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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Parker-Hannifin Corp.

Serial No. 76630399

John H. Weber of Baker & Hostetler LLP for Parker-Hannifin Corp.

Nelson B. Snyder III, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Seeherman, Hairston and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Parker-Hannifin Corp. (applicant) has applied to register the mark shown below for "land vehicle automatic transmission parts, namely, heavy duty clutches, passenger car clutches, medium duty truck clutches, high performance clutches, disc clutches, clutch covers, clutch pilot bearings, clutch pilot bushings, clutch master cylinders, and clutch slave cylinders; brake hardware for land vehicles, namely, automatic slack adjusters, brake pads,

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brake shoes, brake drums, brakerotors, and brake calipers”
in International Class 12.¹

PROSELECT

The Examining Attorney has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Registration No. 3071928 for the mark PROSELECT in standard characters for “air, oil and fuel filters for vehicles” in International Class 7. The cited registration issued on March 21, 2006. Applicant has appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

LIKELIHOOD OF CONFUSION

Section 2(d) of the Trademark Act precludes registration of an applicant’s mark “which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion...” 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476

¹ Application Serial No. 76630399, filed February 7, 2005, claiming first use of the mark anywhere and first use of the mark in commerce on December 31, 1999.

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F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Below we will consider each of the factors as to which applicant or the Examining Attorney presented arguments or evidence.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

With regard to the marks, applicant argues, "The Registrant's mark is PROSELECT without any stylization of the words, whereas Applicant's mark emphasizes the prefix "PRO" such that the Applicant (sic) creates a different commercial impression despite (sic)." Applicant's Brief at unnumbered pages 2-3. With regard to the cited registered

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mark applicant also argues, "The Registered mark consists of a single term PROSELECT, which joins 'Pro' meaning professional, and 'Select' suggesting that the goods are the choice of professionals. Consequently, the mark is extremely suggestive and therefore weak, entitling the registration to only a narrow scope of protection." *Id.* at unnumbered page 6.

On the other hand, the Examining Attorney argues, "Contrary to Applicant's arguments, its mark, 'ProSELECT' (stylized) is identical in sound and commercial impression, and is virtually identical in appearance to the registered mark 'PROSELECT.'" In this case the parties' marks share identical wording. There is no other wording or design elements present with which to distinguish the marks." Examining Attorney's Brief at unnumbered page 4.

We concur with the Examining Attorney. In fact, we conclude that the marks are legally identical. As the Examining Attorney correctly points out, the cited registered mark is presented in standard characters, and consequently, the registration covers PROSELECT in all manners of display within reason. 37 C.F.R. § 2.52(a). *See In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991). The presentation of applicant's mark in this case is well within that scope. Applicant's mark is simply the

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stylized display of the entire mark in the cited registration, without any further distinguishing literal or design elements. There is no meaningful difference between the marks in appearance, sound, connotation or commercial impression.

As we noted, applicant also asserts that the cited registered mark is suggestive, and therefore, weak. We accept applicant's explanation that PROSELECT is a "telescoped" form of "professional" combined with "select." We also accept applicant's characterization of PROSELECT as a suggestive term, though we note that applicant has not submitted any evidence to show to what extent, if any, third parties may have used PROSELECT as a mark. However, even a highly suggestive mark is entitled to protection. *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439, 42 (TTAB 1976). Here, while we find PROSELECT is suggestive, we do not find it to be *highly* suggestive. In a case such as this where the marks are legally identical and there is no other element to distinguish the marks, the registered mark is certainly entitled to protection. *Id.* at 1389. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005).

Accordingly, we conclude that the marks are legally identical and that the registered mark, though suggestive, is entitled to protection.

The Goods and Channels of Trade

We begin our consideration of the goods by noting that, "... in a situation such as this, where both parties are using the identical designation ... the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

Furthermore, as a general proposition the goods of applicant and the registrant need not be identical to find a likelihood of confusion under Trademark Act Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from or are associated with the same source. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The goods identified in the application are "land vehicle automatic transmission parts, namely, heavy duty clutches, passenger car clutches, medium duty truck

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clutches, high performance clutches, disc clutches, clutch covers, clutch pilot bearings, clutch pilot bushings, clutch master cylinders, and clutch slave cylinders; brake hardware for land vehicles, namely, automatic slack adjusters, brake pads, brake shoes, brake drums, brakerotors, and brake calipers." The goods identified in the cited registration are "air, oil and fuel filters for vehicles."

Applicant argues that there are technical and functional differences between its goods and those in the cited registration. Applicant states, "To hold that the Applicant's goods are related to the Registrant's goods so as to cause confusion simply because both may be classified under the extremely broad heading of automotive parts, would be to grant the owner of the registered mark an overly broad scope of protection." Applicant's Brief at 5. Applicant has not discussed any of the evidence the Examining Attorney submitted to establish that the goods identified in the application and the cited registration are related.

On the other hand, the Examining Attorney argues that the goods are related, and the Examining Attorney has submitted evidence to support his position, including numerous use-based, third-party registrations for marks for

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both the types of goods identified in the application and the types of goods identified in the cited registration, as well as excerpts from Internet web sites of entities which offer both types of goods for sale under one mark. See Attachments to Final Office Action.

The use-based, third-party registrations include the following: Registration No. 1572864 for goods including oil filters, air filters, and disc brake pads; No. 1173921 for goods including disk brake pads, oil filters and air filters; No. 1413975 for goods including clutch bearings, clutches and structural parts, and fuel oil filters; No. 1564166 for goods including clutches and clutch discs and parts therefor, air, oil and fuel filters for land vehicle engines; No. 2045412 for goods including air filters, oil filters, fuel filters, brake shoes, brake cylinders, brake linings, brake hardware, brake valves and clutches; No. 2075452 for goods including oil and air filters for automotive use, brake pads, brake rotors, clutch cables and clutch discs; No. 2360510 for goods including air, oil and fuel filters, brake linings, brake shoes, brake cylinders, brake calipers and pads therefor; and No. 2471866 for goods including brake linings, brake cylinders, clutches, and air filters for engines. These examples are but a small but

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representative sample of more than forty third-party registrations in the record.

These registrations provide some evidence that the goods in the application and the goods in the cited registration are the types of goods which may emanate from the same source. *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1659 (TTAB 2002); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The Examining Attorney has also provided excerpts from Internet web sites showing entities in the vehicle and engine parts business which offer both types of goods, and generally under the same mark, including: pepboys.com offering brake pads, brake shoes and oil filters; napaonline.com offering clutch discs, brake calipers, oil, air and fuel filters; and a record from google.com showing a catalog from *American Pony Parts* offering clutch and brake parts, as well as fuel filters.

As we noted, applicant has addressed neither the third-party registrations nor the Internet evidence in its arguments. Based on the evidence of record, in particular, the Internet evidence and the third-party registrations, we conclude that the goods in the application and the goods in the cited registration are related and that they move in the same channels of trade to the same potential

purchasers. The evidence contradicts applicant's claim that the Examining Attorney has taken unrelated goods and found them related because they are "... classified under the extremely broad heading of automotive parts." The evidence indicates that, even though the respective goods may be technically and functionally different, the types of goods in question are generally placed in the same category for sale as commercially related products.

Conditions of Sale

Applicant also argues that, "The consumers who will use and purchase Applicant's goods are sophisticated purchasers who will be using the goods to assist their customers in fixing complicated automatic transmissions and brakes. Since automatic transmissions and braking systems are fairly complicated, it is unlikely that the average consumer will engage in the complex vehicle transmission and brake repair. In comparison, the average consumer often change (sic) their own air, oil and fuel filters ..." Applicant's Brief at 4. Applicant appears to argue that its customers are professional mechanics who will not be confused because they are sophisticated purchasers whereas the purchasers of the goods identified in the cited registration may include less sophisticated individuals. We find applicant's arguments here unpersuasive. While

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some of the potential purchasers of applicant's goods may be sophisticated mechanics, the purchasers for at least some of applicant's goods, for example, brake pads, could include individuals who are not professional mechanics. More importantly, again in a case such as this where the marks are legally identical, we conclude that sophistication of the purchasers would not diminish the likelihood of confusion, whether the purchasers are professional mechanics or others. As the Examining Attorney points out, even sophisticated purchasers are not immune from trademark confusion. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

CONCLUSION

Finally, based on all evidence of record in this case related to the *du Pont* factors, we conclude that there is a likelihood of confusion between applicant's stylized ProSELECT mark when used in connection with "land vehicle automatic transmission parts, namely, heavy duty clutches, passenger car clutches, medium duty truck clutches, high performance clutches, disc clutches, clutch covers, clutch pilot bearings, clutch pilot bushings, clutch master cylinders, and clutch slave cylinders; brake hardware for land vehicles, namely, automatic slack adjusters, brake pads, brake shoes, brake drums, brakerotors, and brake

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calipers" and the cited PROSELECT mark when used in connection with "air, oil and fuel filters for vehicles."

Decision: We affirm the refusal to register the mark under Trademark Act Section 2(d).