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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ford Motor Company
v.
Plaza Automotores, S.A. de C.V.

Opposition No. 91156584
to application Serial No. 76259041

Robyn S. Lederman of Brooks Kushman P.C. for Ford Motor
Company.

John Egbert of Harrison & Egbert for Plaza Automotores, S.A.
de C.V.¹

Before Rogers, Drost, and Walsh, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 21, 2001, Plaza Automotores, S.A. de C.V.
(applicant) filed an intent-to-use application to register
the mark shown below on the Principal Register for services
identified as "dealerships in the field of new and used
automobiles" in Class 35:

¹ Applicant did not file a brief in this case.



An opposition was filed by Ford Motor Company (opposer) alleging that there is a likelihood of confusion under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) between applicant's mark as proposed to be used on its services and the following registrations.

I.

Registration No. 365,585

Issued: March 14, 1939

The word "MERCURY" is written in a very bold, italicized, sans-serif font with a slightly distressed or textured appearance.

For: Passenger and commercial automobiles

Class: 12

Status: Third Renewal

II.

Registration No. 2,035,859

Issued: February 4, 1997

Mark: MERCURY COMMITMENT (typed or standard character form)

For: Automotive services, namely, emergency roadside repair services, and repair and maintenance of motor vehicles

Class: 37

Status: Affidavits under Sections 8 & 15 accepted or acknowledged

III.

Registration No. 2,516,328

Issued: December 11, 2001

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Mark: MERCURY OWNER ADVANTAGE (typed or standard character form)

For: Promoting the sale of goods and services of automobile dealership through an online global computer network, through the distribution of printed material, audio and video tapes, television and radio broadcasts, and promotional contests, and through the administration of customer loyalty programs

Class: 35

Status: Active

Opposer also alleged ownership of a registration for MERKUR for automobiles and their structural parts (no. 1,294,151) but this registration has now been cancelled. In addition, opposer introduced numerous MERCURY registrations during its testimony period but it has not amended its notice of opposition. Inasmuch as applicant has not filed any papers subsequent to the introduction of these registrations, we cannot say that these registrations were tried by consent. Cf. Genesco Inc. v. Martz, 66 USPQ2d 1260, 1265-66 (TTAB 2003) ("Applicant made no objection to opposer's reliance on the three unpleaded registrations, and in fact applicant treated the additional registrations as if they were of record... [W]e consider opposer's pleadings amended to conform to the evidence"). Therefore, we will consider the issue in this case to be whether there is a likelihood of confusion only with regard to opposer's three registrations referred to above.

Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the pleadings, the file of the involved application; and opposer's stipulated testimony by affidavit with exhibits of Mark Sparschu, opposer's chief trademark counsel; and opposer's notice of reliance on registrations and applications, publications, and interrogatories and request for the production of documents.

Priority

Opposer has established its priority by submitting status and title copies of three registrations for its MERCURY marks for automobiles and automobile-related services. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

The issue in this case is whether applicant's mark MERKAUTO and design for its automobile dealership services is so similar to opposer's MERCURY, MERCURY COMMITMENT, and MERCURY OWNER ADVANTAGE marks for its automobile and automobile-related services that there would be a likelihood of confusion. In likelihood of confusion cases, we consider the evidence as it relates to the factors set out by the Court of Custom and Patent Appeals, one of the Federal Circuit's predecessors, in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d

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1201, 1203 (Fed. Cir. 2003) and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The first factor we will consider is the similarity of the marks in sound, appearance, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant's mark includes the word "Merkauto" and a multiple-dot design while opposer's marks are MERCURY, MERCURY COMMITMENT, and MERCURY OWNER ADVANTAGE. The marks are similar to the extent that the marks all begin with the prefix Merc- or Merk-. These prefixes look similar and they would be pronounced the same. The other part of applicant's mark is the term "auto" that would obviously have a very descriptive connotation for automobile dealership services. Certainly, the marks MERKAUTO and MERCURY are not identical, but they are similar since they begin with the phonetically identical term MERC or MERK.

Regarding the meaning of the terms, opposer submits that the term MERCURY was selected because of its "meaning as the winged messenger of God in Roman mythology who symbolizes dependability, elegance and speed." Sparschu testimony, ¶ 6. We also note that Mercury is defined, inter alia, as the "planet nearest the sun" and "a silvery-white poisonous metallic element that is a liquid at room

temperature." *The American Heritage Student Dictionary* (1998).² Applicant's prefix would be at least suggestive of "mercury" inasmuch as "Merc" is an abbreviation of "mercury." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). See also *Mercoide Corp. v. Airborne Instruments Laboratory, Inc.*, 287 F.2d 189, 129 USPQ 64, 66 (CCPA 1961) ("Opposer relies upon three marks, the first of which is MERCOID. This mark consists of the prefix MERC as in mercury, and the suffix 'OID' meaning 'like' or 'related to'"). Applicant's phonetically identical and visually similar term could likely have the same meaning. Therefore, the marks' appearances and meanings have some similarities. Finally, the commercial impressions of the marks MERKAUTO and MERCURY, MERCURY COMMITMENT, and MERCURY OWNER ADVANTAGE would be somewhat similar inasmuch as they, at least, suggest a connection with "Mercury."

We also add that applicant's multiple-dot design would not distinguish the marks. It is a relatively simple design that is unlikely to be referred to by prospective purchasers when discussing the services. Indeed, it is vaguely reminiscent of a hood ornament and it merely reinforces the

² We take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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"auto" nature of the services. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("[M]inor design features do not necessarily obviate likelihood of confusion arising from consideration of the marks in their entireties. Moreover, in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed."). Also, the slight differences in the stylization of the letters in applicant's mark and opposer's 365,585 registration would not be significant enough to lead people to assume that the marks' identify different sources.

In this case, the "Merc" or "Merk" part of the marks can be considered as abbreviations for "mercury" and they would dominate the marks. The other terms "auto," "commitment" and "owner advantage" would have less trademark significance because they are at least suggestive or laudatory for the services. Therefore, when we consider the marks as a whole, we find that the similarity of the initial phonetic prefix would suggest a similarity of the source of the goods and services. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on

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consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable").

Next, we consider whether the goods and services of opposer and applicant are related. Applicant's services are automobile dealership services. Opposer's goods and services include passenger and commercial automobiles, automotive services, namely, emergency roadside repair services, and repair and maintenance of motor vehicles, and promoting the sale of goods and services of automobile dealerships.

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). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

We find that these goods and services are closely related. Opposer is the source of automobiles that could be sold at or through applicant's automobile dealers and opposer is involved in promoting the sale of goods and services of automobile dealerships as well as providing repair services that could be performed at automobile dealerships. Inasmuch as opposer's goods and services

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include automobiles that could be sold at dealerships, promoting automobile dealerships, and providing automotive services that could be performed at automobile dealerships, automobile dealership services are related to opposer's goods and services. Prospective purchasers are likely to assume that there is some association between applicant's services and opposer's goods and services.

The last factor we consider is the fame or public recognition and renown of the opposer's MERCURY mark. Opposer asserts that its MERCURY mark "is a famous trademark that enjoys a substantial international reputation, but most strongly in North America." Brief at 11. When there is evidence of the fame of a mark, it "plays a dominant role." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting, Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 54 USPQ2d at 1897.

In this case, opposer has included evidence that Mercury branded vehicles were first sold in 1939. Sparschu testimony ¶ 7. Over the last ten years, Ford has sold more than two million Mercury cars: 2005 (212,369); 2004 (211,482); 2003 (245,075); 2002 (293,903); 2001 (378,970); 2000 (399,770); 1999 (531,728); 1998 (373,596) and 1997

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(464,771). Sparschu testimony ¶ 14. Opposer also provided evidence that it has spent more than \$200,000,000 over the last six years "to advertise the MERCURY brand": 2005 (\$78,288,000); 2004 (\$87,318,000); 2003 (\$2,630,000); 2002 (\$35,397,000); 2001 (\$57,951,000); and 2000 (\$32,691,000).

Sparschu testimony ¶ 17. In addition, opposer has submitted evidence that suggests the nature of the advertising involved with promoting the MERCURY trademark for automobiles:

The Ford Motor Co. has launched what reportedly is its biggest advertising campaign ever to tout the Ford Contour and Mercury Mystique, cars produced at Ford's Kansas City plant.

Advertising Age, the trade bible for the advertising industry, pegged Ford's Contour-Mystique ad budget at \$110 million...

Indeed, Ford intends to give away Mystiques on NBC's Tonight Show in late September.

The commercial for the new-car line now running regularly in prime time was produced by Ford's corporate office.
Orlando Sentinel, September 8, 1994.

Ford Motor Co.'s Lincoln-Mercury division will unleash its biggest advertising campaign ever today in a bid to sharpen its image. Hoping to capitalize on several new products, including the redesigned Sable sedan, Ford will ask customers to "Imagine yourself in a Mercury" as part of a flurry of television and print ads being released this month. Ford plans a two-week blitz starting Sept. 25 with television ads during Monday Night Football on ABC and "Murphy Brown" on CBS.
Chicago Sun-Times, September 11, 1995.

Ford's Mercury division - which spent about \$175 million last year to advertise - introduced a campaign Tuesday for its 1998 models that includes spoofs of TV

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shows such as *Perry Mason*, *Gunsmoke*, and the movie *Casablanca*.

USA Today, October 1, 1997.

Ford's Mercury Milan has signed on as sponsor of a new AOL program, the Moviefone Short Film Festival, a "Project Greenlight"-like competition set to go live next week at Moviefone.com.

New York Daily News, June 23, 2005.

Opposer's evidence of the sale of hundreds of thousands of automobiles and an advertising campaign that resulted in approximately a quarter of a billion dollars in advertising expenditures in a six-year period supports a conclusion that opposer's MERCURY trademark has achieved at least some public recognition and renown. We add that our conclusion is similar to the one reached by the district court in Ford Motor Co. v. Lloyd Design Corp., 184 F. Supp. 665, 62 USPQ2d 1109, 1120 (E.D. Mich. 2002) (The "court finds that Plaintiffs' marks [including MERCURY] are sufficiently famous"). Therefore, the fame of opposer's MERCURY marks reinforces opposer's argument that there is a likelihood of confusion in this case.

When we consider all the evidence in view of the du Pont factors, we conclude that, if applicant were to use its MERKAUTO and design mark for new and used automobile dealership services, there would be a likelihood of confusion with opposer's MERCURY, MERCURY COMMITMENT, and MERCURY OWNER ADVANTAGE marks used on automobiles and for automobile services and services promoting automobile

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dealerships. The marks have some similarities and opposer's MERCURY mark has achieved some fame. The goods and services are related to the extent that applicant's automobile dealership services are closely related to opposer's automobiles and its automobile-related services. Potential patrons of applicant's MERKAUTO new automobile dealership services are likely to believe that there is some relationship between these services and opposer's MERCURY automobiles and its MERCURY COMMITMENT and MERCURY OWNER ADVANTAGE automobile-related services. Therefore, there is a likelihood of confusion.

Decision: The opposition to the registration of the mark in application No. 76259041 is sustained.