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Mailed: June 18, 2003
Paper No. 13
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sprint Lube Corporation

Serial No. 78/025,917

Jeffrey M. Furr for Sprint Lube Corporation.

Susan C. Hayash, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Applicant has applied to register the mark YOUR OWN
PERSONAL PIT CREW for services which were subsequently
identified as "retail store services featuring motor oil,
automobile fluids, automobile filters and automobile
lubricants" in Class 35 and "vehicle preventive maintenance
services, namely, changing motor oil, changing oil and air

filters" in Class 37.¹ During the course of prosecution, apparently in an attempt to overcome a likelihood of confusion refusal, applicant offered a voluntary disclaimer of the words PIT CREW. The Examining Attorney advised applicant that, although the Office accepts voluntary disclaimers, such a disclaimer was not necessary, and applicant had the right to withdraw the disclaimer. Applicant did not withdraw the disclaimer, and it therefore remains of record.

Registration has been finally refused on three bases: 1) applicant's mark is likely to cause confusion with the mark PIT CREW, previously registered for "mobile automobile maintenance services"² [Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d)]; 2) applicant's specimens do not show use of the mark depicted on the drawing; and 3) applicant's specimens do not show use of the mark for the identified services in Class 35--retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants.³

¹ Application Serial No. 78/025,917, filed September 14, 2000, based on claimed dates of first use and first use in commerce on June 1, 1997.

² Registration No. 1,812,418, issued December 21, 1993; Section 8 affidavit accepted; Section 15 affidavit received.

³ Registration had also been refused on the ground of likelihood of confusion with Registration No. 1,967,192. However, this registration was cancelled for failure to file a Section 8

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

We turn first to the refusal on the basis that applicant's specimens do not show use of the mark which is depicted in the drawing of the application. The Examining Attorney contends that YOUR OWN PERSONAL PIT CREW appears in the specimens as part of the phrase IT'S LIKE HAVING YOUR OWN PERSONAL PIT CREW, with all the words shown in the same font type and stylization. Applicant does not address this refusal at all in its appeal brief (and did not file a reply brief), but in its response filed on September 5, 2001, applicant states that the additional words "are more part of the background."

Trademark Rule 2.51(b)(1) provides, in part, that "the drawing of a service mark shall be a substantially exact representation of the mark as used in the sale or advertising of the services." The designation for which registration is sought must comprise a separate and distinct trademark in and of itself. **The Institut National des Appellations D'Origine v. Vintners International Co. Inc.**, 954 F.2d 1574, 22 USPQ2d 1190 (Fed Cir. 1992) Our determination of whether YOUR OWN PERSONAL PIT CREW

affidavit shortly after applicant filed its appeal brief. As a result, the Examining Attorney withdrew this refusal.

presents a separate and distinct commercial impression must be based on the specimen of record, which is reproduced below. Our determination of this issue must necessarily be subjective.



In this case, we find that YOUR OWN PERSONAL PIT CREW does make a separate and distinct commercial impression. Although the phrase IT'S LIKE HAVING is depicted in the same type font, it is in a smaller size lettering than the words YOUR OWN PERSONAL PIT CREW, and it appears on a separate line. Compare **In re Miller Sports Inc.**, 51 USPQ2d 1059 (TTAB 1999), in which the letter "M" with a skate

design was found to be an integral part of the word MILLER. The darker line in which the words YOUR OWN is written, rather than the outlining that appears in IT'S LIKE HAVING, further visually differentiates these two phrases.

Although we acknowledge that these differences are very subtle, in this particular situation we find it to be sufficient for YOUR OWN PERSONAL PIT CREW to create a separate commercial impression. Accordingly, the refusal of registration on the basis that the specimens do not support use of the mark depicted in the drawing is reversed.

The next refusal also involves applicant's specimens, specifically, whether the specimen of record shows use of the mark for the services in Class 35. Those services are identified in the application as "retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants." Applicant's specimen makes no mention of such services. Rather, it refers to "Quality & Value in an Oil Change" and "Full Service Oilube," which are references to applicant's vehicle preventive maintenance services in Class 37. Applicant did not discuss the requirement for acceptable Class 35 specimens in its appeal brief, and as mentioned previously, applicant did not file a reply brief, even though the Examining

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Attorney pointed out, in her brief, that applicant had not addressed this issue.

We agree with the Examining Attorney that applicant's specimen of record does not show use of the mark in connection with retail stores services featuring motor oil, automobile fluids, automobile filters and automobile lubricants. Accordingly, we affirm the refusal of registration on this basis with respect to the application in Class 35.

This brings us to the refusal based on the ground of likelihood of confusion. In order to render a complete decision, for purposes of considering this issue we will assume that applicant's specimen with respect to its Class 35 services is acceptable.

The Examining Attorney asserts that applicant's mark YOUR OWN PERSONAL PIT CREW so resembles the registered mark PIT CREW for mobile automobile maintenance services that, as used in connection with its identified services, it is likely to cause confusion or mistake or deception. Our determination of this issue 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). In any likelihood of confusion analysis, two key considerations are the

similarities between the marks and the similarities between the goods or services. See **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the services, applicant's Class 37 services--vehicle preventive maintenance services, namely, changing motor oil, changing oil and air filters--are legally identical, in part, to the registrant's identified "mobile automobile maintenance services." Registrant's automobile maintenance services would include the same preventive maintenance services specified in applicant's application, and the only difference is that registrant's services are rendered through a mobile facility, while applicant's are presumably rendered in a fixed establishment. Even though the services may be rendered through different channels of trade, the class of customers for the services--automobile owners--are the same, and they may encounter both applicant's preventive maintenance services under the YOUR OWN PERSONAL PIT CREW mark and the registrant's automobile maintenance services under the PIT CREW mark.

As for applicant's Class 35 services--retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants, although these services are not identical to the registrant's identified services,

they need not be in order to support a holding of likelihood of confusion. It is not necessary that the services of the parties be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the 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. See **In re International Telephone & Telegraph Corp.**, 197 USPQ 910 (TTAB 1978).

Applicant's retail store services featuring motor oil, automobile fluids, automobile filters and automobile lubricants are complementary with the mobile automobile maintenance services identified in the cited registration. The same products which are sold through applicant's retail store services would be used in connection with mobile automobile maintenance services. Moreover, it is common knowledge that many service stations that perform automobile maintenance services also offer retail store services selling automotive products such as motor oil. Thus, if the same or a confusingly similar mark were to be used in connection with both mobile automobile maintenance

services and retail store services featuring motor oil and other automotive products, consumers are likely to believe that the company offering mobile automobile maintenance services has opened a retail store or, conversely, that the retail store is offering mobile automobile maintenance services.

This brings us to a consideration of the marks. Although there are minor differences between the marks because applicant's mark has the additional words YOUR OWN PERSONAL appearing before PIT CREW, we do not regard these differences as sufficient to distinguish the marks. The term PIT CREW remains the same in appearance, pronunciation and connotation in both marks, and the additional words YOUR OWN PERSONAL, while modifying PIT CREW, do not diminish the effect of PIT CREW in applicant's mark.

While the differences in the marks can be detected when they are placed side-by-side, under actual marketing conditions purchasers ordinarily would not have this luxury, so they must rely upon past recollections, which are usually hazy. **Dassler KG v. Roller Derby Skate Corporation**, 206 USPQ 255 (TTAB 1980). As a result, they are likely to remember the PIT CREW portion of applicant's mark, rather than the entire phrase YOUR OWN PERSONAL PIT CREW, because it is this portion that makes the greater

impression. Customers are likely, when referring to applicant's mark, or in word-of-mouth recommendations of applicant's services, to shorten the mark to PIT CREW. Certainly the converse would not occur; no one would use the introductory words YOUR OWN PERSONAL without the term PIT CREW. Although marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We recognize that applicant has chosen to disclaim the words PIT CREW, despite the Examining Attorney's statement that such a disclaimer was not necessary. This disclaimer has no effect in the likelihood of confusion analysis. It does not turn PIT CREW into a descriptive term, nor does it eliminate this portion of the mark from consideration.

Even if consumers note and remember the additional words YOUR OWN PERSONAL in applicant's mark, they are not likely to ascribe the differences between YOUR OWN PERSONAL PIT CREW and PIT CREW to differences in the source of the respective services. Rather, they are likely to assume that these are variant marks for services which emanate from the same source.

Applicant has argued that the common element of the marks--PIT CREW--is weak. Although PIT CREW has a somewhat suggestive connotation with respect to automotive maintenance and other services, in that a "pit crew" provides maintenance services to race car drivers during a race, the term is not as weak as applicant contends. Certainly the scope of protection of the cited registration would extend to prevent the registration of YOUR OWN PERSONAL PIT CREW for identical and closely related services. Nor do we believe, as discussed above, that consumers would look to the phrase YOUR OWN PERSONAL to distinguish applicant's mark from the registrant's.

Applicant has pointed to the fact that, until recently, the cited mark, PIT CREW, coexisted on the Register with Registration No. 1,967,102 for PIT CREW for, inter alia, penetrating oil for releasing corroded and rusted parts and automotive lubricants and brake cleaner, carburetor cleaner, and battery cleaner.⁴ This single third-party registration does not persuade us that PIT CREW is so highly suggestive that the protection of the cited registration should be highly circumscribed. Nor is this registration evidence of use of the mark, such that the

duPont factor of "the number and nature of similar marks in use on similar goods or services" would favor applicant. On the contrary, the fact that this registration was cancelled because of the registrant's failure to file a Section 8 affidavit of use suggests that the mark may no longer even be in use.

Nor does the fact that this registration was allowed to register despite the existence of Registration No. 1,812,418 compel the registration of applicant's mark.⁵ We do not know what led to the Examining Attorney's decision to allow Registration No. 1,967,192. For example, there may have been a consent agreement that was found persuasive. In any event, the Board must decide each case on its own merits. The PTO's allowance of a prior registration does not bind the Board. See **In re Nett Designs**, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Applicant asserts that the buyers of applicant's services are "more than sophisticated" because the services

⁴ As noted previously, this registration, which had originally been cited against applicant's application, was cancelled for failure to file a Section 8 affidavit of use.

⁵ Registration No. 1,967,192 is the only third-party registration for a PIT CREW mark that is of record. Applicant has made reference to "almost five hundred registered and applied for marks that have the word sprint in them for various goods and services." Brief, p. 7. Any such registrations or applications for SPRINT marks are irrelevant to the question of likelihood of confusion between applicant's mark and the cited registration.

are "for one of the major assets that a buyer owns."
Brief, p. 5. Although the purchase of an automobile would be made with great care, the same does not hold true when one chooses a retail outlet in which to buy motor oil, for instance, or when one selects an establishment to have a car's motor oil changed. Thus, we are not persuaded that the selection of the service provider would necessarily be made with care; certainly the purchasers of such services, automobile owners, would not be regarded as sophisticated. Members of the general public are not likely to carefully examine the differences between the marks PIT CREW and YOUR OWN PERSONAL PIT CREW, and explore whether the marks indicate different sources of the services. Rather, as we stated previously, if they take note of the differences in the marks at all, they will simply assume that they both indicate that the respective services emanate from a single source.

With respect to the factor of fame, applicant has stated that it believes that its mark "has become distinctive of Applicant's services through Applicant's substantially exclusive and continuous use thereof in commerce for the past years [since 1999]." Brief, p. 5. This language, which is used to claim acquired distinctiveness in order to obtain a registration pursuant

to Section 2(f) of the Trademark Act, is inapposite here, where registration has not been refused on the ground that applicant's mark is merely descriptive. A Section 2(f) claim cannot be used to overcome a refusal based on likelihood of confusion under Section 2(d) of the Act. In any event, the duPont factor refers to "the fame of the prior mark," not the fame of the mark applicant seeks to register. As in most ex parte situations, we have no evidence as to the fame of the cited mark. Thus, this factor is neutral.

Applicant also asserts that it has been using the mark YOUR OWN PERSONAL PIT CREW "for the past years" without any actual confusion between it and the mark PIT CREW. Brief, p. 5. However, applicant has not provided any evidence about the extent of its use, so we cannot ascertain whether there has been an opportunity for confusion to occur if it were likely to occur. Moreover, we do not know what the registrant's experience as to confusion may be. Thus, we cannot view this factor as favoring applicant.

In conclusion, we find that, upon a review of the relevant duPont factors, the Office has met its burden of proving that confusion is likely between applicant's mark as used in connection with its identified services and the

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cited registration. Accordingly, the refusal is affirmed on this ground.

Decision: The refusal on the ground of likelihood of confusion is affirmed with respect to the application in Classes 35 and 37; the requirement for specimens showing use of the mark in connection with the Class 35 services is affirmed; and the requirement for specimens showing use of the mark as depicted in the drawing is reversed.