely that purchasers will engage in this kind of analysis. Simply put, people who buy the goods listed in the application, including things like fuel additives, carburetor cleaners, wax and automatic transmission fluid for automobiles, can be the same people who purchase the electrical products for automobiles such as speaker wire, fuse links and electrical

wire and terminals, which are specified in the cited registration, and these people are unlikely to analyze these two marks to the extent argued by applicant. To the contrary, the addition of the word "ONE," which appears in letters much smaller than the word "STOP," is unlikely to be a basis upon which consumers distinguish these marks. The marks are otherwise almost identical, and the commercial impressions they create are very similar.

Applicant argues, however, that the purchasers of these products are so sophisticated that they would distinguish between these marks, and that as sophisticated purchasers, they would not expect these goods all to emanate from a single source. Nothing in this record, however, supports applicant's position in this regard.

We must resolve the issue of whether confusion is likely on the basis of the goods as they are identified in the application and the cited registration, respectively, without any restrictions or limitations not reflected therein. In re Elbaum, 211 USPQ 639 (TTAB 1981). In the instant case, therefore, we must consider that the goods set forth in the application and in the cited registrations are sold through all the usual channels of trade for such products, so we can acknowledge the fact that ordinary consumers are included along with professional automotive

technicians in the pool of purchasers to whom these goods are marketed, and that they are available to such people through the same channels of trade, including auto parts stores and mass merchandisers.

The third-party registrations owned by Sears and NAPA support this conclusion. Those registrations, as well as the other use-based third-party registrations made of record by the Examining Attorney, are evidence that the goods named therein are commercially related such that the use of these similar marks on them is likely to cause confusion. In re Albert Trostel & Sons, 29 USPQ2d 1783 (TTAB 1993).

Applicant argues that the Sears and NAPA registrations are not probative of the commercial relatedness of the goods because the marks in these registrations are house marks under which a wide variety of products are sold. While these marks do appear to be house marks, the registrations nonetheless show that the owners of these marks have, in fact, registered their respective marks for the goods listed therein. The relevance of these registrations under the Trostel case, supra, is not diminished by the likelihood that the marks are house marks. That lots of other products are also listed in these registrations does not change the fact that the marks

are registered for both the kinds of goods specified in the application which is the subject of this appeal and the products listed in the registrations cited as a bar to its registration. In any event, even without the Sears and NAPA registrations, the Examining Attorney has met her burden of proof in this regard by making of record the other third-party registrations mentioned above, which do not appear to be in the nature of house marks.

Furthermore, it is well settled that goods or services do not need to be identical in order for confusion to be likely. Instead, it is sufficient if the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same people in situations that would give rise, because of the marks employed thereon, to the mistaken belief that they originate from or are in some way associated with the same producer. In re Pan-O-Gold Baking Co., 20 USPQ2d 1761 (TTAB 1991). The goods at issue in the instant case clearly meet this test. All are products which could be purchased and used by both professional automobile technicians and individual car-owning consumers. Although the purposes for which they are used are not the same, all are related to automotive repair or maintenance. In view of the very similar marks used on these related

Ser. No. 76260899

products, purchasers are likely to assume that the goods emanate from, or are in some way associated with, a single source. Confusion is likely under these circumstances.

Accordingly, the refusal to register under Section 2(d) of the Lanham Act is affirmed and registration to applicant is refused.