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Paper No. 15
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diffie Ford Lincoln Mercury, Inc.

Serial No. 75/618,557

Judith L. Rice of C. Craig Cole & Associates for Diffie
Ford Lincoln Mercury, Inc.

Richard R. Alves, Jr., Trademark Examining Attorney, Law Office 104 (Sidney I.
Moskowitz, Managing Attorney).

Before Hairston, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Diffie Ford Lincoln Mercury, Inc. has filed an application to register the
mark LAND OF LINCOLNS for “automobile dealerships featuring used and
new automobiles.”^{1[1]}

Registration has been finally refused under Section
2(d) of the Trademark Act on the ground of likelihood of confusion with the
marks LINCOLN^{2[2]} and LINCOLN (stylized)^{3[3]}, both of which are registered by
the same entity for “motorcars.”

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*^{4[4]} factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, we are guided by the well-established principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We are in agreement with the Examining Attorney that the dominant portion of applicant's mark is the term LINCOLNS, whereas LINCOLN comprises the whole of registrant's mark. Moreover, LINCOLN when used in connection with registrant's "motorcars," or automobiles, is an arbitrary mark. The additions to registrant's mark of the

^{1[1]} Serial No. 75/618,557, filed January 11, 1999, claiming a first use date and first use in commerce date of April 1, 1993.

^{2[2]} Registration No. 511,662, issued June 28, 1949 under Section 2(f); Section 8 & 15 affidavits; second renewal.

^{3[3]} Registration No. 170,692, issued July 17, 1923 on the Supplemental Register; third renewal.

^{4[4]} *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

words “LAND OF” and the plural ending “S” can at best be regarded as the tacking of merely suggestive elements onto an arbitrary mark. While the additional words obviously render the marks somewhat different in sound and appearance, the overall commercial impressions created by the marks are highly similar. See *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (Addition of merely suggestive term CALIFORNIA to arbitrary registered mark CONCEPT not sufficient to avoid likelihood of confusion).

Applicant argues that the marks have different connotations, with the mark LINCOLN bringing to mind the automobiles manufactured by registrant whereas the mark LAND OF LINCOLNS refers to a dealership that sells numerous LINCOLN automobiles. We simply view the addition of “LAND OF” to the mark LINCOLN as suggesting that this is a location where many LINCOLNS are available, with no particular reference to any specific type of business. No distinction between manufacturer and dealer can be drawn on the basis of the additional words “LAND OF.” The overall commercial impression of both marks is the same, the use of the arbitrary word LINCOLN in connection with the goods and/or services at hand.

In considering the respective goods and services, it is not necessary that the goods of registrant and the services of applicant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods and services are related in some manner and/or that the

conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. If there are no restrictions in the application or registration(s) as to channels of trade, the parties' goods and services must be assumed to travel in all the normal channels of trade for goods of this nature. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

Applicant's major contention is that the public is well aware that automobile dealerships do not manufacture vehicles and that registrant, the Ford Motor Company, sells its vehicles to dealerships, not consumers, and thus there would be no likelihood of confusion. Applicant has submitted the affidavit of its president to the effect that applicant and registrant are not in the same business; that applicant sells registrant's products to consumers and registrant sells its products to dealerships; and that applicant and registrant have entered into an agreement which requires applicant to use and advertise registrant's marks. Applicant points to the many dealerships doing business as "John Doe Lincoln" as support for its argument that consumers are fully aware when dealing with these businesses that they are contemplating transactions with an automobile dealer and not the manufacturer.

The Examining Attorney points out that applicant has acknowledged that its dealership services feature the products of registrant. As a result, the goods of registrant and the services of applicant will ultimately be encountered by the same purchasers. No distinction can be made on the basis of channels of trade, regardless of the intermediate sale of the vehicles by registrant to applicant.

The Examining Attorney counters applicant's argument that dealerships and automobile manufacturers do not deal in the same businesses with copies of several third-party registrations showing registration of the same mark used by an automobile manufacturer for its vehicles for dealership services as well. For example, the mark NISSAN is registered for "motor vehicle dealership services,"^{5[5]}

CHRYSLER for "used car and car part dealership services,"^{6[6]}

BMW for "retail motor vehicle and motor vehicle engine dealership services"^{7[7]}

and registrant, Ford Motor Company, has registered the mark 1-2-3-FORD for "motor vehicle dealership services."^{8[8]}

While these registrations are admittedly not evidence of use of the marks in commerce, they are sufficient to suggest that automobiles and dealership services with respect to these automobiles are goods and services which may be produced or offered by a single entity and marketed under the same or similar

^{5[5]} Registration No. 2,047,851.

^{6[6]} Registration No. 1,263,266.

^{7[7]} Registration No. 1,164,922.

^{8[8]} Registration No. 1,775,555.

marks. See *In re Albert Trostel & Sons Co.*, *supra*; *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Accordingly, if similar marks, such as those involved here, are used for both vehicles and dealership services with respect to these vehicles, it may reasonably be presumed that purchasers will mistakenly believe that both the vehicles and the dealership services emanate from the same source. The line of demarcation which applicant is attempting to draw between manufacturer and dealership services clearly does not hold true in all instances. There may be many independent dealerships that purchase their vehicles from manufacturers and resell them to consumers, but the sponsorship of dealerships directly by the manufacturer is a viable alternative. The use of a mark incorporating LINCOLN in connection with dealership services may well raise the mistaken belief on the part of purchasers as to sponsorship of the dealership by the manufacturer itself.

While applicant argues that there is no evidence that registrant uses its LINCOLN mark for dealership services, or at least has registered the mark for the same, we do not consider evidence of this specificity necessary. The evidence does show that registrant has registered another of its vehicle marks for dealership services and thus in fact provides or sponsors dealership services as well as the vehicles themselves. This evidence simply bolsters the reasonableness of the presumption that consumers may well assume that both vehicles and dealership services emanate from the same source.

Although applicant points to its contractual agreement with registrant in which applicant is required to use applicant's LINCOLN marks in connection with the sale of registrant's automobiles, we find no provision therein that applicant is entitled to register any of these marks, or a variation thereof, for dealership services. In fact, as noted by the Examining Attorney, the agreement specifically provides for the discontinuance of use of any "Lincoln" marks upon termination of the contract. The granting of a registration to applicant for the mark LAND OF LINCOLNS would appear to be in contravention of these terms. Furthermore, although many other dealerships may exist under the names "John Doe Lincoln," there is no evidence of record that any such trade names have been registered as service marks by the dealerships.

Accordingly, on the basis of the similarity of the commercial impressions of the marks, the close relationship between the vehicles of registrant and the dealership services of applicant, and the identity of the ultimate channels of trade, we find that there is a likelihood of confusion.

Decision: The refusal to register under Section 2(d) is affirmed.