THIS OPINION IS
NOT A PRECEDENT
OF THE T.T.A.B.

Mailed:
August 2, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

ExxonMobil Oil Corporation and Exxon Mobil Corporation

v.

Bartels Mangold Electronic GmbH

_____

Opposition No. 91152334 to application Serial No. 75434996 filed on February 17, 1998

_____

Paul F. Kilmer, Anthony R. Masiello and Stephen J. Jeffries of Holland & Knight LLP for ExxonMobil Oil Corporation and Exxon Mobil Corporation.

P. Jay Hines and Rebecca L. Roby of Baker & Hostetler LLP for Bartels Mangold Electronic GmbH.

_____

Before Bucher, Holtzman and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On February 17, 1998, applicant, Bartels Mangold Electronic GmbH, filed an application for registration of the mark IQMOBIL (in standard character form) on the Principal Register for the following goods and services, as amended:

> vehicle and aircraft on-board electronic instruments for measuring and controlling air pressure in tires, namely, an electronic data processing system comprised of air pressure sensors located within the tires of a vehicle or aircraft, transmitters and control units; vehicle and aircraft on-board electronic instruments for measuring the components of exhaust gases and then making corrections, if necessary, to the mixture of fuel, comprised of exhaust sensors, actuators, transmitters and control units; electronic diesel engine exhaust particles filters; vehicle and aircraft on-board electronic instruments, namely, sensors to detect micromechanical pressure, rain, engine revolutions per minute, engine and cockpit temperature, rack travel, acceleration and vibration, sensors for differential monitoring, ignition triggering, compression chamber knock, and oxygen concentration in fuel; electronic data processing devices, namely, CPUs, personal computers, laptops, palmtops, modems, printers, displays, disks and tapes; fax machines, fax machines combined with digital cameras, scanners and digital cameras" in International Class 9;
>
> telecommunication services, namely, providing multiple-user access to a global computer information network; telecommunication services, namely, providing telecommunications connections to a global computer network" in International Class 38; and
>
> Scientific research, research and development of new products for others; technical consultation and research in the field of customized programs for measuring and control system operations in vehicles and aircraft, CAD-CAM programs, and picture processing programs" in International Class 42.

Applicant has asserted a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), and has claimed priority under Section 44(d) of the Trademark Act, 15 U.S.C. §1126(d), based on its ownership of a German application, filed on August 25, 1997.

Opposers, ExxonMobil Oil Corporation and Exxon Mobil Corporation, have filed a timely notice of opposition to registration of applicant's mark. In the notice of opposition, opposers pleaded ownership of "a host of U.S. trademark and service mark registrations for … MOBIL … for a wide variety of goods and services" without identifying the "host" of registrations; and that long prior to the filing date of applicant's application, opposers and their predecessors in interest have continuously used in commerce the MOBIL names and marks; that the MOBIL names and marks have become famous prior to the filing date of applicant's application; and that consumers are likely to believe, falsely, that the goods and services of applicant originate with, are sponsored by, are endorsed by, or are otherwise affiliated with opposers in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Further, opposers alleged that the registration of applicant's mark will dilute the distinctive quality of opposers' MOBIL names and marks in violation of Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

Applicant has denied the salient allegations of the notice of opposition. The parties have fully briefed this case.

The Record

Of course, the record includes the file of application Serial No. 75434996 and the pleadings. It does not, however, include the exhibits to the pleadings because exhibits attached to pleadings are not evidence on behalf of the party to whose pleading they are attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony, and opposers did not do so in this case. Trademark Rule 2.122(c); TBMP § 317 (2d ed. rev. 2004). Additionally, the record includes the following submitted by opposers' notices of reliance; (i) various status and tile copies of opposers' U.S. registrations comprising or containing the term MOBIL; (ii) various web pages; (iii) opposers' requests for admissions and exhibits thereto, and opposers' attorney's statement that applicant did not respond to opposers' requests for admission; (iv) two "Mobile Travel Guide[s]"; (v) a decision involving the MOBIL mark from a foreign tribunal; and (v) various newspaper and magazine articles. The record also includes various web pages from opposers' website of record submitted by applicant's notice of reliance.

Preliminary Matters

The parties have raised several evidentiary objections which we discuss below.

Requests for Admissions

Applicant has objected to opposers' reliance on opposers' requests for admissions which stand admitted pursuant to Fed. R. Civ. P. 36(a) due to applicant's failure to respond, and Exhibits A – F to the requests for admission. According to applicant, the information admitted is not consistent and contains inherent contradictions. Because Trademark Rule 2.120(j)(3)(i) allows for the introduction of requests for admissions into evidence under the notice of reliance procedure, the unanswered requests are properly in evidence. Applicant's objection is hence overruled. The Board, however, has considered any inconsistencies in the admissions and has given them the weight that they are due.

Decision of European
Office for Harmonization
in the Internal Market ("OHIM")

Applicant has objected to opposers' reliance on OHIM's decision sustaining opposers' objection to applicant's Community trademark application for IQMOBIL. According to applicant, the Board has stated that "decisions of foreign courts in lawsuits involving a different evidentiary record and based upon different laws are irrelevant to the issue before us," citing *Miles Labs, Inc. v. Int'l Diagnostic Tech., Inc*. 220 USPQ 438 (TTAB 1983); and *Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A.,*

204 USPQ 688 (TTAB 1979) (decisions of German courts are "irrelevant" and "are of no probative value" and not considered in the evaluation of the marks in controversy). Opposers respond that the OHIM decision is "relevant evidence regarding the disinterested perceptions of specialized and knowledgeable judges as to the factual issue of the similarity of the marks." Reply at p. 6.

Trademark Rule 2.122(e), 37 C.F.R. §2.122(e), provides that "… official records, if … competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered." Because the decisions of foreign courts are "irrelevant" or "of no probative value," the OHIM decision is not relevant to any issue before the Board, including the issue of the similarity of the marks. Thus, we sustain applicant's objection and do not further consider the OHIM decision.

Applicant's German
National Applications for IQMOBIL

Opposers have objected to applicant's request that we take judicial notice of two of its German applications, submitted with applicant's main brief. Because the Board does not take judicial notice of applications, applicant's objection is sustained and we do not further consider the two German applications.

Wire Service Articles

Opposers have relied on articles taken from wire services, such as *Financial Wire*, *PR Newswire*, *Newswire* and *Business Wire*. Wire service articles generally have limited evidentiary value because we cannot determine whether or to what extent they have been broadcast or otherwise distributed so as to reach appreciable members of the relevant public. *In re Squaw Valley Development Co.,* 80 USPQ2d 1264 (TTAB 2006). Accordingly, we have given the wire service articles introduced into the record by opposers limited weight in arriving at our decision.

Priority

Opposers have made status and title copies of the following registrations of record, showing that they are in full force and effect and are owned by opposer ExxonMobil Oil Corporation:[1]

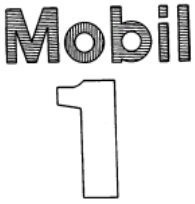
1. Registration No. 1046513, registered August 17, 1976 and renewed, for the mark MOBIL (in typed form) for "automotive service station services" in International Class 37;

[1] Two registrations for which opposers filed status and title copies have been cancelled under Section 9 of the Trademark Act. Specifically, the Office cancelled Registration No. 1364058 on July 22, 2006 and cancelled Registration No. 1930758 on August 5, 2006. We therefore do not further consider these registrations.

2. Registration No. 1049824, registered October 5, 1976 and renewed, for the mark

(lined for the colors red and blue) for "automotive service station services including car wash services and emergency road services" in International Class 37;

3. Registration No. 2133386, registered January 27, 1998, for the mark



for "high performance oil filters for motors and engines" in International Class 7, Section 8 accepted and Section 15 acknowledged;

4. Registration No. 2538994, registered February 19, 2002, for the mark MOBIL MONITOR (in typed form, and with MONITOR disclaimed) for "computer software used in connection with industrial lubricant analysis and testing" in International Class 9, and "testing, analysis, evaluation, and reporting services in connection with industrial lubricants" in International Class 42; and

5. Registration No. 2557896, registered April 9, 2002, for the mark MOBIL 1 E-STORE (in typed form and with E-STORE disclaimed) for "electronic retailing services via computer featuring motor and motorcycle oil, grease, gear lubricants, spray lubricants, oil filters and automatic transmission fluid; promoting the sale of goods and services of others through the distribution of printed material and promotional contests via the global computer network; products merchandising via the global computer network; dissemination of advertising for others via an on-line electronic

communications network" in International Class 35.[2]

Collectively, we refer to the marks of the above-identified registrations as "Opposers' Marks." Because opposers have made the registrations summarized above properly of record, opposers have established their standing to oppose registration of applicant's mark and their priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We add too, that applicant has not contested opposers' standing or priority.[3]

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of

---

[2] We treat these registrations not specifically mentioned in the notice of opposition as having been tried by the implied consent of the parties and we deem opposers' pleading amended to assert the registrations. Fed. R. Civ. P. 15(b).

[3] Opposers' evidence of common law use is dated after the filing date of applicant's application and does not assist opposers in establishing priority.

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).

The Marks

In considering the similarity between Opposers' Marks and applicant's mark, we determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The evidence shows that IQ has a particular meaning and would be recognized as a term separate from MOBIL. Specifically, applicant has admitted that "IQ is an acronym that stands for the expression 'intelligence quotient' and that it is commonly recognized as such by persons in the United States marketplace." Request for admission no. 12. Further, IQ would be pronounced by articulating the "I" and the "Q" separately from MOBIL. See definition of "IQ" submitted by opposers with their main brief from *Webster's Ninth New Collegiate Dictionary* (1986), showing the pronunciation of "IQ" as "ī-'kyü."[4] Thus, the MOBIL portion

[4] Because opposers did not submit the definition during their testimony period, we take judicial notice of the definition of "IQ." See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d

of applicant's mark would be articulated in the same manner as in Opposer's Marks, and, as in opposers' multi-term marks, remains as a distinct term. Consequently, when we consider the marks as a whole, we find that the marks are highly similar when spoken, with no apparent meaning in the context of the goods and/or services.

Applicant's mark may be depicted in a manner so that it is highly similar in appearance to opposers' marks. Because applicant's mark is in typed form, applicant may use any reasonable stylization of lettering, including the stylization used by opposers. See, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc*. 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) (a mark registered in typed format is not limited to the depiction thereof in any special form); *INB National Bank v. Metrohost Inc*., 22 USPQ2d 1585, 1588 (TTAB 1992) ("[a]s the Phillips Petroleum case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which … [the word mark] could be depicted"). Applicant's mark may be depicted in a manner that highlights the MOBIL portion of the mark or that minimizes the impression created by the IQ portion of the mark. By emphasizing MOBIL, and/or by depicting MOBIL in the same

---

1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions).

manner as opposers, applicant heightens the visual similarity between Opposers' Marks and applicant's mark.

We find that the commercial impressions of the marks are also similar. IQ, which is an initialism having a well-understood meaning, would be pronounced separately and would create a separate impression from MOBIL, which is not an English language term. As such, it stands apart from MOBIL. Hence, we find that the distinctive term, MOBIL, plays a significant role in forming the commercial impression of applicant's mark. Also, in Opposers' Marks, because MOBIL forms the entirety of some of opposer's marks, or because it is the dominant term in those of opposers' marks with additional terms (see discussion below), the commercial impression of both applicant's mark and Opposers' Marks is similar.

The differences noted by applicant in the cadence and length of the marks, and the visual impression created by the IQ at the beginning of applicant's mark including in the manner depicted in applicant's web page (made of record in connection with opposers' requests for admissions), are outweighed by the similarities noted above. Also, there is no evidentiary support for applicant's contention that "when the public sees the term MOBIL, they may have reason to see this as slang for autoMOBILe," brief at p. 9, and it appears unlikely to us that this would be the case.

Several of opposers' marks contain terms in addition to MOBIL such as MONITOR, 1 or 1 E-STORE. The addition of these terms does not yield a different conclusion; applicant's mark is also similar in sound, appearance, meaning and commercial impression to such marks. MOBIL is the term which dominates in these marks largely because of its positioning as the top, first or only word in each of these marks, and because the terms MONITOR and E-STORE are descriptive of a feature of the underlying goods or services and have been disclaimed. ("e-" is defined as "computer or computer network" in *The American Heritage Dictionary of the English Language* (4th ed. 2006); E-STORE thus refers to an on-line vendor; and MONITOR describes a feature of opposers' research and development services.) "[T]he 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). See also *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ("When comparing the similarity of marks, a disclaimed term, here 'COMMUNICATIONS,' may be given little weight, but it may not be ignored"). Thus, even when considering each of these marks as a whole, MOBIL forms the dominant part of each

mark. See *In re Chatam Intern. Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (it is proper to give each term in the conflicting marks "more or less weight depending on its effect on the overall commercial impression.").

In view of the foregoing, and because opposers' and applicant's marks are highly similar in appearance, sound, and commercial impression, we conclude that applicant's mark is highly similar to Opposers' Marks when considered in their entireties. The *du Pont* factor regarding the similarity of the marks is therefore resolved in opposers' favor.

<u>The Goods, Services and Trade Channels</u>

We now consider the similarity of the goods, services and established, likely-to-continue trade channels, beginning with applicant's International Class 9 goods. Opposers focus on the following goods in the application in arguing that a relationship exists between applicant's goods and opposers' goods and services:

> sensors for monitoring the level of oxygen in the fuel, the triggering of the ignition, and "compression chamber knock";
>
> exhaust filters for diesel engines;
>
> electronic instruments for measuring and controlling tire pressure, and exhaust; and
>
> electronic processing devices, namely, CPUs.

As indicated by specific limitations in applicant's identification of goods, and as reinforced by the

information on applicant's web site made of record in connection with opposers' requests for admissions, the sensors and the electronic instruments mentioned above are intended for use in connection with vehicles. Applicant's "exhaust filters for diesel engines," which contain no use restrictions, would also be used in vehicles, albeit only those with diesel engines. Because vehicles require lubricants, we find that applicant's above-listed goods are related to the goods of opposers' registrations in that both parties' goods may be used in the same vehicles. Further, applicant's vehicle parts are related to opposers' service station services in that repairs to applicant's goods, or the installation of applicant's goods as replacements, may be made in opposers' service stations.[5] Also, the "electronic data processing devices" are related to opposers' goods and services; applicant's web page indicates that they are intended to provide a "display on the dashboard" for applicant's devices for monitoring tire pressure. See Exhibit B to opposers' requests for admissions stating that "RDKS® prototype systems come with a

[5] Opposers have submitted a dictionary definition of "service station" with their reply brief. The definition, taken from *Webster's New World Dictionary* (1982), of which we take judicial notice, states in relevant part that a service station is "a place providing maintenance service, parts, supplies, etc. for mechanical or electrical equipment[;] 2. a place providing such service, and selling gasoline and oil, for motor vehicles; gas station." Thus, we find that opposers' service station services include vehicle repair services.

CAN bus LCD display unit and provide options for passing RDKS® readouts to a PC or Laptop thorough a CAN and/or V24 interface ….”

The Board has found in the past that vehicle parts are related to lubricants and service station services. See *International Harvester Co. v. BP Corp.*, 181 USPQ 595, 597 (TTAB 1974) (gasoline, diesel fuel and automotive service stations are closely related to construction vehicles, trucks and parts therefor, stating “there is some relationship between the goods and services of the parties in that purchasers and/or operators of construction equipment and trucks bearing one or more of opposer's marks may well encounter or use one of applicant's ‘PAY-LO’ service stations selling diesel fuel”); *Permatex Co., Inc. v. California Tube Products, Inc.*, 175 USPQ 764, 765 (TTAB 1972) (“engine exhaust system components, namely, headers, header extensions, header flanges, header collectors, mufflers, tail pipes, scavengers and brackets, blocking plates, and header bolts for assembly of such components” are closely related to lubricants – “while the goods of the parties are different in physical characteristics and function, they nevertheless comprise automotive parts, supplies, and accessories that would generally move through the same channels of trade for use by mechanics and others in the automotive after-market field. Under these

circumstances, these products would be encountered by the same individuals under conditions and circumstances that could give rise to confusion as to source if the marks in question are confusingly similar”).

In addition, a relationship between the goods may be shown by demonstrating that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could because of the similarity of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Because there are no specific limitations in the identifications of goods in the application or the identifications of goods and services in the registrations, the issue of likelihood of confusion must be determined by looking at all the usual channels of trade and methods of distribution for the respective goods and services. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Each party’s goods therefore must be presumed to be available to vehicle manufacturers, third party retailers of vehicle after-market parts and retailers who offer vehicle maintenance and repair services, such as

opposers.[6] This presumption is reasonable, in view of the fact that applicant has admitted that its goods and opposers' goods and services "travel in some of the same channels of trade" and "are sold to some of the same classes of consumers." Requests for Admissions Nos. 30 and 31. Therefore, and in view of the similarity of the marks, we find that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could because of the similarity of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer; and that a relationship exists between applicant's International Class 9 goods and opposers' goods and services.

Applicant's International Class 38 services are "telecommunication services, namely, providing multiple-user access to a global computer information network; telecommunication services, namely, providing telecommunications connections to a global computer network." Exhibit F to opposers' requests for admissions describes vehicle systems that provide data to an automobile

[6] Opposers maintain that their lubricants are sold to retail consumers through automotive service stations and automotive parts and accessory stores, and they "are also offered and sold to automotive service stations, automotive repair, installation and maintenance shops and to businesses which own or operate commercial vehicle fleets." Brief at pp. 31 – 32.

manufacturer for coordinating the necessary maintenance work, and a "drive-and-fly function" in which an airline ticket is read and the airline is informed when the passenger is due to reach the airport. The system guides the passenger's car to the departure terminal and a reserved parking space. Additionally, Exhibit F provides that the on-board computer will search for a restaurant, reserve a table or ticket and guide the vehicle to the nearest parking space. From these descriptions, it is apparent that applicant envisions its services as including Internet connections from vehicles. The question thus presented is whether there is a relationship between the goods and services identified in opposers' registrations and such telecommunications services to the extent that they relate to vehicles.

In arguing that the services are similar, opposers contend that "[c]ustomers would readily assume a connection between Opposer and any kind of automotive product or service, regardless of sophistication or nature, if it includes the famous MOBIL designation as part of its name or mark." We disagree. Opposers have not established on the record in this case that MOBIL is a famous mark. See discussion of fame, *infra*. Also, opposers have not introduced any credible evidence showing any similarity

between the goods and services of opposers' registrations and applicant's International Class 38 services.

We next consider applicant's International Class 42 services, namely, "scientific research, research and development of new products for others; technical consultation and research in the field of customized programs for measuring and control system operations in vehicles and aircraft, CAD-CAM programs, and picture processing programs." Because applicant's "scientific research, research and development" services are not limited to any particular field, they may concern lubricants and may include the testing, analysis and evaluation of lubricants. Thus, we find that opposers' testing, analysis, evaluation and reporting services involving lubricants - and hence the trade channels too - overlap with applicant's International Class 42 services. Further, to the extent that applicant's "technical consultation and research services in the field of customized programs for measuring and control systems operations" concern lubricants, such services are related to opposers' lubricants and "computer software used in connection with industrial lubricant analysis and testing." Thus, we find that there is a relationship between applicant's International Class 42 services and the services of opposers' registrations.

Fame

While opposers maintain that Opposers' Marks are famous, they have not introduced evidence directed to any of the usual indicia of fame, such as advertising figures, sales figures, revenues, critical acclaim of any of opposers' products or services, or even survey evidence. See *Kenner Parker Toys, Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). Rather, opposers rely on articles containing references to the renown or fame of opposers' MOBIL mark. The statements regarding fame in such articles are hearsay and hence of limited probative value.

Opposers rely on *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451 (TTAB 1998) in arguing that their evidence of fame is sufficient. Opposers states that *Fossil* "indicates that the 'better practice' is to submit 'newspaper and magazine articles discussing Opposer's … products.' … This is exactly what Opposer has done in this case." Reply at pp. 11 – 12. Opposers misquote *Fossil*, a case in which the plaintiff offered sales and advertising figures without offering evidence that placed such figures in perspective by comparing them to sales and advertising figures for similar goods. The case actually states, "Of course, the better practice is not to rely merely upon sales and advertising

figures, but also to submit, for example, consumer and trade testimony as well as newspaper and magazine articles discussing opposer's FOSSIL products." *Fossil,* 49 USPQ2d at 1457. (Emphasis added.) *Fossil* does not state that "consumer and trade testimony" alone is sufficient to establish fame.

Because opposers have not established the fame of any of their marks, the *du Pont* factor concerning fame is neutral.

Conditions of Sale

As noted above, applicant has admitted that opposers' and applicant's goods and services "are sold to some of the same classes of consumers." Request for Admissions No. 31. Applicant argues that its goods and services are expensive, and that its customers are discriminating purchasers such as automobile manufacturers that can be expected to exercise "greater care" in purchasing applicant's goods and services. Brief at p. 10. Opposers do not contest applicant's contention regarding its purchasers, but counter with "there is no reason to presume that Applicant's goods and Applicant's Mark would be invisible to consumers. Ordinary consumers use sophisticated goods … [and] [o]ne of the main functions of Opposer's service stations is to assist consumers in maintaining and repairing such sophisticated goods." Further, opposers argue that "even if Applicant's

goods and customers are sophisticated, there is no reason to believe that sophisticated customers would never have heard of Opposer's MOBIL trademark." Reply at pp. 8 – 9.

Opposers' arguments miss the mark. First, even if ordinary consumers use sophisticated goods, there is no evidence that ordinary consumers are involved in purchasing decisions regarding such goods. Second, the question before us is not whether sophisticated consumers such as those identified by applicant ever have heard of opposers' marks – which we cannot presume because opposers have not proven fame of their marks – but rather whether purchasers of applicant's goods will likely confuse the source of applicant's goods, believing them to be those of opposers.

Because opposers do not contest applicant's contention regarding its purchasers, and due to the electronic nature of applicant's International Class 9 goods and the technical nature of its International Class 42 services, we presume that purchasers of those of applicant's goods and services which have a connection to vehicles would not include the general public but rather would comprise vehicle manufacturers, mechanics and vehicle repair facilities, and that such purchasers take care and have some level of sophistication in their purchasing decisions. However, even those purchasers who are sophisticated or knowledgeable in a particular field and deliberate in their purchasing

decisions are not immune from source confusion. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). In view of the shared term MOBIL in both parties' marks, we find that the sophistication of purchasers would not diminish the likelihood of confusion with respect to applicant's International Class 9 and 42 goods and services.

Turning to applicant's International Class 38 services, such services of course could be purchased by the general public. Accordingly, we do not presume any sophistication in those who purchase such services. This *du Pont* factor with respect to such International Class 38 services favors opposers.

Variety of Goods and
Services on Which the Mark is Used

Opposers argue that they have used their marks on a wide variety of goods and services and that "it is probable that consumers will attribute the source of other varied products to Opposer." Brief at p. 34. In support of their argument, opposers rely on several of opposers' web pages and registrations, as well as two "Mobil Travel Guides" dated 2000 and 2003.[7] Opposers' evidence – to the extent

[7] We do not accept opposers' contention that they have used their marks on other goods and services described in the Nexis articles of record. Opposers have only relied on hearsay statements

that it is probative – does not reflect use of opposers' marks on a wide variety of goods and services; such evidence reflects that opposers' uses have largely been in the automotive field and in related fields. Consequently, this *du Pont* factor only weighs slightly in opposers' favor.

Absence of Confusion

Opposers have pointed out that applicant has admitted that it is aware of "instances of actual confusion among members of the relevant purchasing public between Applicant's Mark and Opposer's Mark." Request for Admissions No. 29. In its brief, applicant has pointed out that its application is an intent-to-use application and that it has not yet used its mark in commerce. Because there is no evidence of actual use in the United States of applicant's mark, we find that applicant's admission is of limited probative value. This *du Pont* factor hence is neutral in the likelihood of confusion analysis.

Conclusion

After weighing each of the relevant *du Pont* factors, and considering the marks in their entireties, we find that there is a likelihood of confusion as to applicant's International Class 9 and 42 goods and services. Opposers have established that the marks are sufficiently similar,

---

contained within such Nexis articles in support of their contention and no other evidence.

that there is a sufficient relationship between the goods, services and trade channels so that confusion as to source is likely to occur. With respect to the International Class 38 services, we find that opposers have not established a likelihood of confusion, largely because the record does not support a finding that the services are similar to those goods and services of opposers' registrations or that there is a relationship between the trade channels of applicant's services and opposers' goods and services.

Dilution

In order to make out a claim of dilution, a plaintiff must establish that its mark is famous. Section 43(c)(1) of the Lanham Act, 15 U.S.C. §1125(c)(1), provides, so far as pertinent, that "The owner of a famous mark shall be entitled … to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." In fact, fame for likelihood of confusion purposes and for dilution is not the same, and fame for dilution purposes requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). In this case, as discussed above, opposers have not established that their marks are famous

even for purposes of likelihood of confusion. Opposers' dilution claim is therefore dismissed.

DECISION: With respect to the International Class 9 and 42 goods and services, the opposition is sustained and registration to applicant is refused. With respect to the International Class 38 services, the opposition is dismissed and the application will move forward to registration for the identified services in International Class 38. Opposers' dilution claim is dismissed.