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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AutoFair Investors, LP

Serial No. 76012699

Paul. W. Garrity of Kelley Drye & Warren LLP for AutoFair Investors, LP.

Zhaleh Sybil Delaney, Trademark Examining Attorney, Law Office 116 (Meryl Herskowitz, Managing Attorney).

Before Hairston, Walters, and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

AutoFair Investors, LP (a Delaware limited partnership) filed an application on March 29, 2000, to register on the Principal Register the mark AUTOFAIR for services ultimately amended to read: "automobile dealership services featuring new or nearly new automobiles, but excluding the offering for sale or exhibition of custom, collector, or specialty cars or

trucks" in International Class 35.¹ The application is based on applicant's claimed date of first use and first use in commerce of February 5, 1991 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a). In response to the Examining Attorney's refusal to register the mark as merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), applicant amended the application to seek registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), which was accepted by the Examining Attorney.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its

¹ In applicant's "Response to Office Action No. 3" dated March 27, 2002, applicant sought to add "automobile leasing services in International Class 36" to the application. It is unclear whether the Examining Attorney then handling this application specifically accepted the additional class or not. In any event, it is clear from a later Office action dated October 1, 2003, that the Examining Attorney then handling the application found "automobile leasing services" to be beyond the scope of the original identification of services. (The Examining Attorney pointed out that the correct classification is International Class 39). Both applicant and the Examining Attorney have since treated the application as involving only the services in International Class 35. The computer records of the USPTO likewise indicate that this application involves only International Class 35 services.

identified services, so resembles two registered marks:²
AUTOFAIR³ and the mark shown below

AUTOFAIR

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both for "conducting exhibitions in the field of custom, collector and specialty cars and trucks, and car parts" in International Class 41, as to be likely to cause confusion, mistake or deception.

After the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing.⁵

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the Court 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*

² The records of the Assignment Branch of the USPTO indicate that both registrations are owned by (through transfers of interest) Speedway Properties Company, LLC.

³ Registration No. 2197130, issued October 20, 1998, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use and first use in commerce is April 1976.

⁴ Registration No. 2210137, issued December 15, 1998, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use and first use in commerce is March 4, 1994.

⁵ In April 2005, the Board suspended proceedings on this appeal pending a determination of whether the cited registrations(s) would be cancelled under Section 8 of the Trademark Act, 15 U.S.C. §1058. As the Section 8 affidavits of use were filed and accepted, this appeal has been resumed.

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).

The Examining Attorney essentially contends that applicant's mark and the two cited registered marks are identical and nearly identical, respectively; that the cited registrant's services and applicant's services are closely related despite applicant's stated exclusions because "specialty automobile 'exhibitions' include trade exhibitions for the sale of [cars and trucks]" (brief, unnumbered page 4); that "it is not implausible for the registrant to expand [its normal fields of expansion] to the classic car dealer market" (brief, unnumbered page 10); and that doubt is resolved in the registrant's favor.

Applicant argues that the marks are different in connotation; that registrant's services are not as broad as the Examining Attorney contends and the Examining Attorney's position relies on flawed logic and speculation; that registrant's services are limited to custom car

enthusiasts, while applicant operates automobile dealerships selling new cars; that applicant's services are distinctly different from the very specific and limited exhibition services offered by registrant; that there is no evidence that registrant, who has been in business since at least 1976, (or any other custom car exhibition company) has expanded into the field of automobile dealerships; that applicant's services involve the sale of automobiles which generally cost well over \$10,000 and these items are purchased only after careful consideration; and that there are no instances of confusion to applicant's knowledge despite simultaneous use since 1991.

Applicant's mark and the cited registration of the standard character mark are identical. Moreover, applicant's mark and the cited registration of the stylized lettering (and underlined) mark are virtually identical. As to connotation, the record includes The American Heritage Dictionary (Third Edition 1992) definitions of the noun "fair" including the following:

"1. A gathering held in a specific time and place for the buying and selling of goods; a market. 2. An exhibition, as of farm products or manufactured goods, usually accompanied by various competitions and entertainments: a state fair. 3. An exhibition intended to inform people about a product or

business opportunity: a computer fair;
a job fair..."

In addition, the Board takes judicial notice of the following definitions of the word "fair" from The Random House Dictionary (Second Edition 1983):⁶

"adjective 1. free from bias, dishonesty or injustice..."; and

"noun 1. an exhibition, usually competitive, of farm products, livestock, etc, often combined in the U.S. with entertainment and held annually by a county or state. ... 3. an exposition in which different exhibitors participate, sometimes with the purpose of buying or selling..."

In connection with registrant's services, the word "fair" is likely to be perceived as meaning only the exhibition; whereas, in connection with applicant's services, the word is likely to be perceived as having either or both connotations -- an honest deal and/or an exhibition of products.

We find that the marks are identical or virtually identical in terms of sound, appearance, connotation and overall commercial impression.

We turn to a consideration of the involved services. Applicant's identified services are "automobile dealership

⁶ See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12 (2d ed. rev. 2004).

services featuring new or nearly new automobiles, but excluding the offering for sale or exhibition of custom, collector, or specialty cars or trucks." The registrant's services are "conducting exhibitions in the field of custom, collector and specialty cars and trucks, and car parts."

The arguments of the Examining Attorney regarding the relatedness of the services evolved during the prosecution of the application. The most relevant evidence submitted by the Examining Attorney in support of her position that these services, as identified, are related within the meaning of the Trademark Act is that submitted with the Office action dated May 17, 2004, in which applicant's Section 2(f) claim of acquired distinctiveness was accepted, the refusal under Section 2(e)(1) was withdrawn, and the finality of the Section 2(d) refusal was reinstated. The Examining Attorney stated therein that automobile dealerships featuring new and nearly new cars (excluding custom, collector or specialty cars and trucks) and exhibitions in the field of custom, collector or specialty cars and trucks "are very closely related automobile sales and exhibition services for which a connection will be presumed on behalf of the relevant consumer"; and that "dealerships often sponsor car

exhibitions in trade" and the automobile dealerships "exhibit" new models to consumers. The Examining Attorney argued in her brief on appeal that the term "exhibitions" in the cited registrations is a broad term that includes trade exhibitions for the sale of custom or collector cars.

The problem with the Examining Attorney's evidence (printouts of pages from several websites) is that there is little evidence that automobile dealerships themselves sponsor car exhibitions particularly under the dealership name or mark. Rather, much of the evidence indicates that automakers such as Daimler Chrysler, General Motors, Toyota, and Volvo sponsor and/or participate in major "auto shows" and the launch of new automobiles, or that several auto clubs such as Stallion's Gate Mustang and Ford Club of Chicagoland, All American Corvette Club, Buick Club of America and Mustang Club of America, sponsor (through local chapters) car shows (presumably of the brand named and of collector cars). Further, a few of the websites indicate that a particular automobile dealership either was a secondary co-sponsor of a car show event (Arlington Heights Ford for the one-day All Ford Powered Annual Car Show in the Chicago area), or that it was the co-sponsor of a general fair (such as Auto Way Ford Lincoln Mercury for the Hernando County (Florida) Fair and Youth Livestock Show).

This evidence is insufficient to establish that any exhibitions of custom, collector and specialty cars that may be co-sponsored by an automobile dealership use the same mark that is used to identify the dealership services. Further, the mere fact that an automobile dealership may be a co-sponsor of such an exhibition, does not mean that the exhibition service is related to the dealership service. For example, a beverage company may co-sponsor an automobile exhibition, but beverages would not be considered related to automobile exhibition services. The Examining Attorney's evidence simply does not establish that consumers are likely to believe that the respective services are related.

While the Examining Attorney contends that there is a direct and close relationship between applicant's new car automobile dealerships and the registrant's specialty automobile exhibitions as "both [involve] a type of automobile sales..." (brief, unnumbered page 8), there is very little evidence of any such understanding by consumers as between conducting exhibitions of custom, collector and specialty cars, on the one hand, and applicant's automobile dealerships services, on the other.

Simply put, we cannot conclude from the evidentiary record furnished by the Examining Attorney that automobile

dealership services and the service of conducting exhibitions of custom, collector and specialty cars emanate from a single source under the same mark, such that the consumers of these services would assume a common source. See *Chrysler Corp. Silva*, 892 F.Supp. 321, 36 USPQ2d 1120 (DC MA 1995)(the district court denied plaintiff's request for a preliminary injunction as plaintiff failed to establish likelihood of confusion between its DODGE VIPER car and defendant's MONGOOSE custom-built car); rev'd in part, aff'd in part, 118 F.3d 56, 43 USPQ2d 1375 (1st Cir. 1997); and *LHD Enterprises Inc. v. Austin Rover Group Ltd.*, ___ F.Supp. ___, 3 USPQ2d 1226 (ND CA 1987). See also, *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Moreover, for the same reasons, the record does not establish that automobile dealership services are within the natural scope of expansion of conducting exhibitions of custom, collector and specialty cars or that purchasers would generally expect these particular services to emanate from the same source. See *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992).

As a result, even though the involved marks are identical or virtually so, this ex parte record does not support a finding that the contemporaneous use of the mark

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AUTOFAIR by applicant for its automobile dealership services as identified and registrant's use of the mark (in standard character form as well as stylized lettering) for conducting exhibitions in the field of custom, collector and specialty cars and trucks is likely to cause confusion.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed as to both of the cited registrations.