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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JSW Parts Pty Ltd.

Serial No. 79015665

Michael Cerrati of Patel & Alunit, P.C. for JSW Parts Pty Ltd.

Dawn Feldman Lehker, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Kuhlke and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

JSW Parts Pty Ltd. filed application Serial No. 79015665 for the mark IRONMAN 4 X 4 SUSPENSION and design, shown below, under the provisions of Section 66 of the Trademark Act of 1946, 15 U.S.C. §1141f, for goods ultimately identified as "motor vehicle parts and accessories namely leaf springs, coil springs and overload springs, torsion bars, U-bolts, shock absorbers, steering dampers, shackle bushes and greaseable shackle and pin kits all for use as parts of motor vehicle suspensions," in

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Class 12. Applicant disclaimed the exclusive right to use "4 X 4 SUSPENSION."



The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark used in connection with the goods described in the application is likely to cause confusion with the mark IRONMAN, in typed drawing format, for "tires for motor vehicles," in Class 12.¹

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or

¹ Registration No. 1385907, issued March 11, 1986; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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").

A. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando*

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Electric Mfg. Co. v. JFD Electronics Components Corp., 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We begin our analysis of the marks by noting, as indicated above, that although likelihood of confusion must be determined by analyzing the marks 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, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this regard, with respect to applicant's mark, the name "Ironman" is accorded greater weight than the design element because it is the word portion of the mark that consumers use to request and to identify applicant's products. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions*

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Co., 3 USPQ2d 1553, 1554 (TTAB 1987); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985).

Also, the name "Ironman" makes a greater impression than the term "4 X 4 Suspension" because "4 X 4 Suspension" is a descriptive term referring to the suspension system for a four-wheel drive vehicle. Descriptive matter is generally viewed as a less dominant or significant feature of the mark. *In re National Data Corp.*, 224 USPQ at 750. Moreover, applicant disclaimed the exclusive right to use the term "4 X 4 Suspension" in response to the requirement for a disclaimer because the term is merely descriptive of applicant's products. *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting *In re National Data Corp.*, 224 USPQ at 750 ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'").

Applicant's mark incorporates the entire registered mark. "When one incorporates the entire arbitrary mark of another into a composite mark, inclusion in the composite mark of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion." *Wella*

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Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT with a surfer design is similar to CONCEPT). See also *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL LANCER in association with the design of a Bengal Lancer soldier is similar to BENGAL); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972) (griffin design above the words WEST POINT PEPPERELL is similar to WEST POINT).

Because the registered mark is in typed drawing format, the registration is for the word "Ironman" itself, without any form of lettering or associated design. The registrant's rights reside in the word "Ironman," and not in any particular form of the mark. Thus, for purposes of determining the registrability of applicant's mark, we must be cognizant that registrant's IRONMAN mark may be displayed in any form, including the identical form used by applicant. *In re Melville Corp.*, 18 USPQ2d 1386, 1387-1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987).

The marks in their entireties are similar because they both include the arbitrary term "Ironman." In this case, applicant's inclusion of the design of what appears to be

an "iron man" character in its mark is not likely to be viewed as indicating that applicant's products come from a different source. The IRONMAN 4 X 4 SUSPENSION and design mark will be viewed as a variation of registrant's IRONMAN mark because the "iron man" design emphasizes the word mark IRONMAN, as opposed to serving as a separate and distinct indicator of source. Accordingly, in our opinion, because the marks share the name "Ironman," the marks are substantially similar.

B. Strength of the IRONMAN mark.

Applicant argued that registrant's IRONMAN mark is a weak mark, entitled to only a narrow scope of protection as evidenced by the five registrations for IRONMAN owned by World Triathlon Corporation, for bicycles, sport utility vehicles marketed in connection with running, swimming, and biking competitions, and baby strollers. Although applicant did not submit any evidence that the third-party IRONMAN marks were in use, the Examining Attorney did, including an excerpt from Wikipedia that described the IRONMAN competition as "possibly the most famous triathlon in the world."² Despite the purported fame of the IRONMAN

² July 2, 2006 Office Action. The Wikipedia evidence is admissible because applicant had an opportunity to verify and rebut the evidence. *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007).

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triathlon sponsored by the World Triathlon Corporation, one user of a mark in a field far removed from vehicle parts and accessories does not make registrant's mark a weak mark.

C. The similarity or dissimilarity and nature of the goods.

In analyzing the similarity or dissimilarity and relatedness of the goods, we must keep in mind that there is no rule that certain goods are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See, e.g., *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

The Examining Attorney submitted seven third-party registrations, based on use in commerce, where the same mark is registered for both vehicle suspension systems and

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vehicle tires.³ Third-party registrations based on use may serve to suggest that the goods listed in the registrations may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d at 1785-1786; *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d at 1470 n.6.

The Examining Attorney also submitted excerpts from websites purportedly showing that suspensions and tires are frequently sold together in the aftermarket for auto parts.⁴ We do not find these websites particularly probative of the relatedness of the products. The first website is an excerpt from *Petersen's 4 Wheel & Off Road* online magazine.⁵ The excerpt provided by the Examining Attorney is entitled "Tech Articles," and it appears to be a table of contents

³ We have not considered the five registrations based solely on foreign filings pursuant to Sections 44 or 66 of the Trademark Act of 1946. Applications filed under Sections 44 or 66 do not require use in commerce. Without use in commerce, the registrations have very little probative value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). In addition, Registration No. 3077288 did not include vehicle tires, Registration No. 2997193 was for bicycle parts and accessories, not motor vehicle parts, and Registration No. 3116346 was for trailer parts and accessories, not motor vehicle parts.

⁴ June 19, 2007 Office Action in response to applicant's request for reconsideration. The Examining Attorney stated that applicant's goods and registrant's goods are highly similar, and attached copies of the websites to show that products are sold together. The Examining Attorney has merged the similarity of the goods and the similarity of the trade channels. As discussed in the main body of the decision, the websites are probative that the trade channels are similar, however, they do not show that the products are similar.

⁵ www.4wheeloffroad.com.

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including subjects such as "truck suspension lift kits & brakes," "4X4 truck engines," and "off road truck wheels & tires." We can infer from this exhibit that 4x4 vehicles include suspensions, brakes, engines, and tires, but not that consumers would expect that these parts would emanate from a single source.

The second website is an excerpt from the *4 Wheel Parts* website.⁶ This is an online retail website in the field of truck parts. This online retailer sells lift kits, shocks, suspension systems, and tires. However, different trademarks identify the shocks and tires displayed in the excerpt (e.g., Pro Comp shocks and suspension system kits and Dick Cepek Tires and Mickey Thompson Tires). There is no evidence that tires and suspension systems are identified by the same or similar marks.

The third website is an excerpt from the *Enjoy The Drive* website regarding off-road tires.⁷ The subject matter of the website excerpt is the difference between off-road and stock tires. The only reference to suspension systems is the statement that a consumer has the "option of installing an off-road suspension package that will lift

⁶ www.4wheelparts.com.

⁷ www.enjoythedrive.com.

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your vehicle suspension and provide room for a taller wheel-and-tire combo."

The final exhibit is an excerpt from the *Rough Country Suspension Systems* website, an online retailer.⁸ The website references Dick Cepek tires and Mickey Thompson tires, as well as unbranded suspensions and suspension lift kits. There is no evidence that tires and suspension systems are identified by the same or similar marks.

Applicant also submitted an excerpt from the *Inner Auto Parts* website.⁹ Inner Auto Parts is an online retailer in the field of automobile parts. In the section of the website regarding suspension systems, Inner Auto Parts identifies, *inter alia*, coil springs and shock absorbers, but not tires. In fact, even though Inner Auto Parts sells hubcaps and wheels, it does not sell tires. *See also* the *Car Stuff* and *Car Parts Wholesale* websites.¹⁰

Applicant submitted excerpts from an additional three online automotive tire retailers, none of whom appeared to sell both tires and suspension parts.¹¹

⁸ www.roughcountry.com.

⁹ www.innerauto.com attached to applicant's September 29, 2006 response to the first Office Action.

¹⁰ www.car-stuff.com and www.carpartswholesale.com.

¹¹ We did not consider the EuroPerformance.co.uk website because it is a European website and there is no evidence as whether it has any impact on consumers in the United States. Also, we note that although the excerpts from the online tire retailers were only one page, the Examining Attorney did not submit any contrary

In view of the third-party registrations, we find that the goods are sufficiently related such that when used in connection with a highly similar and strong mark would be likely to cause confusion. The third-party websites do not persuade us otherwise because those websites are by third-party retailers who sell a wide variety of automobile parts and accessories manufactured by others as opposed to manufacturers of tires and/or suspension systems. Thus, the third-party websites are not probative of whether consumers perceive tires and suspension systems as emanating from a single source.

D. The similarity or dissimilarity of established, likely-to-continue channels of trade and classes of consumers.

Because there are no restrictions as to trade channels and classes of consumers in either the application or the cited registration, we presume that the goods move in all normal trade channels for such goods and to all normal classes of purchasers for such goods. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In addition, the above-noted websites that were submitted by the Examining Attorney demonstrate that the same automotive retailers thereof sell

evidence to demonstrate that those online tire retailers, in fact, sold suspension systems and related parts in addition to tires.

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tires and suspension systems and parts. Accordingly, we find that the channels of trade and classes of consumers are the same.

E. Balancing the factors.

In summary we have carefully considered all of the evidence of record pertaining to the *du Pont* likelihood of confusion factors, as well as applicant's arguments with respect thereto. For the reasons discussed above, we conclude that applicant's use of IRONMAN 4 X 4 SUSPENSION and design, when used in connection with "motor vehicle parts and accessories namely leaf springs, coil springs and overload springs, torsion bars, U-bolts, shock absorbers, steering dampers, shackle bushes and greaseable shackle and pin kits all for use as parts of motor vehicle suspensions," is likely to cause confusion with the mark IRONMAN for "tires for motor vehicles." Any doubts as to this conclusion must be resolved against applicant. *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register is affirmed.