

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

wellington

MAILED: February 26, 2003

Opposition No. 123,625

DENT DOCTOR, INC.

v.

MICHAEL D. BATES

Before Hohein, Walters and Bottorff, Administrative Trademark Judges.

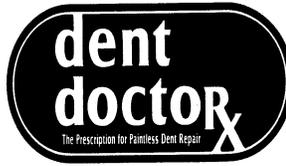
By the Board:

On July 23, 2000, applicant has filed an application (Serial No. 78/018,014) to register the following mark:



for "automobile repair and maintenance" in Class 37. The application alleges use in commerce since March 15, 1998. The term "DING" is disclaimed.

On July 9, 2001, opposer filed its notice of opposition to registration of applicant's proposed mark. As grounds for the opposition, opposer alleges that applicant's mark so resembles the following previously used and registered marks owned by opposer:



for "minor dent removal for vehicles" services in International Class 37;¹ and



for "minor dent removal for vehicles" services in International Class 37,² as to be likely to cause confusion, or to cause mistake or to deceive.³

In his answer, applicant admits that he "has used the designation DING DOCTOR since March 15, 1998, the date of first use claimed in [his] application"; that opposer is the owner of its pleaded registrations; that the parties' respective services

¹ Registration No. 1,573,853, registered on December 26, 1989, and claiming use in commerce since June 10, 1988 (date of first use anywhere set forth as June 1, 1988).

² Registration No. 1,915,713, registered on August 29, 1995, and claiming use in commerce since June 10, 1988 (date of first use anywhere set forth as June 1, 1988).

³ We note that opposer did not make its pleaded registrations of record pursuant to Trademark Rule 2.122(d), namely, by filing a status and title copy for each pleaded registration. However, applicant conceded in his answer to the notice of opposition that opposer owns the pleaded registrations. Applicant also treated the pleaded registrations as being of record in his opposition to the summary judgment motion. Based on applicant's admissions in the answer and his treatment of the pleaded registrations in opposition to the summary judgment motion, the pleaded registrations are deemed to be of record for purposes of such motion and owned by opposer. See TBMP Section 703.02(a) and authorities cited therein.

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are "similar and/or nearly identical" and "are sold or will be sold to the general public throughout Southern California to the same classes of customers and through the same channels of trade"; and that "the term DING DOCTOR is similar to opposer's mark DENT DOCTOR, is presented within a blue rounded rectangle within a white ring within a red ring with red letters with a white outline design which is somewhat similar to the design feature in opposer's mark." Applicant maintains, however, that his mark is not likely, when applied to applicant's services, to cause confusion or mistake or deceive.

This case now comes up on the opposer's motion for summary judgment. The parties have briefed the motion and, in order to expedite our decision thereon, the Board presumes familiarity with the issues presented and does not provide a complete recitation of the allegations and contentions of each party.⁴

In support its motion for summary judgment, opposer argues that there are no genuine issues of material fact; that likelihood of confusion exists based on the services recited in the registrations relied on by opposer and in the opposed application; that it has priority of use; and that it is entitled to judgment as a matter of law.

Opposer's summary judgment motion is accompanied by a declaration of Tom Harris, its president, wherein he avers to the genuineness of the following, self-described documents: repair

⁴ Applicant's uncontested motion (filed November 1, 2002) for extension of time to file a response to opposer's motion for summary judgment is granted as conceded. Trademark Rule 2.127(a).

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orders and estimates (dating from 11/30/93 to 5/4/02) showing actual use of opposer's marks; a list of representative samples of advertisements and newspaper/ magazine articles (dating from 7/1/91 to 1/02) regarding opposer's business; copies of a business card and a photograph of opposer's predecessor-in-interest's business truck showing use of the mark DENT DOCTOR in connection with vehicle dent repair services from 1986 to 1988; a copy of opposer's U.S. Registration No. 1,573,853; a copy of opposer's articles of incorporation (dated May 5, 1988); a chart for the years 1988-2002 listing the gross sales/advertising expenses (specifying advertising media used) for opposer's dent removal services under its marks; representative samples of letters (dating from 1990 to 2002) from customers; a list of opposer's franchise locations and company-owned locations that use the DENT DOCTOR mark in connection with dent removal services; a standard franchise agreement used by opposer; a copy of a letter (dated July 10, 2002) from owners of one of opposer's franchises; a printout from opposer's website; and a color advertisement showing opposer's mark as used from 1998 to present.

In response to opposer's summary judgment motion, applicant argues that the parties' respective marks are not identical in meaning, commercial impression, sound or appearance; that applicant has used its mark since February 1998 and has established a well-known presence in the southern California

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region; that opposer has only recently rendered dent removal services in the southern California region; that other businesses with similar and identical marks exist in the southern California region; that the terms "ding" and "dent" are commonly used for businesses rendering dent removal services; that there are many companies named "Dent Doctor" in the United States; that many companies use "Doctor" and "RX" (prescription symbol) as part of their trademark; that the term "Dent Doctor" is considered generic in many areas and does not identify one specific source; that opposer's allegations of actual confusion are unsubstantiated; that applicant has rendered dent removal services in San Diego County, California since February, 1998 without actual confusion with other companies using similar names; that opposer's franchisee used meta tags on its website to improperly confuse and/or misdirect customers; and that confusion is not likely.

Applicant submitted the following as exhibits to his response: a declaration signed by applicant; color copies of the parties' respective marks; Yellow Pages listing for applicant (dated 1998 to 2001); printouts from Internet directory listings for third party companies using the term "Dent", "Ding", "Doctor", "Rx" and "Dent Doctor" in their name; copies of logos for third party companies rendering dent removal services; copies of applicant's brochures, cards and notepads; a Better Business Bureau report for applicant and companies named "Dent Doctor" that applicant argues have no affiliation with opposer; customer

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and third party testimonials regarding applicant's quality of service; and printouts from the USPTO's TESS database of third-party registrations and applications containing the term "Dent" in the mark.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

In determining the issue of likelihood of confusion, and hence whether there is any genuine issue of material fact relating thereto, the Board must consider all of the probative facts in evidence which are relevant to the factors bearing on likelihood of confusion, as identified in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, each of the factors, from case to case, may play a dominant role. *Id.*, 476 F.2d at 1361, 177 USPQ at 567. Those factors as to which we have probative evidence are discussed below. After a careful review of the record in this

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case, we find that opposer has met its burden of establishing that no genuine issues of material fact exist and has demonstrated that it is entitled to judgment as a matter of law.

As a preliminary matter, we note that priority is not in issue in view of opposer's ownership of its pleaded and subsisting registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Moreover, and in any event, priority lies with opposer in light of applicant's admission in his answer that opposer has used its pleaded marks prior to applicant's first use of his mark.

As to the similarity of services offered by each party, opposer's identified services, "minor dent removal from vehicles" and applicant's identified services, "automobile repair and maintenance," are identical to the extent that the latter recitation is broad enough to encompass the former. Furthermore, based on the evidence submitted, it is clear that both parties use their marks in connection with vehicle repair services, namely, paintless dent removal.

As to the channels of trade, we note that the parties' respective recitations of services are unrestricted. Thus, the Board must presume that the parties' services travel in all the normal channels of trade and to the usual customers for the services. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed Cir. 1992). Thus, the trade channels and purchasers are the same for both parties' services.

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Applicant attempts to negate the impact of the parties' respective services travelling in the same channels of trade by arguing that he has used his mark in southern California since February 1998 and opposer has only recently entered this geographic region. This argument is not well taken. It has long been held that any geographical separation of the parties' use of their marks is not relevant in an opposition. The owner of a territorially unrestricted federal registration has a presumptive exclusive right to use which extends throughout the United States. Therefore, it is not proper to limit consideration of likelihood of confusion to territories arguably occupied by parties in an opposition. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (while opposer and applicant may presently be geographically separated in their uses, this is irrelevant where applicant seeks a nationwide unrestricted registration); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) (territorial separation of the use of the cited registered mark from the applicant is irrelevant to determining likelihood of confusion in a geographically unrestricted application). The application which is the subject of this proceeding is not geographically restricted nor are the pleaded registrations. Consequently, applicant's argument that the parties' use their respective marks in different geographic areas fails as a matter of law.

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We now turn to the degree of similarity of the marks being used by opposer and applicant. In comparing the marks, the Board is guided by the general principle that the greater the degree of similarity of the services, the lesser the degree of similarity of the marks that is required for there to be a likelihood of confusion. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). It is equally well established that, although the marks must be considered in their entirety, there is nothing improper in giving more or less weight to a particular feature of a mark, particularly where portions of the marks are descriptive or generic. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Both parties have conceded that the terms "dent" and "ding" are synonymous, and that the terms are descriptive of the parties' services. These terms are accordingly given less weight and the term "DOCTOR" is the dominant, source-indicating portion of the parties' respective marks. Adding to the similarity of the marks is the nearly identical, ringed oval border used by both parties to enclose the literal portion of their marks.

Indeed, aside from the parties' use of the descriptive terms "DENT" and "DING", there is very little to distinguish the marks. Differences in the parties' use of stylized lettering is generally given less weight in favor of the word portion of the mark, because it is by the words that purchasers will refer

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to the services, and the words themselves, rather than the stylized lettering, will therefore make a greater impression on consumers. See *Ceccato v. Manifattura Lane Gaetano Marzotto y Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994); and *In re Appetito Provisions Co.*,.

Comparison of the commercial impressions created by the competing marks in their commercial context is appropriate. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, *supra*. Here, a review of the parties' respective marks reveals that there is no genuine issue as to the fact that they create the same commercial impression. By using the term "DOCTOR" in all three marks, the parties liken their services, albeit non-seriously, to medical treatment.

Applicant's evidence in support of its argument that the term DOCTOR or DENT DOCTOR is weak and used by third parties, thus enabling consumers to distinguish between the parties' respective marks, is unpersuasive.

The Board has previously given weight to credible and probative evidence of widespread, significant and unrestrained use by third parties of marks containing elements in common with the mark being opposed on grounds of likelihood of confusion to demonstrate that confusion is not, in fact, likely. See *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996); *Hilson Research Inc. v. Society For Human Resource Management*, 27 USPQ2d 1423, 1431 (TTAB 1993), citing *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1462 (TTAB

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1986, amended 1987). However, in an *inter partes* proceeding involving a restaurant, the Board noted that such third-party use of same or similar marks has little or no impact where "applicant has not furnished any evidence regarding the extent of use of the marks by these third parties" and "the pictures of these restaurants tend to indicate that the operations are small and local in nature." *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995).

In the case now before us, applicant's evidence of third-party uses and registrations is minimal. Unlike the situation in the *Broadway Chicken* case, applicant has not demonstrated third party use of the term "Dent Doctor" in connection with the relevant services. Indeed, the evidence submitted by applicant reveals only seven apparent third-party users of the term DENT DOCTOR or DENT DOCTORS in connection with such services. We are not persuaded that this minimal number of apparent third-party uses herein raises a material issue of fact for trial.

More succinctly put, the Board is convinced that there is a likelihood of confusion here as a matter of law, where substantially similar marks are used in connection with the same services, even assuming the existence of the third-party use demonstrated by applicant.

In making its decision herein, the Board does not rely on opposer's proffered evidence of actual confusion. Nonetheless, and even assuming that there has been no actual confusion, this does not preclude a finding of likelihood of confusion. See, for

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example, *Walgreen Co. v. Knoll Pharmaceutical Co.*, 162 USPQ 609 (TTAB 1969).

Considering the substantial similarities between the marks, we find that, when used on the identical services, confusion is likely to result. Opposer, therefore, has met its burden of establishing that no genuine issues of material fact exist and that confusion is likely.

Accordingly, opposer's motion for summary judgment is granted, judgment is entered against applicant and registration to applicant is refused.

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