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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Vetronix Corporation

v.

American Financial Warranty Corporation

Opposition No. 91150901
to application Serial No. 75943880
filed on March 14, 2000

Jaye G. Heybl of Koppel, Jacobs, Patrick & Heybl for
Vetronix Corporation.

Joan L. Long and Aric S. Jacover of Mayer, Brown, Rowe and
Maw, LLP for American Financial Warranty Corporation.

Before Seeherman, Chapman and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Vetronix Corporation has opposed, on the ground of
likelihood of confusion, the application of American
Financial Warranty Corporation to register "MASTERTECH
Vehicle Protection Program and design," as shown below, and
with the words "Vehicle Protection Program" disclaimed, for

"vehicle service contracts, namely agreements covering mechanical breakdown or failure in which a vehicle dealer will provide repairs to the purchaser's vehicle, which contracts are insured and ordinarily financed as part of the purchase of a vehicle" in Class 36.¹



Specifically, opposer has alleged that it owns a federal registration for the mark MASTERTECH for "hand held tester for automobile electronics systems"; that opposer's use of its mark for its goods is prior to the first use claimed by applicant; that opposer's goods and applicant's services are related in that opposer's goods relate to the servicing of vehicles and applicant's services relate to vehicle service

¹ Application Serial No. 75943880, filed March 14, 2000 and asserting first use and first use in commerce on January 1, 1999. In reviewing the application file, we note that during examination the Examining Attorney required applicant to amend its identification to be more definite, proposing the identification "Providing and administering insured vehicle service contracts which cover motor vehicle maintenance and repair." Applicant did not respond to this requirement, and apparently the Examining Attorney withdrew it, because the application was approved for publication with the original identification. Thus, although applicant's identification is for a contract, which is an object, it is clear that applicant offers services, which been classified in Class 36, and we consider the identification as referring to services despite the fact that the parties sometimes refer to the contract or warranty services as a "product."

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contracts; and that applicant's mark so resembles opposer's mark that, when it is used with applicant's services, it is likely to cause confusion.

In its answer, applicant has denied all of the salient allegations in the notice of opposition, and has asserted affirmatively that there is no likelihood of confusion.

The record includes the pleadings and the file of the opposed application. The parties have stipulated to the admission in evidence of opposer's first set of requests for production of documents, and applicant's response thereto; opposer's first set of interrogatories and applicant's response thereto; applicant's first request for production of documents and opposer's response thereto; applicant's first set of interrogatories and opposer's response thereto; and a status and title copy of opposer's pleaded registration for MASTERTECH.²

Both parties have submitted briefs on the case, but neither requested an oral hearing.³

² Registration No. 1,745,088, issued January 5, 1993; Section 8 and 15 affidavits accepted and acknowledged; renewed.

³ With its brief opposer submitted copies of registrations and applications for MASTERTECH marks which were obtained from the electronic records of the U.S. Patent and Trademark Office, and asked that the Board take judicial notice of them. The Board does not take judicial notice of records residing within the Office. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1978). However, in its brief applicant has discussed these documents, and therefore we consider them to have been stipulated into the record.

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Based on the interrogatory responses provided, we find that opposer uses, has used or intends to use MASTERTECH SERIES MTS (followed by a specific number) for gas analyzers, a scan tool, a noise vibration and harshness analyzer, an engine analyzer, a storage cart and a roll cart.⁴ In the United States these goods are sold through Vetronix Sales Corporation, whose sales staff directly markets the goods to opposer's customers. The customers for these goods are automobile dealerships and their repair shops, and independent automotive repair shops, and the class of consumers includes automotive dealership owners and managers; automotive dealership repair shop owners, managers and automotive technicians; and independent automotive repair shop owners, managers and automotive technicians.

Opposer objected to providing information as to the approximate dollar amount of its annual sales of its goods (Interrogatory No. 9), stating that such information "is not relevant nor reasonably calculated to lead to the discovery of relevant information." Opposer provided a similar response to applicant's interrogatory (No. 12), which sought opposer's annual expenditures for advertising and marketing opposer's goods and services associated with the mark.

⁴ In its brief, opposer has stated that it uses its mark "only in connection with the hand held equipment described in the registration," brief, p. 13, i.e., for "hand held tester for automobile electronics systems."

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Opposer did state, with respect to applicant's request for information about advertising (Interrogatory No. 10), that "in the past, Opposer has advertised in a number of industry trade publications, many of which are no longer publishing. Opposer currently advertises in the industry trade publications 'Motor Age' and 'Motor.'"

Applicant first began using the mark MASTERTECH VEHICLE PROTECTION PROGRAM in connection with its vehicle service contracts in April 1999. It markets and distributes its warranties to car, boat and RV dealerships, which in turn sell the warranties to their customers. The dealerships operate mainly as sales outlets for applicant's warranty products. Applicant does not intend to use the mark with any other products, or to expand the class of consumers to which it sells its warranties.

Applicant markets its warranty products primarily through individual salesmen to the various dealerships. Its promotion efforts are focused on person-to-person marketing, rather than print ads. It has displayed its marketing materials at the National Auto Dealer Association convention and at various state auto dealer association conventions.

Neither party is aware of any instances of actual confusion.

Priority is not in issue in view of opposer's registration for MASTERTECH, which it has made of record.

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King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Turning to the issue of likelihood of confusion, our determination 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). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The first factor we consider is the similarity of the marks. The dominant feature of applicant's mark is the term MASTERTECH, which is identical in pronunciation and connotation to opposer's mark. Further, because the protection accorded opposer's mark, which is registered in "typed" drawing form, extends to stylizations of the mark, opposer's mark could be depicted in the same manner as applicant's. Thus, we consider MASTERTECH to have the same appearance as well.

We recognize that marks must be compared in their entirety, and therefore the additional elements in applicant's mark cannot be ignored. However, it is well established that, for rational reasons, more or less weight may be accorded to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, the descriptive and disclaimed

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words VEHICLE PROTECTION PROGRAM have no source-indicating significance. Consumers will regard these words as merely describing the type of service offered under the mark. Nor are the design element and the three horizontal lines in the MASTER portion of the mark likely to make an impression on consumers. Rather, it is the word MASTERTech, by which consumers will refer to and call for the services, that they will remember. Thus, we think it appropriate to follow the general rule that, if a mark comprises both a word and a design, the word is normally accorded greater weight. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Although the factor of the similarity of the marks favors opposer, virtually all of the other duPont factors favor applicant.

Turning to the goods and services, opposer's primary argument to show that they are related appears to be that:

Opposer's products are used to locate the source of problems with the vehicle during service. Applicant's product provides coverage to the customer in the event that vehicle service is need. Both products are reasonably related to the service and repair of automobiles. Brief, p. 9.

In previous decisions we have stated that it is not enough to find one term that may generically describe the goods. See *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690 (TTAB 1977). Here, we find opposer's efforts to put its goods and applicant's services

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into a single category to be, to say the least, a real "stretch." Opposer's tester for automobile electronics systems and applicant's vehicle service insurance plans are very different. There is no evidence that the same companies market both kinds of products/services, nor has opposer submitted any evidence to show why consumers would expect both types of products and services to emanate from a single source.

It is true that opposer's tester and applicant's vehicle service contracts are both marketed to automobile dealerships. However, the goods and services themselves are very different. To a large extent, the employees of automobile dealerships would not come in contact with both opposer's goods and applicant's services. That is, opposer's goods would be used by the employees who do automotive repair, but applicant's vehicle service contracts would be offered by the salesmen who sell the automobiles. There may, of course, be some overlap, in that owners or managers may make decisions to buy opposer's testers for electronic systems and to offer applicant's repair contracts. However, such people will be sophisticated and careful purchasers. The decision as to which service contract--in effect, an insurance contract--to offer one's customers would not be made lightly, since any problems with the performance of that contract would necessarily reflect

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on the dealership. Similarly, the decision to purchase equipment for testing the electronics system of an automobile--equipment used in the maintenance and repair of the vehicle, would be made with care, and not on impulse. Given the substantial differences in the nature of the goods and services--a tester for electronics systems and an automobile service contract, the common purchasers of these goods and services are not likely to assume that they come from a single source simply because they are offered under very similar marks.

It must also be noted that the mark MASTERTECH cannot be considered a strong mark. Certainly it is not, as opposer contends, a famous mark. Opposer has provided no evidence regarding the amount spent on advertising and promoting its products or the amount of its sales which might prove that its mark is famous. On the contrary, opposer stated in its answers to applicant's interrogatories that such information was not relevant. We cannot conclude based on the evidence of record that opposer's MASTERTECH trademark is famous. Instead, we find that MASTERTECH is a suggestive mark. As opposer has acknowledged, it is a combination of the word "master" and the word "tech," which opposer states in an abbreviation for "technician," "technical" or "technology." The suggestiveness of this term is demonstrated by the third-party registrations for

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MASTERTECH marks, which include registrations for handtools and for providing technical training courses in automotive service and repair.⁵

We note that there is no evidence of third-party use of MASTERTECH marks (third-party registrations do not constitute proof of use of the marks shown therein). This duPont factor favors opposer but is outweighed by the suggestiveness and lack of strength of the MASTERTECH mark.

We will follow the parties' lead and discuss the remaining duPont factors only briefly. There is no evidence of actual confusion. In view of the lack of evidence as to either party's sales and market presence, and the difficulty in obtaining evidence of actual confusion, we regard this factor as neutral in our analysis. As for the variety of goods on which a mark is used, because opposer uses its mark MASTERTECH only on the hand held tester identified in its registration, consumers will not expect opposer to expand its use of the mark to such substantially different services as vehicle service contracts. Both parties have also discussed in their briefs that applicant uses MASTERTECH ETCH on anti-theft products. We do not regard this factor as favoring either party.

⁵ The former registration has been cancelled, but it is still evidence of the suggestive nature of the mark. Third-party registrations are competent to show the meaning of a mark in the same way that dictionaries are employed. *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187 (TTAB 1977).

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In conclusion, although such factors as the similarity of the marks and the lack of third-party uses favor opposer, they are outweighed by such factors as the differences in the goods and services, the care and sophistication of the common purchasers, and the suggestiveness of the term MASTERTECH. Accordingly, we find that opposer has failed to prove that applicant's use of MASTERTECH VEHICLE PROTECTION PROGRAM and design for its identified services is likely to cause confusion with opposer's mark MASTERTECH for a hand held tester for automobile electronics systems.

Decision: The opposition is dismissed.