

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 27  
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9/27/00

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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**Autozone, Inc.**

v.

**International Web Broadcasting Corporation, by change of  
name from Internet World Broadcasting Corporation<sup>1</sup>**

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Opposition No. 106,669  
to application Serial No. 75/044,430  
filed on **January 16, 1996**

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**Alan S. Cooper and Eric Fingerhut** of Shaw, Pittman, Potts &  
Trowbridge for Autozone, Inc.

**Eleanor Spillman, Esq.** for **International Web Broadcasting  
Corporation.**

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Before **Simms, Hanak and Rogers**, Administrative Trademark  
Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

International Web Broadcasting Corporation has filed an  
application to register the mark CAR ZONE for services  
identified as "providing an on-line computer database via

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<sup>1</sup> It appears applicant has twice recorded its change of name in  
the Assignment Branch, at Reel 1775, Frame 0568, and at Reel  
1789, Frame 0849. On applicant's "List of TTAB Depositions  
Taken," filed January 14, 2000, applicant reports a further

the global computer information network and electronic bulletin board featuring advertisement and marketing information for others about automobile and motorcycle-related goods and services; and on-line ordering services featuring automobile and motorcycle-related goods and services," in Class 35.<sup>2</sup> The application includes a disclaimer of the exclusive right to use "CAR."

AutoZone, Inc. has opposed registration on the grounds that since "long prior to" the filing date of applicant's application, opposer's predecessor adopted and used, and opposer continues to use, in commerce, "the trademark and service mark AUTOZONE<sup>3</sup> for, *inter alia*, a variety of retail automotive products and for retail auto parts store services"; that "long prior to" the filing date of the opposed application, opposer "adopted, used and is still using in commerce AUTOZONE.COM as [a] domain name and service mark for "on-line electronic services namely, on-line ordering services in the field of automotive parts and accessories, and providing information regarding automotive repair and maintenance via a global computer network," and that opposer, on February 7, 1996 filed to register

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change of name to IWBC.Net Corporation, but this apparently has not been recorded.

<sup>2</sup> Serial No. 75/044,430, filed January 16, 1996, based on applicant's allegation of a bona fide intention to use the mark in commerce.

<sup>3</sup> Opposer relies on registrations for the mark in both typed form and in stylized form with a design element.

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AUTOZONE.COM as a service mark for these services<sup>4</sup>; that opposer "duly registered AUTOZONE.COM as an Internet domain name" on September 26, 1995; that purchasers of its goods and services recognize AUTOZONE as an indication of origin in opposer; that its mark "has become exceedingly well-known"; that opposer's mark and applicant's mark "are identical in terms of their meaning, and accordingly are confusingly similar"; that the goods and services described in opposer's registrations and in its approved application "are commercially related" to the services in applicant's application; and that consumers will be confused or deceived.

Applicant has expressly or effectively denied the salient allegations of the notice of opposition. Applicant asserts that "the apparent differences in sight, sound, connotation and commercial impression, as well as the differences in services and channels of trade, show that there exists no likelihood of confusion." Applicant also states that "[s]hould the Board determine that Opposer is entitled to judgment with respect to Applicant's services as broadly defined in the application, Applicant claims the following affirmative defense in the alternative." The defense asserts:

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<sup>4</sup> Serial No. 75/054,355. Office records reveal that a Notice of Allowance issued on August 19, 1997 and that opposer has obtained five extensions of time to file a statement of use.

5. Applicant has adopted and has begun actually marketing the service mark CAR ZONE in association with an Internet Web Site that offers links to other, independently owned and operated, Internet Web Sites, each site for providing an on-line computer database via the global computer information network and electronic bulletin board featuring advertisement and marketing information for others about automobile and motorcycle-related goods and services; and on-line ordering services featuring automobile and motorcycle-related goods and services.

6. Applicant's service does not offer content under the name CAR ZONE. On the contrary, CAR ZONE is an on-line infrastructure, linking users to Web Sites controlled and operated by independent entities, each bearing the trademark or service mark of that entity. ...In order for the user to obtain specific, automobile related information, the user must link to one of these independent Web Sites.

7. Applicant's services provided through CAR ZONE is one [sic] among many services organized into an on-line infrastructure known as New Atlantis. Along with CAR ZONE, users of New Atlantis can access Web sites concentrating on a number of different professions or areas of interest. ...

8. Based on, among other things, the actual services offered by Applicant in association with the service mark CAR ZONE, the independent nature of the Web Sites containing specific information, and the family of "Zone" marks utilized by Applicant, there is no likelihood of confusion with respect to Opposer's mark.

9. Even if the Board ultimately finds that Opposer is entitled to judgment with respect to Applicant's services as broadly identified, Applicant would be entitled to a registration of its mark with a restricted identification reflecting the actual nature of its goods [sic].

The record includes the pleadings, the opposed application and, as described by opposer in its brief, the following items submitted by opposer: the testimony deposition of Anthony Dean Rose, Jr., opposer's senior vice president, advertising and customer satisfaction, with exhibits<sup>5</sup>; applicant's answers to certain of opposer's interrogatories; applicant's responses to certain of opposer's request for admissions; status and title copies of opposer's pleaded registrations; and dictionary definitions of "auto," "automobile," and "car."

Applicant did not submit any testimony or other evidence. Opposer filed a brief; applicant did not. An oral hearing was not requested.

Insofar as opposer relies on its pleaded registrations, priority of use is not an issue, because the record shows that the registrations are subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Insofar as opposer relies on its use of AUTOZONE.COM, opposer has failed to prove priority. While the unchallenged testimony of opposer's witness establishes that opposer maintains a Web site with the address AUTOZONE.COM, there is no testimony to as to the date of registration of that designation as an Internet address, or as to first use of that designation as

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<sup>5</sup> Applicant did not attend and cross-examine the witness.

an address. Thus, the allegations in the notice of opposition as to registration of the designation as an Internet address and as to use of the designation as a mark since prior to the filing date of applicant's application both are unproved.

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that confusion as to source or affiliation or sponsorship is likely in this case. In the *du Pont* analysis, two key considerations are the similarity of the marks and the similarity or commercial relatedness of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29. In the case at hand, other key *du Pont* considerations include the fame of opposer's mark, as evidenced by its widespread promotion, and the lack of evidence that there are any other marks at all similar to opposer's in use for similar goods or services. We consider first, the marks.

While we must consider the marks in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant has disclaimed rights in "CAR," and the record establishes that "car" and "auto" or "automobile" are interchangeable terms.<sup>6</sup> Disclaimed or descriptive elements in marks typically are less significant. See Tektronix, Inc. v. Daktronics, Inc., 189 USPQ 693 (CCPA 1976). In contrast, there is nothing in the record to indicate that "ZONE" is anything other than arbitrary for opposer's and applicant's respective goods and services. Moreover, opposer has submitted evidence sufficient to support its claim that its mark is "exceedingly well-known"<sup>7</sup> and there is no evidence that any other "Zone" marks are in use for the involved goods or services or any related thereto.

In short, we find opposer's mark strong and widely promoted among consumers, and we find applicant's mark similar in sight and sound and nearly identical in commercial impression. Given the fallibility of the normal consumer's recollection of marks, we find the nearly identical commercial impression created by the marks to be quite significant. See In re Lamson Oil Co., 6 USPQ2d 1041,

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<sup>6</sup> The evidence on this point includes the dictionary definitions made of record by opposer and the unchallenged testimony of opposer's witness.

<sup>7</sup> Opposer's witness testified to use of its registered marks in 2,124 stores in 38 states and opposer has submitted evidence of national advertising that has reached even into states where opposer has not yet expanded its operations. Opposer's witness testified that, as a result of its national advertising, opposer has received calls from consumers inquiring when opposer would open stores near them.

1042 n.4 (TTAB 1988) (one element in the sight, sound and meaning trilogy can, under the circumstances of a particular case, be sufficient to find marks confusingly similar).

Considering the respective goods and services, we note that much of applicant's answer and some of its responses to opposer's interrogatories attempt to differentiate applicant's actual services from those covered by the identification of services in its application. It is well settled, however, that our consideration of the question of likelihood of confusion must be based on the identifications in opposer's pleaded registrations and in applicant's application. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

Applicant's identification includes "on-line ordering services featuring automobile and motorcycle-related goods and services." Opposer has subsisting registrations for its mark, in both typed and design form, for various automotive parts and supplies<sup>8</sup> and for "retail auto parts store services."

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<sup>8</sup> As for goods, the registrations of record cover automotive batteries, automobile and truck engines, cleaning preparations for hands and automobiles, vehicle engine thermostats, and vehicle engine belts.

There is, of course, no question that the use of similar marks for goods on the one hand and related services involving those goods on the other may, in appropriate cases, be likely to result in confusion in trade. See, e.g., Steelcase Inc. v. Steelcare Inc., 219 USPQ 438, 435 (TTAB 1983) (STEELCARE for refinishing of furniture and office equipment held likely to be confused with STEELCASE for office furniture and accessories). See also, Safety-Kleen Corp. v. Dresser Industries, Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975).

Moreover, we take judicial notice of the increasing use of Internet Web sites as an additional channel of trade for traditional retail outlets.<sup>9</sup> Thus, many of the same consumers that have used opposer's stores over the years, finding applicant's Web site, may be confused and believe it to be somehow sponsored by or affiliated with opposer.

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<sup>9</sup> We find this a fit subject for judicial notice as a fact "generally known". Cf. General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc., 204 USPQ 396, 400 (TTAB 1979), *aff'd*, Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986, 988. We also note the following:

**World Wide Web** The largest collection of online information in the World. The Web is an Internet facility that has become synonymous with the Interent [sic].

...[T]he Web is turning into "the" worldwide information system for education, research, entertainment and commerce.  
The Computer Glossary The Complete Illustrated Dictionary 470 (8<sup>th</sup> ed. 1998)

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We find that if applicant uses its mark, for its identified services, there will be a likelihood of confusion among consumers, in view of opposer's prior registration and use of its mark for various automotive goods and for its retail auto parts store services.

We note that applicant pleaded, in the alternative, that confusion of consumers is unlikely but that, were we to find otherwise, then applicant is entitled to registration of its mark "with a restricted identification reflecting the actual nature of its goods [sic]." We view this as an attempt to make a claim under Section 18 of the Trademark Act, 15 U.S.C. §1068. We have no testimony or evidence from applicant, however, regarding the exact nature of its services. Moreover, it is entirely unclear from the pleadings and applicant's responses to opposer's interrogatories whether applicant has begun use of the mark and, if so, for what precise services. In this regard, we compare applicant's responses to opposer's interrogatories 23 and 24, applicant's denial of paragraph 2 in opposer's notice of opposition, and applicant's affirmative defense.

Applicant denied opposer's allegation that applicant made no use of its mark prior to filing the involved application (answer, ¶2), and the allegations in applicant's affirmative defense discuss applicant's use of the mark. In contrast, applicant's interrogatory responses deny any use

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of the mark: "Applicant has not commenced use of the mark. Applicant filed an Intent to Use Application. Applicant will use the mark pending the outcome of the Opposition period [sic]." (Response to Opposer's Interrogatory 23).

Under the circumstances, applicant has failed to apprise opposer and the Board of the precise limitation on applicant's identification that would support a claim under Section 18. Moreover, for the Board to grant relief under Section 18, applicant would have had to show that it is actually using its mark and the precise nature of the services it is using the mark for. Having failed to do so, applicant's affirmative defense has not be considered.

Decision: The opposition is sustained and registration to applicant is refused.

R. L. Simms

E. W. Hanak

G. F. Rogers

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board