

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: 9/7/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Avanti Motor Corporation

Serial No. 75856030

Jennifer L. Day of Bose McKinney & Evans for applicant.

Edward Nelson, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Quinn, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Avanti Motor Corporation
to register the mark STUDEBAKER for "automotive vehicles,
namely automobiles."¹

The trademark examining attorney refused registration
under Section 2(d) of the Trademark Act on the ground that
applicant's mark, if applied to applicant's goods, would so
resemble the previously used and registered marks

¹ Application Serial No. 75856030, filed November 23, 1999, based
on an allegation of a bona fide intention to use the mark in
commerce. Applicant subsequently filed an amendment to allege
use setting forth dates of first use of July 1, 2001.

Ser No. 75856030

STUDEBAKER DRIVERS CLUB for "association services, namely, promoting the general interest of those interested in antique cars"² and



for "association services, namely, promoting general interests of those interested in antique cars,"³ as to be likely to cause confusion. The registrations are owned by the same entity.

When the refusals were made final, applicant appealed.⁴ Applicant and the examining attorney filed briefs. An oral hearing was not requested.

In urging that the refusal be reversed, applicant contends that the marks, when considered in their entirety, are not similar in sound and appearance inasmuch as both registered marks include additional words, and one of the registered marks includes a design element.

² Registration No. 1068731, issued June 28, 1977; renewed. The words "Drivers Club" are disclaimed.

³ Registration No. 1043803, issued July 13, 1976; renewed. The words "Drivers Club Inc." are disclaimed.

⁴ The examining attorney withdrew a surname refusal in his Office action dated July 9, 2003.

Ser No. 75856030

As to meaning, applicant asserts that its mark is arbitrary whereas the registered marks convey the idea of a drivers club associated with the Studebaker automobile. Applicant also points to the differences between automobiles and association services, arguing that it is unlikely that any consumer would think that a drivers club would manufacture automobiles. Applicant also states that customers for the involved goods and services would be sophisticated.

Further, according to applicant, it has peacefully coexisted with registrant for two years; registrant has in fact posted news articles about applicant's automobile on registrant's web site. In support of its arguments, applicant submitted these articles, as well as the declarations of two of applicant's officers, Kevin Hines and John Seaton.

The examining attorney maintains that the registered marks are dominated by the term STUDEBAKER which is identical to the entirety of applicant's mark. Thus, the examining attorney argues, the marks are similar. As to the goods and services, the examining attorney finds that they are related, stating that "the registrant is promoting under the same mark the very goods that applicant is making available for purchase." (Brief, p. 5). The examining attorney concludes that consumers are likely to believe

Ser No. 75856030

that applicant, as the automobile manufacturer, formed a club to celebrate and promote its automobile.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

By way of background, the record shows that Studebaker Corporation manufactured automobiles from the 1920's through the 1960's. This corporation manufactured a car branded as AVANTI from April 1962 to December 1963. When Studebaker exited the auto manufacturing business in 1963, applicant continued to make cars under the AVANTI mark. According to Mr. Seaton, applicant has purchased parts and blueprints identified by the STUDEBAKER mark, and applicant is recognized as a successor to the original manufacturer

of STUDEBAKER automobiles. Applicant's activities have been described in the press as the "latest revival" of the Studebaker automotive business, and many consumers have inquired as to applicant's plans to produce automobiles under the STUDEBAKER mark. Mr. Seaton states that applicant's NEW AVANTI automobile incorporates the styling elements of Studebaker Corporation's original AVANTI.

With respect to the marks, although they must be considered in their entirety, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "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...." Id. at 751.

Insofar as registrant's marks are concerned, the disclaimed words "Drivers Club" in the typed mark, and the disclaimed words "Drivers Club Inc." in the logo mark are generic or highly descriptive for the type of services

Ser No. 75856030

rendered by registrant. Thus, these words, as they appear in registrant's respective marks, play a subordinate role in our likelihood of confusion analysis. When registrant's typed mark is viewed as a whole, it is the term STUDEBAKER which is the dominating and distinguishing element thereof. Likewise, registrant's logo mark is dominated by the term STUDEBAKER. Further, in registrant's logo mark, the term STUDEBAKER appears in larger letters than the disclaimed words; the STUDEBAKER portion dominates the literal portion of this mark, which in turn dominates over the design portion. In re Dixie Restaurants Inc., supra; In re Decombe, 9 USPQ2d 1813 (TTAB 1988); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). The dominant element STUDEBAKER is the portion of each of registrant's marks that purchasers are most likely to remember. Of course, this dominant portion of each of registrant's marks is identical to applicant's mark. Neither the disclaimed words in the marks, nor the design element in the logo mark offers sufficient distinctiveness to create a different commercial impression. Indeed, the design portion of the logo mark, which comprises a depiction of a wheel, merely serves as a background for the literal portion.

The similarities between the marks outweigh the differences. In sum, we find that applicant's mark and each of registrant's marks, when viewed in their entirety, are similar in sound, appearance and connotation, and that they create similar overall commercial impressions. These findings weigh in favor of a conclusion that confusion is likely.

In connection with the marks, we also note that there is no evidence of any third-party use of similar STUDEBAKER marks in the field, a fact which supports a finding that the registered marks are entitled to a scope of protection broad enough to encompass applicant's mark.

Next, we turn to compare applicant's goods (automobiles) with registrant's services (association services of promoting general interests of those interested in antique cars). The thrust of applicant's argument is that it is highly unlikely that any consumer would think that a driver's club would manufacture automobiles, and in this instance, "it is even more unlikely that the public would think that an organization for antique automobile enthusiasts would manufacture and market a modern extreme utility vehicle." (Brief, p. 6).⁵ The design, production

⁵ Throughout applicant's arguments, applicant refers to its "modern extreme utility vehicle" which, according to applicant,

and marketing of applicant's STUDEBAKER automobiles require a significant investment of time, money and labor, which, according to applicant, could not be supported by a driver's club organization.

As has been often stated, it is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services

has a list price of \$75,000, and is sold through only a limited number of applicant's hand-selected dealers. Applicant should note, however, that likelihood of confusion must be determined on an analysis of the mark as applied to the goods and/or services identified in the involved application vis-à-vis the goods and/or services set forth in the cited registration, rather than what the evidence shows the goods to be. Canadian Imperial Bank v. Wells Fargo Bank N.A., 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

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). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods and/or services and the registrant's goods and/or services that is required to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

In the present case, we find that the goods and services are commercially related and/or, at the very least, are complementary. Here, under similar marks, registrant is promoting antique STUDEBAKER automobiles while applicant is selling modern versions of automobiles with the styling of a STUDEBAKER. Consumers, upon encountering the marks and the goods and services sold thereunder, are likely to think the manufacturer of STUDEBAKER automobiles also sponsors a driver's club for those interested in antique STUDEBAKER automobiles. Although an organization of automobile enthusiasts may not have the wherewithal to manufacture cars, certainly an automobile manufacturer may have or sponsor a club catering to those consumers who are interested in antique cars of

the manufacturer. It comes as no surprise that, as reflected in registrant's mark itself, and as shown by the evidence, antique STUDEBAKER cars are the focus of registrant's services. The goods and services would be purchased by the same classes of customers, and these consumers are likely to mistakenly believe that the goods and services originated with or are somehow associated with or sponsored by the same entity.

We agree with applicant that the purchase of the involved goods and services may, in many cases (but not all), be made by relatively sophisticated purchasers. The sophistication of the purchasers, however, does not require a finding of no likelihood of confusion. Even assuming that the purchasers of these goods and services are sophisticated, this does not mean that such consumers are immune from confusion as to the origin of the respective goods and services, especially when sold under similar marks. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Decombe*, supra. We agree with the following assessment of the examining attorney: "There is no reason to believe that the public (sophisticated or not) would not think that the purveyor of goods would not also form a club to celebrate and promote

such goods. A commercial enterprise will seek to promote the use of its goods in a wide variety of ways and certainly forming an 'association' to do so is a logical extension of promoting one's own goods." (Brief, p. 5).

Lastly, applicant points to "co-extensive use and registrant's acknowledgement of applicant's use of STUDEBAKER mark." (Brief, p. 8). According to applicant, its mark and registrant's marks have been contemporaneously used since July 1, 2001 without any known instances of actual confusion. Applicant also highlights the fact that registrant has supported applicant's use of the STUDEBAKER mark as evidenced by registrant's posting on its web site news articles about applicant's STUDEBAKER vehicles.

The absence of actual confusion does not compel a different result in this case; the applicable test is a likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). There is nothing in the record regarding the extent of use of either applicant's or registrant's marks. Thus, we are unable to determine if there has been any meaningful opportunity for confusion to occur in the marketplace. In any event, the absence of actual confusion may be attributable to consumers' simply assuming that

there is a source, sponsorship or license-type arrangement between applicant and registrant.

We recognize that registrant has posted on its web site articles about applicant and applicant's activities in reviving the STUDEBAKER mark. Applicant has not furnished, however, any consent to register from registrant, and we will not infer any consent from registrant's actions relative to its postings on its web site of articles dealing with applicant's STUDEBAKER vehicle. See generally TMEP §1207.01(d)(viii) (3d ed. rev. May 2003). Even if one were to infer a consent to use based on registrant's actions, this is not tantamount to a consent to *register*. See: *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30, 31 (Comm'r Pats. 1937) and *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PO Ex. Ch. 1954) [permission to use a mark without specific consent to also register the mark does not give a party the right to register the subject matter as a trademark].

The Federal Circuit has made it clear that consent agreements should be given great weight. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985). In the present case, we have neither a consent from registrant nor

an agreement between applicant and registrant. See *In re Opus One Inc.*, supra at 1819-22. Even if registrant has not voiced any objection to applicant's use, and has helped publicize applicant's business efforts, we will not assume, on this record, that registrant has no objection to the issuance of a federal trademark *registration* to applicant. If registrant in fact has no such objection, there is available to applicant in a future application a type of evidence which, under case law, is entitled to great weight in the likelihood of confusion analysis, that is, a valid consent agreement between applicant and registrant. The evidence of record herein simply does not suffice as a substitute for such an agreement.

In making our determination, we anticipate that some may view the result herein as strange. Indeed, the usual situation undoubtedly is that the car manufacturer is the senior party using the mark, followed by the car club. Here, although the original car manufacturer came first, the manufacturer ceased operations, and then the car club adopted *and registered* its mark for services rendered by it. After a mark has become abandoned, if it is then adopted and used by an entity unrelated to the original owner, the rights to the mark vest with the first to adopt and use it, provided that the new user takes reasonable

Ser No. 75856030

precautions to prevent confusion. Subsequent users will have rights which are subordinate to the rights of the first entity to adopt the mark after the abandonment. In *re Wielinski*, 49 USPQ2d 1754, 1758 (TTAB 1998) [applicant, an organization for collectors of DIAMOND T antique vehicles, could register the DIAMOND T mark for its activities and items because the original vehicle manufacturer was defunct and had abandoned the DIAMOND T mark more than thirty years previous], *overruled in part on other grounds*, *In re WNBA Enterprises LLC*, 70 USPQ2d 1153 (TTAB 2003). To state the obvious, each case must stand on its own set of facts, and, based on the record before us, we find that there would be a likelihood of confusion between the involved marks and the respective goods and services sold thereunder.

We conclude that purchasers familiar with registrant's association services, namely, promoting general interests of those interested in antique cars rendered under registrant's STUDEBAKER DRIVERS CLUB marks would be likely to believe, if they were to encounter applicant's mark STUDEBAKER for automobiles, that the goods and services originated with or are somehow associated with or sponsored by the same entity.

Ser No. 75856030

To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., supra; and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.