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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Independent Media Marketing, Inc.

Serial No. 76411149

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Before Hanak, Hairston, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 23, 2002, applicant (Independent Media Marketing, Inc.) applied to register the mark WARD LAFRANCE (in typed form) on the Principal Register for goods identified as "fire trucks and fire truck parts, namely, body structural parts for fire trucks" in International Class 9.[1]

[1] Serial No. 76411149. The application contains an allegation of a date of first use anywhere and a date of first use in commerce of 1979.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of five prior registrations, owned by the same registrant, American LaFrance Corporation, for the marks shown below:

for "fire trucks and fire truck parts, namely, body structural parts for fire trucks" in International Class 9.[2] The second registration is for the mark AMERICAN LAFRANCE EAGLE (typed) for "fire trucks and fire truck parts, namely, cabs, chassis, and body structural parts for fire trucks" in International Class 9.[3] The third registration is for the mark AMERICAN LAFRANCE (typed) for "trucks parts and components, namely, cabs, chassis, and body structural

[2] Registration No. 2,201,823, issued November 3, 1998. The registration includes a Section 2(f) claim of acquired distinctiveness for the term "American."
[3] Registration No. 2,419,377, issued January 9, 2001. The registration includes a Section 2(f) claim of acquired distinctiveness for the term "American."

parts" in International Class 12.[4] The fourth registration is for the mark shown below:

for "fire engine trucks comprising pumping engines and ladders" in International Class 12.[5] The final registration is for the mark AMERICAN LAFRANCE for "engine driven fire apparatus" in, inter alia, International Class 9.[6]

The examining attorney's position (Brief at 5) is that the goods are identical and that "the dominant portion of the applicant's mark, LAFRANCE, is identical to that of the marks in the cited registrations." Applicant argues (Brief at 3) that "fire engines and their replacement parts are obviously very high-priced items." Applicant also maintains that: "It is possible that the average individual on the street may believe that there is some connection between AMERICAN LAFRANCE and WARD LAFRANCE… To

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[4] Registration No. 2,201,732, issued November 3, 1998. The registration includes a Section 2(f) claim of acquired distinctiveness for the term "American."
[5] Registration No. 966,004 issued August 14, 1973, second renewal.
[6] Registration No. 693,670 issued March 1, 1960, second renewal. These goods remain after other goods were deleted.

persons who normally purchase, repair and utilize fire engines, they would clearly know the distinction between AMERICAN LAFRANCE and WARD LAFRANCE." Id.

When the refusal was made final, applicant filed this appeal.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start our analysis by looking at the similarity or dissimilarity of the goods. Applicant's goods are fire trucks and fire truck parts, namely, body structural parts for fire trucks. This identification of goods is identical

to the goods in the '823 registration.[7] We observe that the goods are at least in part identical with the goods in the '377 registration to the extent that they include fire trucks and body structural parts for fire trucks. Applicant's fire trucks and fire truck parts are also either identical or related to the goods in the '004 (fire engine trucks comprising pumping engines and ladders), '732 (truck parts and components), and '670 (engine driven fire apparatus) registrations. Our primary reviewing court has held that when the goods are identical, "the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Next, we consider the similarities and dissimilarities of the marks in the application and registrations. Applicant's mark is WARD LAFRANCE. All of registrant's marks contain the words AMERICAN LAFRANCE. Two registrations are for the words alone ('732 and '670), two add an eagle design ('004 and '698) and one ('377) adds the word "eagle." Comparing the marks WARD LAFRANCE and

[7] Applicant "essentially borrowed the [description of the goods] directly from the AMERICAN LAFRANCE registrations." Response dated March 26, 2003 at 4.

AMERICAN LAFRANCE, there are obvious differences and similarities. Both contain the same second word LAFRANCE and a different initial word, WARD and AMERICAN. The Federal Circuit addressed a somewhat similar case recently when applicant sought to register the mark JOSE GASPAR GOLD for tequila and the mark GASPAR'S ALE for beer and ale was cited as a bar to registration. In re Chatam International Incorporated, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004). The Court held that "[w]ith respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." Chatam, 380 F.3d at 1343. See also Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989) (VITTORIO RICCI and NINA RICCI are similar).

In this case, applicant has indicated that "Ward" was the first name used by the founder of the original Ward LaFrance Truck Company. See *Sunday Telegram (Elmira, New York)*, March 12, 1972 ("Mr. LaFrance (he never used his first name, preferring instead 'A. Ward" or "Ward" as his friends called him) established the Elmira Heights fire truck company which bears his name"). Registrant's marks do not include a first name, instead those marks include

the geographical term “American.” Three registrations (‘823, ‘377, and ‘732) contain a claim of acquired distinctiveness for this term. It is unlikely that prospective purchasers would focus on this term, which is geographically descriptive, as the dominant part of the marks. In America, the use of the word “American” would hardly be unusual.

We also note that registrant has one registration that adds the word “Eagle” and two that add an eagle design to the mark AMERICAN LAFRANCE. “[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 position of the mark is the one most likely to indicate the origin of the goods to which it is affixed.” CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983). We do not view that the addition of either the design of an eagle or the word “eagle” would make the marks dissimilar. While the term and the design would be observed, they would not lead people to conclude that the goods come from different sources.

Thus, when we compare the mark WARD LAFRANCE with the AMERICAN LAFRANCE marks, the identical term LAFRANCE would dominate the marks. The marks’ similarities in sound,

appearance, meaning, and commercial impression would outweigh the differences. Therefore, a significant number of potential purchasers are likely to assume that there is some connection or association between the sources of the goods.

Applicant makes two additional points to support its conclusion that confusion is unlikely.

Applicant's first point (Brief at 2) concerns the history of the marks.

> By way of background, Truckson LaFrance formed the LaFrance Manufacturing Company in Elmira, New York in 1873 to make fire engines. Around the turn of the century, that company became known as American LaFrance.
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> Addison Ward LaFrance began working for his uncle, Truckson, at American LaFrance in the early 1900's. In 1918, Addison Ward LaFrance formed a company in Elmira, New York which he named LaFrance Truck Mfg. Company.
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> Initially, the similarity in names caused some confusion. At a meeting between the companies, it was agreed that Ward would change the name of his new company to Ward LaFrance Truck Company.
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> The two companies competed for almost 60 years. And while new WARD LAFRANCE fire trucks were not made sometime after the late 1970's, existing WARD LAFRANCE fire trucks are still in operation and replacement parts have always been available under the name WARD LAFRANCE.

Despite this period of apparent co-existence between registrant and the Ward LaFrance Truck Company, applicant has not included evidence of any consent agreement to

register the mark WARD LAFRANCE. There is a difference between the right to register the mark WARD LAFRANCE and the right to use the trade name Ward LaFrance Truck Company and any related trademarks. Furthermore, applicant admits that production of new WARD LAFRANCE trucks ceased in the late 1970's, and there is no evidence as to whether applicant succeeded to any rights owned by the original Ward LaFrance Truck Company.[8]

Also, we have no information as to the extent of registrant's and applicant's current use of the marks in terms of units sold, dollar amount of sales, and advertising. Except for applicant's specimen of use, which consists of a return address mailing label, the evidence of the use of the mark WARD LAFRANCE appears to be by the Ward LaFrance Truck Company more than thirty-five years ago. There is no evidence of the extent that applicant and registrant currently co-exist in the marketplace. Therefore, applicant has failed to demonstrate that, if there was a period of co-existence in the past between registrant and the Ward LaFrance Truck Company, it is relevant to applicant's attempt to register its mark today.

Second, applicant argues (Brief at 3) that:

[8] The present application contains a date of first use in commerce "by a predecessor in interest" in 1979.

> Fire engines and their replacement parts are obviously very high-priced items. Furthermore, they are purchased by a very limited class of consumer. While the name may be of some significance, Appellant suggests that it is not the major factor when a fire company purchases a fire engine. These are not impulse items where people will purchase the products solely based on the trademark. Rather, a municipality buying a fire engine will fully investigate the features of the fire engine and numerous other factors before purchasing the same.

The problem with applicant's argument is that we have little evidence of the state of the current market for fire engines and parts. It is likely that the purchasers here are careful and highly sophisticated purchasers. However, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). In addition, it is not apparent that these purchasers would be aware of the previous, apparent co-existence of the LAFRANCE marks that stopped when the Ward LaFrance Truck Company ceased operations thirty-five years ago. Many purchasers now would likely believe that there was some relationship or association between fire engines that are sold under applicant's and registrant's marks.

Decision: The examining attorney's refusal to register under Section 2(d) of the Trademark Act is affirmed.