

3/3/2005

THIS OPINION IS NOT CITABLE  
AS PRECEDENT OF  
THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Goodyear Swap Meet, L.C.

---

Serial No. 76476149

---

Scott E. Johnson for Goodyear Swap Meet, L.C.

Lourdes D. Ayala, Trademark Examining Attorney, Law Office  
106 (Mary Sparrow, Managing Attorney).

---

Before Seeherman, Hanak and Hairston, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Goodyear Swap Meet, L.C. (applicant) seeks to register  
in typed drawing form GOODYEAR MARKET PLACE SWAP MEET for  
"publications, namely, newsletters reporting upcoming  
social events, bumper stickers, pens and pencils" (Class  
16); "housewares, namely, coffee cups, sports bottles sold  
empty, sipper cups, and thermal insulated holders for  
contained beverages" (Class 21); and "clothing, namely,  
shirts and caps" (Class 25). The application was filed on

December 19, 2002 with a claimed first use date as to all types of goods of November 1, 1999. Applicant disclaimed the exclusive right to use MARKET PLACE SWAP MEET apart from the mark in its entirety.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as used in connection with applicant's goods, is likely to cause confusion with five previously registered marks. The first is GOODYEAR and design registered for "erasers." Registration No. 502,320. The second is GOODYEAR and design registered for "retail store services" featuring, among other goods, "glassware." Registration No. 909,784. The third is GOODYEAR and design registered for "clothing, namely, caps, t-shirts, sweatshirts and jackets." Registration No. 1,202,797. We have not reproduced the design features in the foregoing three registered marks because applicant has never contended that said design features in any way distinguish these three marks from applicant's mark. Indeed, at page 3 of its brief applicant even states that "all of the trademark registrations cited by the Examining Attorney ... consist entirely of the word GOODYEAR." (emphasis added). The other two registrations cited by the Examining Attorney -- namely, Registration Nos. 1,037,899 and 1,467,482 -- are

not pertinent to our likelihood of confusion analysis because they cover goods which are decidedly more dissimilar from applicant's goods than are the goods and services of the aforementioned three registrations.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Because applicant has filed a multi-class application, we must compare the goods in each of applicant's three classes with the goods of one or more of the three pertinent cited registrations. Applicant's Class 16 goods include pencils. Pencils are extremely closely related to the goods of Registration No. 502,320, namely, erasers. Many, if not most, pencils come with erasers.

Applicant's Class 21 goods include housewares such as coffee cups, sports bottles and sipper cups. The services of Registration No. 909,784 include retail store services featuring glassware. We find that retail store services featuring glassware and various types of cups including coffee cups are extremely closely related. Glassware and cups are used to hold liquids for human consumption.

Finally, applicant's Class 25 goods include caps and shirts. These goods are identical to certain of the goods of Registration No. 1,202,796, namely, caps and t-shirts.

Turning to a consideration of the marks, we note at the outset that when applicant's goods are extremely closely related or identical to the goods or services of the cited registrations as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In considering the marks, we recognize that we are obligated to compare the marks "in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in comparing the marks in their entirety, it is completely appropriate to give less weight to a portion of a mark that is merely descriptive of

the relevant goods or services. National Data, 224 USPQ at 751 ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark."). In the first Office Action, the Examining Attorney stated that the phrase MARKET PLACE SWAP MEET in applicant's mark was merely descriptive of applicant's goods and hence must be disclaimed. Thereafter, applicant submitted, as previously noted, a disclaimer of MARKET PLACE SWAP MEET, thereby conceding that this phrase was indeed descriptive of its goods in that it indicated where the goods could be purchased.

Hence, we find that the most prominent feature of applicant's mark is GOODYEAR, which is identical to the word portion of the three pertinent cited marks. While the three pertinent cited marks contain design features, said features are entitled to extremely minimal weight in any likelihood of confusion analysis because they are so minor. In this regard, as previously noted, applicant even stated at page 3 of its brief that "the trademark registrations cited by the Examining Attorney ... consist entirely of the word GOODYEAR." (emphasis added).

Moreover, GOODYEAR is the most prominent portion applicant's mark for two other reasons. First, the fact

that GOODYEAR is "the first word" in applicant's mark and the only word in the three pertinent registered marks is a factor which makes "the marks similar." Palm Bay Imports, Inc. v. Veuve Clicquot, \_\_\_ F.3d \_\_\_, \_\_\_ USPQ2d\_\_\_ (Fed. Cir. 2004). See also Presto\_Products v. Nice-Pak Products, 9 USPQ2d 1825, 1897 (TTAB 1988) (The fact that two marks share the same first word is "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.")

Second, and of far greater importance, is the fact that applicant seeks to register its mark GOODYEAR MARKET PLACE SWAP MEET in typed drawing form. This means that applicant's mark is not limited to being "depicted in any special form," and hence we are mandated to "visualize what other forms the mark might appear in." Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992).

If applicant were to obtain a typed drawing registration of GOODYEAR MARKET PLACE SWAP MEET, then applicant would be free to depict the GOODYEAR portion of its mark in large lettering on one line, and then to depict the descriptive phrase MARKET PLACE SWAP MEET in decidedly

smaller lettering on a second line. When so depicted, applicant's mark would be extremely similar to the marks of the three pertinent cited registrations.

Finally, if there is any doubt on the issue of likely confusion (and there is not), said doubt is totally eliminated when we take into account applicant's concession that at least the marks of cited Registration Nos. 909,784 and 1,202,797 are very famous, or to use applicant's precise words "so famous." (Applicant's Brief page 4). As our primary reviewing Court has made crystal clear on numerous occasions, the fame of a prior mark plays a "dominant role" in any likelihood of confusion analysis. Famous marks enjoy a wide latitude of legal protection. Recot, Inc. v. M.C. Becton, 214 F.3d 1322, 1327 (Fed. Cir. 2000). See also Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 353 (Fed. Cir. 1992).

One final comment is in order. Applicant's only real argument as to why there is no likelihood of confusion involving its mark GOODYEAR MARKET PLACE SWAP MEET and the marks of the cited registrations is based on the fact that the GOODYEAR portion of applicant's mark refers to Goodyear, Arizona. In this regard, applicant states that the "GOODYEAR MARKET PLACE SWAP MEET is a famous flea market venue in Goodyear, Arizona." (Applicant's Brief page

4). See also Applicant's Reply Brief page 2. Applicant also contends that the Goodyear Tire & Rubber Co. "has not requested that applicant discontinue use of GOODYEAR MARKET PLACE SWAP MEET." (Applicant's Reply Brief page 2).

The issue before this Board is not whether there is a likelihood of confusion in Goodyear, Arizona involving the use of applicant's mark and the marks of the pertinent cited registrations. Applicant is now seeking nationwide rights in its mark GOODYEAR MARKET PLACE SWAP MEET. Applicant has simply offered no proof whatsoever that consumers located outside the vicinity of Goodyear, Arizona would not confuse its mark with the various registered GOODYEAR marks. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited registrations], rather than what the evidence shows the goods and/or services to be."). The fact that in actuality applicant's goods may be offered only in Goodyear, Arizona is of no consequence because there is no limitation in

Ser. No. 76476149

applicant's application restricting the sale of applicant's goods only to Goodyear, Arizona.

Decision: The refusal to register is affirmed.