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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Automotive Parts Association

Serial No. 76/175,910

Daniel M. Riess of Cook, Alex, McFarron, Manzo, Cummings & Mehler for applicant.

Jeffrey S. Molinoff, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Quinn, Hairston and Walters, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by National Automotive Parts Association to register the mark NAPA AUTOCARE "PEACE OF MIND" for "business management supervision in the administration of warranties made by independent dealers in the field of motorized vehicle repair."¹

¹ Application Serial No. 76/175,910, filed December 5, 2000, alleging first use anywhere and first use in commerce on January 1, 1994. Applicant has claimed acquired distinctiveness under Section 2(f) of the Trademark Act as to "Autocare." Applicant

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The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the following previously registered marks, both owned by the same entity, as to be likely to cause confusion:



Both marks are for "vehicle repair and maintenance services performed at applicant's automobile dealership" (in International Class 37); "automobile, van and truck leasing

claims ownership of Registration Nos. 1,782,992; 1,868,696; and others.

services" (in International Class 39); and "automobile dealership services" (in International Class 42).²

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney filed briefs.³ An oral hearing was not requested.

Applicant argues that the common portion of the marks, "PEACE OF MIND," is "not only highly suggestive of the services of the applicant and the cited registrant, but is so diluted and common in use as to preclude perception by purchaser's [sic] as distinguishing source." [emphasis in original]. In support of applicant's principal argument, applicant submitted a Dialog electronic printout of third-party registrations for marks which include the term "peace of mind" as a portion thereof; photocopies of these third-party registrations retrieved from the U.S. Trademark Electronic Search System (TESS); Internet hits for the term "peace of mind" pursuant to searches using www.google.com; and printouts of lists of articles retrieved from the NEXIS database wherein the term "peace of mind" appeared.

Applicant concludes that the diluted nature of the term

² Registration No. 2,079,108, issued July 15, 1997, and Registration No. 2,081,339, issued July 22, 1997, respectively.

³ Applicant, in its reply brief, refers to an attached "Exhibit J" which apparently is a copy of applicant's website home page. This exhibit is not in the record file. In any event, such submission is untimely and, thus, would not be considered. Trademark Rule 2.142(d).

"peace of mind," coupled with the presence of applicant's widely known and famous house mark "NAPA" together with the term "AUTOCARE," serve to sufficiently distinguish applicant's mark from the cited marks. In urging that the reversal be reversed, applicant addresses the matter of a Board decision involving applicant's earlier attempt to register the same mark for the same services. In that decision the Board affirmed the Section 2(d) refusal based on the same registrations as those involved herein. Applicant essentially contends that the record relative to the common use of the term "peace of mind" is significantly more developed in the present case and that, therefore, a different result is warranted.

The Examining Attorney maintains that the involved marks are similar in that they are dominated by the phrase "PEACE OF MIND." The addition of the house mark "NAPA" and the descriptive term "AUTOCARE" in applicant's mark is, according to the Examining Attorney, insufficient to distinguish it from either of registrant's marks. While the Examining Attorney concedes that the term "peace of mind" is suggestive, he disputes that the term is diluted in the automotive field, pointing to the small number of third-party registrations of marks employing the phrase in the automotive field. Further, the Examining Attorney

contends that the services are closely related and that there is an overlap in classes of consumers therefor. As to the significance of the prior appeal, the Examining Attorney takes the position that the issues are the same, and that the only difference in the present case is that applicant has submitted evidence relating to the purported diluted nature of the phrase "peace of mind" which, the Examining Attorney asserts, does not compel a different result on the merits of the Section 2(d) refusal.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Before turning to the merits of the present appeal, it is helpful to review the Board's determination in the earlier appeal.⁴ As alluded to above, registration was

⁴ Application Serial No. 75/335,792, decided September 13, 2000. The prior decision is not citable as precedent. The decision has been considered, however, in view of the identity of issues between that appeal and the present one. TBMP §101.03.

refused on the bases, inter alia, of the two registrations cited herein. In affirming the Section 2(d) refusals to register, the Board found the services to be related, and the marks to be confusingly similar despite applicant's contention that the commonality of the phrase "peace of mind" in the marks was an insufficient basis for a finding of likelihood of confusion. While the Board found that the phrase might be construed as suggestive of the desired results of the services, the Board stated that "the marks of registrant employing the phrase are neither merely descriptive nor so highly suggestive that the addition of a house mark by applicant would serve to obviate likelihood of confusion." The Board also made the specific remark that the record did not include "any evidence of record that third parties use the phrase such that it has become commonplace in the automotive field."

We first turn to compare applicant's "business management supervision in the administration of warranties made by independent dealers in the field of automotive repair" with registrant's "vehicle repair and maintenance services performed at applicant's automobile dealership; automobile, van and truck leasing services; and automobile dealership services." As is often stated, it is not necessary that the services be identical or even

competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The Board, in the earlier decision, found the services to be "directly related" and to be offered to "the same persons." Applicant's appeal brief is completely silent on this du Pont factor, and applicant has not introduced any evidence to contravene this earlier finding. Indeed, our own assessment is that the services are closely related. Further, the services are offered to the same class of purchasers, namely, ordinary consumers, as is reflected by the specimens of record in the involved application. Thus, we are in complete agreement with the Board's earlier analysis of this factor:

We completely understand that applicant does not itself perform the repair services or extend the warranty related thereto; the independent dealers affiliated with applicant perform these services. Nonetheless, we find the supervision of the

administration of this warranty program which is performed by applicant under the mark sought to be registered to be not only directly related to the warranties but also to be a service which is proffered to the same persons to whom the warranties have been extended. Applicant itself has stated that the specimens indicate to "the ordinary customer" that applicant is involved in the proper management of the warranty program. (Reply brief, p. 3). If the warranty forms submitted are true specimens of applicant's use of its mark, then the services being proffered by applicant under the mark are directed to the same persons to whom the warranties have been made. Applicant's services involve the management of the nationwide warranty program through an administrator such that the warranties made to the purchasers will be fulfilled. Although the independent dealers provide both the repair services and the warranties extended therewith, as the third-party registrations show is often the case, applicant's supervision of the warranty program is inextricably related to these services.

We next turn to consider the marks, and we reach the same conclusion as that of the earlier panel. We begin by noting the general rule that the addition of a house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion. See, e.g.: In *re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986). Exceptions are made to this general rule, however, if (1) there are some recognizable differences in the conflicting

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product marks, i.e., the marks being used for the specific goods or services, or if (2) the product marks are merely descriptive or highly suggestive or play upon commonly used or registered terms, so that the addition of the house mark may be sufficient to render the marks as a whole distinguishable. See: In re Christian Dior, S.A., 225 USPQ 533 (TTAB 1985) and the cases cited therein.

We find, as did the earlier panel, that the phrase or slogan "PEACE OF MIND" is the dominant feature of registrant's marks. The design feature is minimal in Registration No. 2,079,108 and even in Registration No. 2,081,339, the burning log design, although noticeable, would not be the portion which would be relied upon by purchasers in referring to the source of the services. See: In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987) [literal portion generally dominates over design portion]. Further, the term "STANDARD EQUIPMENT" is suggestive when used in connection with services involving automobiles.

That brings us now to the principal thrust of applicant's present attempt to register its mark herein, namely, that there is sufficient evidence in the record (found to be lacking in the first appeal) to support applicant's argument that "PEACE OF MIND" is so commonly

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used that confusion between applicant's and registrant's marks is not likely to occur among purchasers.

After carefully examining the evidence submitted herein that was not of record in the earlier appeal, we nonetheless reach, after balancing the relevant factors, the same result on the merits, that is, there is a likelihood of confusion between applicant's and registrant's marks.

Exhibit A consists of an electronic printout from the Dialog database showing third-party registrations of marks employing the phrase "PEACE OF MIND." Exhibit B consists of copies of the listed registrations. As pointed out by the Examining Attorney, however, few of the registrations cover services that are even minimally related to the automotive repair industry, and none of the registrations covers services that are directly related to the industry. Thus, other than registrant, it would appear that no third-party owns a registration employing the subject phrase in the automotive repair field.

The GOOGLE and NEXIS searches (Exhibits C-G) likewise are of limited value. It is no surprise that there were thousands of hits when the phrase "peace of mind" was searched in connection with discussions about cars. We say this because the phrase is an ordinary figure of speech.

As best we can tell from the short excerpts of record, it would appear that the uses are in the nature of a figure of speech, and not in the nature of a trademark. Thus, we are not convinced by applicant's argument that the "PEACE OF MIND" portion of registrant's marks should be given little weight in comparing the marks on the rationale that purchasers will not perceive the matter to be a source distinguishing feature, but rather will look to other portions of the marks, and will not be confused unless the other portions are similar. Again, while the evidence shows everyday language uses of "peace of mind" in connection with automobiles, the evidence falls short of establishing that purchasers no longer would look to the phrase as a source distinguishing feature.

There is no question but that the phrase "peace of mind" falls within the general vernacular and has a recognized and commonly understood meaning (in this case, of freedom from anxiety or annoyance). However, as pointed out by the earlier panel, so do most words which are used as marks. We do not find that applicant's evidence establishes that the phrase is merely descriptive of the services involved herein. Although the phrase "peace of mind" may be suggestive of the desired results of the services, the marks of registrant employing the phrase are

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neither merely descriptive nor so highly suggestive that the addition of applicant's house mark NAPA and the descriptive term AUTOCARE in applicant's mark serves to avoid likelihood of confusion.

To the extent that any of the points argued by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decisions: The refusals to register are affirmed.