

THIS OPINION IS NOT  
A PRECEDENT OF THE  
TTAB

Mailed:  
14 August 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Versus Trading Company, Inc.

---

Serial No. 78262569

---

Charles R. Sutton of the Sievers Law Firm for Versus  
Trading Company, Inc.

Tracy Cross, Trademark Examining Attorney, Law Office 109  
(Dan Vavonese, Managing Attorney).

---

Before Drost, Kuhlke, and Wellington, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 15, 2003, applicant Versus Trading Company,  
Inc. applied to register the mark VERSUS MOTORSPORT (in  
typed or standard character form) on the Principal Register  
for services identified as "distributorship and retail  
store services in the field of vehicle parts and  
accessories" in Class 35. The application (Serial No.  
78262569) was based on applicant's allegation of a date of  
first use anywhere of December 1, 1993 and in commerce of  
July 1, 1994. Applicant has disclaimed the term

"Motorsport." On February 7, 2005, the Office received applicant's response to an Office action that proposed to amend the application to seek registration on the Supplemental Register and to change the dates of first use anywhere and in commerce to February 1, 1993.<sup>1</sup>

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 a registration for the mark VERSUS,<sup>2</sup> in typed or standard character form, for "wheels for land vehicles" in Class 12.<sup>3</sup>

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

In cases involving a likelihood of confusion refusal (15 U.S.C. § 1052(d)), we consider the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA

---

<sup>1</sup> In her brief (unnumbered pp. 13-14), the examining attorney explained that "the amendment to the Supplemental Register is unacceptable because the proposed mark is clearly capable of registration" on the Principal Register, and "the term VERSUS is not descriptive of the goods/services."

<sup>2</sup> Registration No. 2265157, issued July 27, 1999. Affidavits under Sections 8 and 15 accepted and acknowledged.

<sup>3</sup> The examining attorney also cited a second registration (No. 2363870) for the mark VERSUS CONSPIRED BY RAYS and design for "wheels for land vehicles" in Class 12. This registration was cancelled on April 7, 2007, and therefore, it no longer serves as a bar to registration of applicant's mark.

1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) 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 begin by looking at the first *du Pont* factor. This "factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)). In this case, applicant's mark is VERSUS MOTORSPORT and registrant's mark is VERSUS. Both marks are in typed or standard character form so that there are no differences between the stylization of the marks. Therefore, the marks are similar to the extent that they are for the same word VERSUS, which is the only word in registrant's mark. They

are different because applicant adds the word MOTORSPORT to its mark. We find that that the term "Versus" is the dominant feature in applicant's mark and it is defined as: "against (used esp. to indicate an action brought by one party against another in a court of law, or to denote competing teams of players in a sports contest)." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).<sup>4</sup> While the term may have some suggestive connotations when applied to services associated with motor sports competitions, it does not appear to be merely descriptive of applicant's services and an amendment to the Supplemental Register would not have been appropriate. 15 U.S.C. § 1091(a) ("All marks capable of distinguishing applicant's goods or services and *not registrable on the principal register* herein ..., which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register") (emphasis added).

Applicant argues (Brief at 8) that:

While Appellant's mark implies racing and excitement in connection with [its] services, the cited registrations used in connection with wheels more likely imply something akin to the Latin root of the

---

<sup>4</sup> We take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

word "VERSUS" the past participle of *vertere* (to turn). These marks imply "toward" or "turned toward."

We certainly are skeptical that this Latin meaning would be the understanding of a significant number of potential purchasers. Applicant has presented no evidence on this point, and we instead hold that the word "Versus" in both marks, at least for most purchasers, would have the same meaning.

Regarding the term "Motorsport" in applicant's mark, we cannot find that it would significantly change the meaning of the term "Versus." "Motor sports" are defined as "competitions, esp. races, involving motor vehicles, as automobiles, motorboats, and motorcycles." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). The term "Motorsport" in applicant's mark would suggest that applicant's services are rendered in the field of motor sports. In addition, registrant's identification of "wheels for land vehicles" includes wheels used in motor sports. Therefore, the commercial impressions of the marks VERSUS for wheels for land vehicles and VERSUS MOTORSPORT for services in the field of vehicle parts would be similar. Furthermore, the marks would be similar in appearance and sound to the extent that they are both dominated by the same term "Versus."

We add that we have considered the marks VERSUS MOTORSPORT and VERSUS in their entireties. However, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). When we do consider the marks in their entireties, we conclude that they are similar. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there still was a likelihood of confusion) and *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

Next, we look to see if applicant's services and registrant's goods are related. "[G]oods that are neither used together nor related to one another in kind may still 'be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.'" *Shen*

Ser No. 78262569

*Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350  
(Fed. Cir. 2004) (citing *Recot*, 54 USPQ2d at 1898).

It "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services."

*In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

To demonstrate a relationship between wheels and retail stores services in the field of vehicle parts, the examining attorney submitted copies of several internet printouts. See [www.upgrademotoring.com](http://www.upgrademotoring.com) (Upgrade Motoring - Suspension/Safety/Wheels/Performance/Race Car/Aerodynamics/Accessories). See also [www.enjoythedrive.com](http://www.enjoythedrive.com):

Keystone Automotive Operations Inc. - Warehouse distributor stocking more than 600 product lines, including high-performance, accessories, wheels, automotive parts, truck accessories and import performance

Pro-Am - Retail and mail-order sales of personalized accessories, including Recaro seats, wheels, tires, shocks, trim and Simpson race products.

In addition to the internet evidence, the examining attorney also relied on registrations to suggest that the goods and services are related. See, e.g., Registration Nos. 2302608 (Mail order and retail store services featuring automotive parts and land vehicle parts, namely wheels); 2824520 (retail store services and online retail store services in the field of vehicle parts and vehicle parts and accessories, namely wheels); and 2420691 (motorcycle wheels and retail store services and mail order services in the field of motorcycles and motorcycle parts). Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant argues that the purchasers are "tuner car enthusiasts" (Brief at 9) and that these enthusiasts "are acutely aware of the difference between a set of wheels and part distribution services" (Brief at 10). However, we cannot limit our consideration to any specific type of

purchasers for either wheels or vehicle parts retail store services. Absent restrictions in the identification, we must assume that the goods and services travel in the "normal and usual channels of trade and methods of distribution." *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). See also *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 956 (TTAB 1985).

While applicant attempts to differentiate the products based on applicant's selling its products only through mail orders while opposer's sales of its goods are through ordinary retail channels of distribution, in the absence of a restriction in applicant's identification of goods and in the identification of goods in opposer's registrations, the respective goods must be presumed to travel in all channels of trade suitable for goods of that type.

Neither the application nor the registration limits the identification of goods or services to any type of purchaser or any type of land vehicle wheel. "The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed." *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed.

Cir. 1990). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services).

In a case involving the relationship between goods and services, the Federal Circuit affirmed the board's determination that there was a likelihood of confusion when the goods and services involved the mark "bigg's" (stylized) for "retail grocery and general merchandise store services" and BIGGS and design for furniture.

The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance.

*In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Inasmuch as vehicle wheels are sold in vehicle parts stores, we hold that applicant's vehicle parts retail store services and registrant's vehicle wheels are related.

In addition, we must conclude that the purchasers include all types of purchasers for wheels including car

enthusiasts and ordinary purchasers who are simply seeking to upgrade or change their vehicles' wheels.

Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof.

*In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

See also *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Thus, purchasers would not be limited to sophisticated purchasers. It is likely that the same purchasers would encounter both registrant's mark for wheels and applicant's vehicle parts retail services.

We note that applicant has argued that its "mark has acquired distinctiveness from long and active use in the industry" and that it is "entitled to registration on the Supplemental Register." As explained earlier, applicant's mark is more appropriately subject to registration on the Principal Register. Nevertheless, we point out that the refusal to register on the ground of likelihood of confusion applies to marks for registration on the Supplemental Register. Thus, the amendment would not obviate the refusal. Indeed, marks "registered on the

Supplemental Register can be used as a basis for refusing registration to another mark under §2(d) of the Act.” *In re The Clorox Company*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978). While applicant also points out that it “was using its mark before those” of registrant (Brief at 11), priority is not an issue in this ex parte proceeding. *In re Calgon Corp.*, 435 F.2d 596, 598, 168 USPQ 278, 280 (CCPA 1971).

When we consider the evidence of record, we conclude that the marks VERSUS MOTORSPORT and VERSUS are similar and that the goods and services are related. When prospective purchasers familiar with registrant’s mark for wheels for land vehicles encounter applicant’s VERSUS MOTORSPORT for the identified services, they are likely to assume that there is some association or relationship between the sources of the goods and services. Therefore, confusion is likely.

Decision: The examining attorney’s refusal to register applicant’s mark VERSUS MOTORSPORT for the identified services under Section 2(d) of the Trademark Act because of a registration for the mark VERSUS for wheels for land vehicles is affirmed.