

Hearing:
July 11, 2006

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
March 2, 2007
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

General Motors Corporation

v.

ICRC - Integrated Concepts & Research Corp.

Opposition No. 91152661
against Serial No. 76346399

Robert C.J. Tuttle and Hope V. Shovein of Brooks Kushman
P.C. for General Motors Corporation.

Thomas N. Young, Thomas E. Bejin, and Kathleen G. Mellon of
Young & Basile, P.C. for ICRC - Integrated Concepts &
Research Corp.

Before Walters, Bucher and Cataldo, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

ICRC - Integrated Concepts & Research Corp. seeks
registration on the Principal Register of the mark

SMARTRUCK (*in standard character format*) for goods and

services described in the application, as follows:

"armored security vehicle for land use" in
International Class 12; and

"design and engineering services for development of armored security vehicles for others" in International Class 42.¹

General Motors Corporation has opposed registration, asserting that applicant's mark, when used in connection with applicant's goods and services, so resembles marks previously used and registered by opposer, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Specifically, opposer alleges, *inter alia*, that it has used "a family of 'SMART-' based names and marks in connection with its automotive and related business operations" since long prior to any priority date that applicant may claim; that applicant's mark so resembles numerous 'SMART-' based marks and trade names used in opposer's automotive and related businesses, including the allegation that "[a]s early as November 26, 1990, General Motors adopted and used the trademark **SMARTTRAK** for 'combination all-wheel drive and four-wheel anti-lock braking systems for motor land vehicles'" in International Class 12; that "[a]s early as October 1, 1988, General Motors, through its wholly-owned subsidiary General Motors Acceptance Corporation, adopted

¹ Application Serial No. 76346399 was filed on December 7, 2001 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

and has used continuously to [the] present the service mark **SMARTLEASE by GMAC** for 'Automobile Leasing Services, '''; that opposer has "directly or through entities with which it is in privity, used other "SMART-" based names and marks in connection with its automotive and other businesses for intervals of time" prior to any date of priority which applicant may claim; and that the dominant portion of applicant's proposed mark is the word "Smart" and its identified goods and services involve vehicles; and that applicant's "SMART-" based mark so resembles opposer's "SMART-" based marks and trade names in its automotive and related businesses as to be likely to cause confusion, to cause mistake or to deceive. In its answer, while acknowledging the existence of some of opposer's pleaded registrations, applicant otherwise denied the remaining salient allegations in the notice of opposition.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. In support of its case, opposer made of record the testimony of its corporate trademark counsel, Charles H. Ellerbrock, taken on May 16, 2005, with attached exhibits; opposer's

first notice of reliance filed on May 13, 2005, consisting of the following:

Appendix A – Status and title copies of Opposer’s registrations included in the Notice of Opposition, and Amended Notice of Opposition.

Appendix B – Articles retrieved from LEXIS regarding Applicant’s **SMARTRUCK**.

Appendix C – Articles retrieved from LEXIS regarding Opposer’s SMART-based goods and services.

Appendix D – Opposer’s First Set of Interrogatories Nos. 5-10.

Appendix E – Applicant’s Responses to Opposer’s First Set of Interrogatories Nos. 5-10.

Appendix F – Applicant’s Supplemental Responses to Opposer’s First Set of Interrogatories Nos. 5-10.

Appendix G – Applicant’s search report produced in response to Opposer’s Interrogatory No. 8.

Appendix H – Exhibit A, originally included with Opposer’s Brief in Opposition to Applicant’s Motion for Summary Judgment.

Appendix I – Exhibit B, originally included with Opposer’s Brief in Opposition to Applicant’s Motion for Summary Judgment.

Appendix J – Exhibit D, originally included with Opposer’s Brief in Opposition to Applicant’s Motion for Summary Judgment.

Appendix K – Copies of third-party registrations from United States Patent and Trademark Office website, originally included as Exhibit E with Opposer's Brief in Opposition to Applicant's Motion for Summary Judgment;

Opposer's second notice of reliance, filed August 29, 2005, consisting of the following:

Appendix A – An article retrieved from LEXIS regarding opposer's modified Silverado for military use, and

Appendix B – Articles retrieved from LEXIS regarding applicant's use of a GM DuraMax, diesel engine in the SmarTruck II.

Applicant made of record the testimony of Kevin Mulrenin, of applicant's advanced vehicle technologies division, taken July 14, 2005, with attached exhibits; and applicant's notice of reliance, filed July 15, 2005, consisting of the following:

Appendix A – Articles/Books regarding SmarTruck I, II and III, Exhibits 1-24.

Appendix B – Copies of some third-party registrations not owned by General Motors for vehicle parts/services, Exhibits 1-22.

Appendix C – Copy of Registration No. 2837584 for **SMART** for auto services, leasing services, insurance services relating to warranties, and other vehicle related services, said registration not owned by Opposer.

Appendix D – Applications for third-party marks containing the word “Smart” on vehicles and/or vehicle parts and related services, Exhibits 1-7.

Appendix E – Information regarding pending application of DaimlerChrysler AG for “sub-compact automobiles featuring colored exterior body panels which can be changed easily, low fuel consumption, ease of parking, and crash protection comparable to larger cars,” showing that opposer withdrew its opposition with prejudice against the registration of said mark, Exhibits 1-2.



Appendix F – Information from a now-abandoned trademark application.

Appendix G – Information about Trademark Application No. 74734869 for **SMART** (which subsequently issued into Registration No. 3147044), also showing that opposer withdrew its opposition with prejudice against the registration of said mark.

Appendix H – Article about DaimlerChrysler’s **SMART** vehicle relevant to show the existence of a vehicle in the marketplace bearing the mark **SMART** and not associated with opposer, General Motors Corporation.

Appendix I – Recent article about SmartKey for goods related to vehicles owned by a third party.

Appendix J – Applicant’s First Set of Requests to Opposer for Admissions and Opposer’s Responses to these Requests.

Appendix K – Applicant’s First Set of Interrogatories to Opposer, Nos. 1, 2, 4, 5,

6. 7, 8, and 9 and Opposer's Responses to Interrogatories Nos. 1, 2, 4, 5, 6, 7, 8 and 9.

Opposer took Mr. Ellerbrock's rebuttal testimony on August 26, 2005, and submitted this transcript for the record along with the exhibits attached thereto.

Opposer has made of record its pleaded registrations by appropriate identification and introduction during Mr. Ellerbrock's testimony, or by filing a notice of reliance on enumerated registrations, and in both cases, submitting certified copies showing status and title of the following registrations for its "SMART-" based marks:²

² During the prosecution of this opposition, opposer has made reference to an even larger number of applications and registrations for "SMART-" based marks claiming vehicle components, leasing and financing services, dealer incentive programs and warranty/repair services.

For example, in its notice of opposition, opposer claimed Registration No. 1669344 for SMARTTRACK and Registration No. 1815311 for SMARTDRIVE, although both had already been cancelled under Section 8.

Although not claimed in its notice of opposition, opposer, in its testimony introduced Registration No. 1863983 for  [e.g., see Ellerbrock testimony, pp. 19 - 20, Exhibit 16], but it too had already been cancelled under Sec. 8.

In its brief, opposer refers to its application for , which was abandoned, and Registration No. 2102069 for SMARTTOWN, which had already been cancelled under Section 8.

Cancelled or expired registrations and abandoned applications are of no probative value in the determination of likelihood of confusion.

SMARTTRAK	for "combination all-wheel drive and four-wheel anti-lock braking systems for motor land vehicles" in International Class 12; ³
	for "automobile leasing services" in International Class 39; ⁴
SMARTLEASE	for "direct automotive consumer leasing services" in International Class 39; ⁵
SMARTBUY	for "financial services; namely, motor vehicle retail financing plans" in International Class 36; ⁶
SMARTPROTECTION	for "providing extended warranty contracts for motor vehicles" in International Class 36; ⁷
SMART BEGINNINGS	for "motor vehicle financing services" in International Class 36; ⁸

³ Registration No. 2366317 issued to General Motors Corporation on July 11, 2000 based upon a claim of first use anywhere and first use in commerce at least as early as November 26, 1990.

⁴ Registration No. 1610141 issued to General Motors Acceptance Corporation on August 14, 1990 based upon a claim of first use anywhere and first use in commerce at least as early as October 1988; renewed.

⁵ Registration No. 1631111 issued to General Motors Acceptance Corporation on January 8, 1991 based upon claims of first use anywhere and first use in commerce at least as early as October 1, 1988; renewed.

⁶ Registration No. 1742492 issued to General Motors Acceptance Corporation on December 22, 1992 based upon claims of first use anywhere and first use in commerce at least as early as April 24, 1992; renewed.

⁷ Registration No. 2363081 issued to General Motors Acceptance Corporation on June 27, 2000 based upon claims of first use anywhere and first use in commerce at least as early as October 1, 1998; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁸ Registration No. 2940869 issued to General Motors Acceptance Corporation on April 12, 2005 based upon claims of first use anywhere and first use in commerce at least as early as September 1, 2003.

SMARTEDGE	for "computer software namely educational computer programs providing instruction in finance" in International Class 9; "printed instructions and teaching materials all in the field of finance" in International Class 16; ⁹
SMARTLANE	for "arranging and conduction of auctions for used motor land vehicles" in International Class 35; ¹⁰

Factual Findings

Opposer

Opposer General Motors Corporation ("GM") is a large, well-known, global automobile manufacturer and the parent of a wholly-owned subsidiary, General Motors Acceptance Corporation ("GMAC"), which handles, *inter alia*, auction services, along with automobile financing and leasing services, as well as warranty services for purchasers of General Motors' automobiles.

General Motors is the owner of many trademarks for vehicles and vehicle parts. A registration for vehicle parts most relevant to this case is **SMARTTRAK** for

⁹ Registration No. 3083892 issued to General Motors Acceptance Corporation on April 18, 2006 based upon claims of first use anywhere and first use in commerce in both classes at least as early as April 28, 2005.

¹⁰ Registration No. 3206726 issued to General Motors Acceptance Corporation on February 6, 2007 based upon claims of first use anywhere and first use in commerce at least as early as August 2004.

"combination all-wheel drive and four-wheel anti-lock braking systems for motor land vehicles."¹¹ This automatic, always-on system is touted by opposer as being "exceptional."¹² The **SMARTTRAK** system was used by opposer on the Oldsmobile BRAVADA SUV -- a vehicle that is not presently being offered for sale by opposer. In addition to being used in promotional materials, the record shows a badge from the rear of an SUV that appeared to have the term **SMARTTRAK** below the word BRAVADA.

While the majority of the vehicles opposer builds and sells are marketed through dealerships to individual private owners, among opposer's fleet and commercial sales are offerings of speciality vehicles to speciality markets, including homeland security, counter-terrorism, municipalities such as police departments, and the military. Historically, opposer has sold three main vehicles to the United States military services - the Chevrolet Silverado, the Chevrolet Suburban, and the Hummer (Ellerbrock rebuttal

¹¹ See footnote 3, *supra*.

¹² "Bravada beats the blizzard," *Chicago Sun Times*, March 15, 1998 (opposer's notice of reliance, Appendix C); "Bravada has bragging rights to competence," *Morning Call* (Allentown, PA), December 28, 1996. (opposer's notice of reliance, Appendix C). Although not explored during this litigation, we note that the 2003 brochure lists SmartTrak all-wheel drive as a power train option without noting any packaging/combining with the four-wheel anti-lock braking system (Ellerbrock Exhibit #9).

testimony, p. 72). One example of these sales, pictured below, is the Light Service Support Vehicle (LSSV) Cargo/Troop Transport vehicle, based on the Chevrolet Silverado truck platform. The web pages made part of the record were printed out on August 15, 2005 and portray what appears to be a 2006 model. This "LSSV Cargo/ Troop Carrier" is shown with its Enhanced Mobility Package (EMP) and a military package (Code "MCTL"). This military-specific vehicle that opposer has sold to the United States Army includes an M16/M14 weapons rack, NATO-compliant starting components, blackout lighting, tie-downs for air transport, etc. The vehicle is available to the various military services through the United States General Services Administration's (GSA) Federal Supply Service. While the pages from GM's website make clear this is a GM product being marketed through a subsidiary, "GM Defense,"¹³ and the GM bowtie logo is shown in the front grill of the truck, there do not appear to be any other trademarks by which General Motors identifies itself as the source of this vehicle.

¹³ While Mr. Ellerbrock testified that GM Defense had been sold (Ellerbrock rebuttal testimony, p. 72), it is not clear from these exhibits or from Mr. Ellerbrock's testimony when this sale took place, and whether this purported transaction has had any effect on opposer's involvement with the United States Army with regard to the LSSV Cargo/ Troop Carrier military truck program or other military truck programs.

(Ellerbrock rebuttal testimony, p. 46, Exhibit 28;
<http://www.gmfleet.com/>).

LSSV CARGO/TROOP CARRIER

Military Designation: Light Service Support Vehicle, 4X4: Military Tasks: Cargo/Troop Transport

Offered on 4X4 Models	Regular Cab	Crew Cab
GSA Standard	307	
GSA Item#	49.1	57.1
GSA Option Code Required		
Special Traction Differential	D3	D3
Military Package	MCTL	MCTL
Diesel Engine	YD	YD
Additional Option Codes		
Troop Seats	ELFS	ELFS
Enhanced Mobility Package	EMP	EMP
Fiberglass Pickup Cap	FPUC	FPUC
6.5 foot Pickup Box	L6	L6

Shown: 57.1 with EMP, MCTL, and ELFS

GM Defense **GM Fleet and Commercial**
IT ALL ADDS UP.[™]

Based on 2006MY Rev 6-2-2005

(Ellerbrock rebuttal testimony, Exhibit 28).

Opposer also introduced an article from April 2005 about another vehicle on a Chevrolet Silverado platform being leased by opposer to the Army's Research, Development and Engineering Command ("RDECOM"), touted as the "first drivable fuel cell truck." (Ellerbrock rebuttal testimony, Exhibit 30).

Opposer also has a partnership with the United States Army's Tank-automotive and Armaments COMmand ("TACOM"). This arrangement is known as COMmercially Based Tactical

Truck ("COMBATT"). Through COMBATT, GM sells Chevrolet Silverado, heavy-duty pickups that are "remanufactured to Army specifications, that provide mobility, durability, survivability and affordability to the Services. The Army and the Border Patrol in California are currently evaluating this multi-purpose tactical vehicle." (Ellerbrock rebuttal testimony, Exhibit 32).

Accordingly, over the past decade, the record reveals three different programs - ❶ the LSSV Cargo/ Troop Carrier, ❷ a fuel cell truck, and ❸ COMBATT - whereby opposer has supplied specialty, Chevrolet Silverado-based vehicles to the United States Army.

Applicant

In 1999, applicant also contracted with TACOM of the United States Army to build a dual-use vehicle, i.e., combining state of the art technologies with commercial vehicles in a way that would be useful in a military or homeland security environment. ICRC conceived of this sophisticated armored security vehicle, made a proposal requiring Congressional approval, and received a contract from the United States Army to design, engineer and build the vehicle. The program with the Army was administered by

the National Automotive Center ("NAC")¹⁴ and became known as the **SMARTRUCK** program. (K. Mulrenin testimony, pp. 9 - 10). In substantially all the articles placed into the record, the term is usually presented as SmarTruck (upper case letters "S" and "T").¹⁵

The first generation of this vehicle ("SmarTruck I") unveiled in 2001 was based on a Ford F-350 pickup truck:

... [I]t's a SmarTruck capable of shedding terrorists or an angry mob by way of its tack

¹⁴ Other records suggest that given recent military restructuring within the Army Material Command, the NAC became part of the Tank-Automotive Research, Development and Engineering Center ("TARDEC"), located within a new unit known as the Research, Development and Engineering Command ("RDECOM"). See e.g., "SmarTruck unveiled at SAE 2001," by Mara Mucciolo, The United States Army Tank-Automotive Research, Development and Engineering Center, Issue 32, May 2001 (applicant's notice of reliance, Appendix A, Exhibit 8).

¹⁵ See "Vehicle innovations get smar-ter every day," Macomb Daily, February 7, 2001 (applicant's notice of reliance, Appendix A, Exhibit 1); "Not for a Joyride," Time, March 19, 2001 (applicant's notice of reliance, Appendix A, Exhibit 6); "Meet SmarTruck," www.washingtonpost.com/ March 19, 2001 (applicant's notice of reliance, Appendix A, Exhibit 7); "SmarTruck unveiled at SAE 2001," by Mara Mucciolo, periodical of The United States Army Tank-Automotive Research, Development and Engineering Center, Issue 32, May 2001 (applicant's notice of reliance, Appendix A, Exhibit 8); "For True Road Warriors," by Liz Krieger, The Industry Standard, June 18, 2001 (applicant's notice of reliance, Appendix A, Exhibit 11); "Soldier of the Future: with new technology, he might fight like RoboCop, Drive like James Bond," www.ABCNews.com, June 26, 2001 (applicant's notice of reliance, Appendix A, Exhibit 12); "'Bondish' war truck ready for action, say carmakers," by Shelley Emling, The Miami Herald, December 6, 2001 (applicant's notice of reliance, Appendix A, Exhibit 16); "Expanding Military Missions Fuel Market for Custom Trucks," by Sandra I. Erwin, National Defense Magazine, January 2, 2002; (applicant's notice of reliance, Appendix A, Exhibit 17); "Forget the Batmobile: The SmarTruck has it all," Traverse City Record-Eagle, June 4, 2002 (applicant's notice of reliance, Appendix A, Exhibit 19).

spreader, smoke-screener, oil slicker, grenade launcher, armored cladding, run-flat tires, bulletproof glass, pepper-spray blaster, electrified door handles and enough electronic wizardry to navigate, compute and eradicate itself out of any jam its inhabitants might get into.

It's for military police, embassy workers and peace-keeping assignments," said Russell Maze, SmarTruck program manager...¹⁶

and

NON-LETHAL PROTECTION

SmarTruck has an array of nominally non-lethal devices to provide protection to the occupants...

Grenade Launcher

The Grenade Launcher can be used to project nets, including the entanglers/containment devices family of nets, meshes, and the like, to ensnare individuals or vehicles.

Obscurant: Colored smoke concentrations produce greater initial psychological and panic effects than white smoke. This is approximately 40,000 cubic feet of smoke per canister.

Flash-bang grenade: This grenade emits a loud bang and dazzling light, creating a sensory overload which temporarily causes confusion and inability to effectively respond.

Illuminating grenade: The MK1 illuminating grenade, which produces 55,000 candlepower for 25 seconds, which can effectively cause temporary blindness in the center of its illumination zone.

¹⁶ U.S.A. Today, March 9, 2001 (applicant's notice of reliance, Appendix A, Exhibit 5).

Acetylene grenade: This one-pound projectile contains calcium carbide in water. When detonated, a bubble of acetylene gas seven feet in diameter is formed. A concentration of a little as one percent ingested by a diesel engine will cause premature ignition with enough force to break piston rods.

Rubber projectiles

"Rubber" and "PVC" bullets have been used widely by the British in Northern Ireland, and have also been tried by the US military...

Electrical energy

Electric shock devices (stun guns): ...

Ultraviolet Light UV Phaser: ...

Light Energy

Optical Dazzle is a class of devices that emit extremely bright light causing temporary blindness. An eye-safe argon-ion laser beam that can cause disorientation can also be used.

SmarTruck incorporates "dazzling lights" on the front and rear of the vehicle. These lights are controlled in pan and tilt from the touch panels.

Pepper Ball and Spray

...

Acoustic

An acoustic weapon with frequencies tunable all the way up to lethal has been theorized for some time. A California company has reportedly built a device that will make internal organs resonate. The effects can run from discomfort to damage or death. If used to protect an area, its beams would make intruders increasingly uncomfortable the closer they get. Acoustic fields have also

been envisioned for riot control or to clear paths for vehicles.

Electromagnetic heat

A prototype short-range tactical RF (radio frequency) non-lethal weapon has been demonstrated. Energy is concentrated into a beam of micro-millimeter waves that penetrate clothes to rapidly heat moisture particles in the outermost layer of flesh without going deep enough to damage organs. The device reportedly causes no permanent damage to the body or to electronic devices such as pacemakers.

The Marine Corps Vehicle-Mounted Active Denial System, heats a target's skin to approximately 130 degrees Fahrenheit in about two seconds. Humans start to feel pain at 113 degrees Fahrenheit.

High voltage door handles

...

17

The record shows that the second generation prototype of applicant's armored security vehicle, the "SmarTruck II"



(unveiled in 2003) was built on a modified commercial Chevrolet Silverado platform.¹⁸ Like SmarTruck I before it, SmarTruck II

¹⁷ "SmarTruck - A Technology Tool Box for Personnel Safety," by David A. Sloss, National Automotive Center, United States Army Tank-automotive and Armaments Command, presented before the Society of Automotive Engineers, Military and Emergency Vehicles

had many of the same "non-lethal protection" devices, such as obscurants, dazzling lights, crowd-dispersing pepper spray and high-voltage door handles.¹⁹

More than one article in the record mentioned that this vehicle is powered with opposer's DuraMax diesel engine.²⁰ A second rear axle was added so that the vehicle became a six-

Safety, TOPTIC, September 11 - 12, 2001, Tempe, Arizona; applicant's notice of reliance, Appendix A, Exhibit 13.

¹⁸ "Unveiling of SmarTruck II," by Paul D. Mehney, RDECOM magazine, March 2003 (applicant's notice of reliance, Appendix A, Exhibit 21); SmarTruck Demonstration Video (Mulrenin testimony, exhibit 6-A); "U.S. Army puts anti-terrorist truck on road," Financial Times of London, January 8, 2003 (opposer's notice of reliance, Appendix B); Move over James Bond: SmarTruck shows its stuff," Armed Forces Journal, January 1, 2004 (opposer's notice of reliance, Appendix B); "In times of war, Detroit enlists," New York Times, March 30, 2003 (opposer's notice of reliance, Appendix B).

The third generation SmarTruck ("SmarTruck III") was featured in "High Tech Military Truck," Detroit Free Press, on March 9, 2004 (applicant's notice of reliance, Appendix A, Exhibit 23); "A new truck [SmarTruck III] based on Navistar International's 4200 platform, the mammoth off-road capable vehicle makes the Hummer look like an antiquated kid's toy." "SUV thrills Detroit," Windsor Star (Ontario), March 9, 2004.

¹⁹ *Id.*; "ICRC: A modern Company," by Ben Grenn, Alaska Business Monthly, Vol. 19, Issue 9, September 1, 2003 (applicant's notice of reliance, Appendix A, Exhibit 22).

²⁰ "It has a military bearing," Newsday, January 17, 2003 (opposer's notice of reliance, Appendix B); "Detroit Auto Show: The Road Show," Windsor Star (Ontario), January 9, 2003 (opposer's notice of reliance, Appendix B); "ICRC unveils SmarTruck II," ICRCCommunicator, summer ed. 2003; "Army Truck gets SmarTer: Forget Maybach, Bentley and Ferrari. The most expensive vehicle at the North American Auto Show belongs to the U.S. Army," by Brian Corbett, www.wardsauto.com. January 9, 2003; Registration No. 2804683 for the mark DURAMAX for "diesel engines for motor vehicles" issued to General Motors Corporation on January 13, 2004 based upon claims of first use anywhere and first use in commerce at least as early as March 1998, Exhibit 37.

wheeled/three-axle vehicle, able to carry a payload of up to 10,000 pounds.

The rear of the 6X6 vehicle was designed with a modified, receiving frame that accepts multiple combinations of special applications in the form of interchangeable modules/pods.

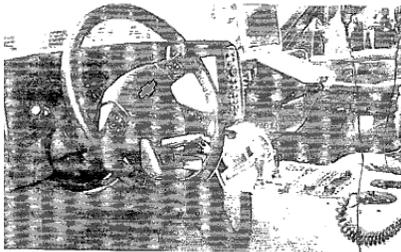
These modules include auxiliary fuel tanks and a generator, sophisticated electronic surveillance equipment, thermal imaging, night vision and video camera systems, and weapon systems such as launchers for guided missiles or a remote-controlled drone.

The exterior was changed significantly, with stainless steel tubing added to the exterior, bulletproof glass in all the windows, and metal bullet-resistant brush guard panels added to the front grille to deflect incoming small arms.

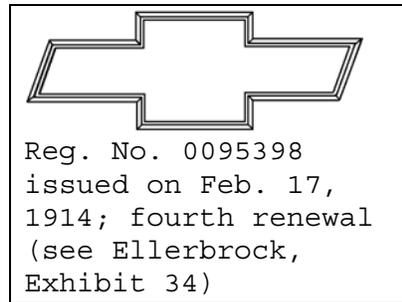
This SmarTruck II vehicle cost more than \$2 million to develop and weighs more than 16,500 pounds. (K. Mulrenin testimony pp. 26 - 28). Various articles published in newspapers and magazines of general circulation included a variety of images of this homeland security and counter-terrorism vehicle. One such article included a view of the

cockpit.²¹ According to the record, this vehicle would also be capable of being configured for community service and humanitarian aid applications such as general security at large events, crowd control, disaster relief and medical response.²² However, the extent to which this program proceeded beyond the prototype stage is not exactly clear

²¹ <http://autoshow.msn.com/autoshow2003/article.aspx?xml=Army>. (opposer's rebuttal testimony, Exhibit 33). While this exhibit



contains a grainy photocopy of a screen print depicting the instrument panel of the SmarTruck II, Chevrolet's "bowtie logo" is barely visible on the



Reg. No. 0095398
issued on Feb. 17,
1914; fourth renewal
(see Ellerbrock,
Exhibit 34)

airbag cover in the center of the steering wheel.

²² As to the range of potential buyers of the SmarTruck II, applicant's witness conceded on cross-examination that customers may well be broader than military and anti-terrorism agencies:

Q: (Opposer's counsel, Mr. Tuttle): "Okay, How about if the Super Bowl Host Committee for 2006 wanted to buy a dozen SMARTRUCK second generation vehicles and gave you a purchase order and a letter of credit on terms and amount that was agreeable to you, would you sell to them?"

A: (Mr. Mulrenin): "Assuming the terms and price were agreeable, we would entertain selling to the Super Bowl Host Committee."

(K. Mulrenin testimony p. 56).

However, we find that it stretches credulity to believe, given the history of this procurement, the cost, size and weight of this vehicle, and the nature of its enumerated payload modules, that there are customers for such a vehicle beyond the U.S. Department of Homeland Security, the U.S. military, other quasi-governmental groups as permitted by law and approved foreign governments.

from the record.²³

Preliminary matters

Before analyzing the merits of this case, we must discuss a preliminary matter by turning to applicant's objections to the Ellerbrock testimony. Applicant's objections on the basis of lack of foundation are overruled inasmuch as opposer has laid a foundation sufficient to admit his testimony. He is competent to testify about any knowledge of facts he acquired in the usual course of his business responsibilities. We find from this evidence that Mr. Ellerbrock, as trademark counsel for GM and GMAC, had personal knowledge, for example, of opposer's ownership and the status of its various registrations.²⁴ This applies as well to the promotion of the services being offered by GMAC under the various "SMART-" based service marks. Moreover, he is certainly competent to authenticate any evidence he personally downloaded from the Internet.

²³ "Two previous versions of the SmarTruck - the first from Ford in 2002, the second [*SmarTruck II*] from GM [*in*] 2003 - were considerably smaller than Navistar [International's 4200 platform 'SmarTruck III'] and were *not operating demonstration vehicles*. (emphasis supplied).

"SUV thrills Detroit," *Windsor Star* (Ontario), March 9, 2004.

²⁴ In fact, Mr. Ellerbrock's name appears on some of these records from the United States Patent and Trademark Office as the named correspondent for opposer's subsisting registrations and pending applications.

However, we agree with applicant that Mr. Ellerbrock's testimony as to the truth of any material seemingly not related to his official responsibilities within the company, e.g., a printout from a website discussing General Motors' conversion of its auto manufacturing facilities in World War II to production for the war effort would be hearsay on his part, and has not been considered. Specifically, it has not been clearly shown that Mr. Ellerbrock had sufficient "personal knowledge" on this topic to satisfy the requirements of Fed. R. Evid. Rule 602.²⁵

As to the dealings of GM with the U.S. Army, an area where applicant has specifically objected to his personal knowledge, we find that the record is not clear.²⁶ Accordingly, in this area, we have given very little weight to Mr. Ellerbrock's testimony.

²⁵ This rule states in relevant part that, "[a] witness may not testify to a matter unless evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter." Fed. R. Evid. 602. The test is whether a reasonable trier of fact could believe the witness had personal knowledge. See Wright & Gold, *27 Federal Practice and Procedure* § 6022 at 193-94.

²⁶ While he testified to first-hand knowledge of patent matters related to the fuel cell truck (Ellerbrock rebuttal testimony, p. 69), he appeared to know little about the COMBATT program (Ellerbrock rebuttal testimony, pp. 70 - 72).

General Motors Corporation Has Standing

With regard to the threshold inquiry as to the standing of General Motors Corporation in this opposition proceeding, opposer has alleged and proven at trial a real commercial interest, as well as a reasonable basis for the belief that opposer would be damaged by the registration of applicant's **SMARTRUCK** mark. Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). General Motors Corporation has presented evidence of its ownership and validity of registrations for the mark **SMARTTRAK** and seven "SMART-" based marks owned by General Motors Acceptance Corporation²⁷ (e.g., , **SMARTLEASE**, **SMARTBUY**, **SMARTPROTECTION**, **SMART BEGINNINGS**, **SMARTEDGE**, and **SMARTLANE**) for leasing and financing goods and services, warranty services and auction services.

Priority

We turn then to the issue of priority in relation to the goods and services set forth in opposer's pleaded registrations. As noted above, General Motors Corporation has established its ownership of valid and subsisting

²⁷ As noted on p. 2, *supra*, General Motors Acceptance Corporation (GMAC) is a wholly-owned subsidiary of opposer, General Motors Corporation (GM).

registrations for eight marks - one for its all-wheel drive and anti-lock braking systems and seven others, through its wholly-owned subsidiary, General Motors Acceptance Corporation, for automobile and financing goods and services, warranty services and auction services.

Therefore, there is no issue as to opposer's priority. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie

Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The goods and services

We turn first to the du Pont factor focused on the relationship of the goods and/or services as described in the application and registrations.

We consider first the goods, "combination all-wheel drive and four-wheel anti-lock braking systems for motor land vehicles," identified in opposer's registration for the mark **SMARTTRAK**. As noted above, opposer introduced into the record a Bravada badge from the rear of an SUV of an unknown model year that appeared to have the term **SMARTTRAK** in much smaller letters and below the word BRAVADA.²⁸ All of the promotional information placed into the record showed that this was used as a mark for a discrete system of the vehicle - not as a product mark for the BRAVADA model SUV.

²⁸ Applicant argues that it is relevant that this system was used by opposer only on the Oldsmobile Bravada SUV -- a vehicle that is not presently being manufactured/offered for sale by opposer inasmuch as GM discontinued the Oldsmobile brand at the end of the 2004 model year. On the other hand, opposer's witness made it clear that **SMARTTRAK** is a GM trademark and could well have been used on other GM sports utility vehicles (Ellerbrock rebuttal testimony, p. 73) like the Chevrolet TrailBlazer or GMC Envoy. In any case, applicant has not counterclaimed to cancel this registration and, thus, any allegations of lack of use of the mark by opposer have not been considered, and we continue to accord this registration all the benefits of Section 7 of the Lanham Act.

There is no evidence in the record that this **SMARTTRAK** system was ever sold as an aftermarket product for later installation in a sports utility vehicle.

As we have seen, opposer does sell vehicles to the United States military, e.g., the Chevrolet Silverado, the Chevrolet Suburban, and the Hummer. However, there is nothing in the record to suggest that it has ever sold Oldsmobile Bravada vehicles or any other model of GM vehicle having the **SMARTTRAK** system. In fact, opposer does not appear to sell, nor does it appear to market, any type of vehicle or vehicle parts to the United States military or any other governmental agency under the **SMARTTRAK** mark or any other "SMART-" signature formatives. (Ellerbrock rebuttal testimony, p. 38).

As we have seen, applicant's goods and services involve heavily-armored, land vehicles. According to the record, the primary sales targets for these goods and services would be organizations like the United States Army and the United States Department of Homeland Security. We find no basis on which to conclude that opposer's combination all-wheel drive and four-wheel anti-lock braking systems are related at all to applicant's goods and services involving heavily-armored, land vehicles. It is certainly much too tenuous a

connection that the **SMARTTRAK** system is historically tied into four-wheel (or all-wheel) drive capability, and that opposer sells four-wheel drive (and all-wheel drive) vehicles to the military (Ellerbrock's rebuttal testimony p. 76).

We turn next to **SMARTEDGE**, the mark in a registration recently issued to General Motors Acceptance Corporation for "computer software namely educational computer programs providing instruction in finance" in International Class 9, and "printed instructions and teaching materials all in the field of finance" in International Class 16.²⁹ This registration for educational software and teaching materials does not even mention a specific automotive-related purpose. Accordingly, we find there is no relationship between these goods and applicant's goods and services involving heavily-armored, land vehicles.

Opposer's notice of opposition alleged that it owned a number of "SMART-" based service marks. The services identified in opposer's registrations for the marks , **SMARTLEASE**, **SMARTBUY**, **SMARTPROTECTION**, **SMART BEGINNINGS**, **SMARTEDGE**, and **SMARTLANE** are for leasing and

²⁹ See footnote 9, *supra*.

financing services, warranty services and auction services. We conclude from this record that opposer offers no automotive engineering or design services under any "SMART-" based mark. Hence, we find that there is nothing in the record that would even suggest that these leasing and financing services, warranty services and auction services are related to the design and sale of heavily-armored, land vehicles identified in the application.

Opposer cites repeatedly to Saab-Scania Aktiebolag v. Sparkomatic Corp., 26 USPQ2d 1709 (TTAB 1993) [applicant's mark 9000 Series for automotive stereo speakers, is likely to cause confusion with opposer's 9000 marks for automobiles, because purchasers of automotive stereo speakers have reasonable basis to expect such goods to originate from common sources if the same or similar mark is used on both automobiles and auto speakers]. However, this case is distinguishable inasmuch as the marks in the instant case are not as similar as 9000 Series and 9000, nor are any of opposer's relevant goods or services as closely related to applicant's goods and services as are automobiles and auto speakers.

Opposer also argues from In re Jeep Corp., 222 USPQ 333 (TTAB 1984) [contemporaneous use of LAREDO for land vehicles

and structural parts therefor, and for pneumatic tires, is likely to cause confusion], and In re Mitsubishi Jidosha Kogyo Kabushiki Kaisha, 19 USPQ2d 1633 (TTAB 1991) [SIGMA for automobiles and structural parts is likely to cause confusion with  for tires], that likelihood of confusion follows whenever similar marks are applied to automobiles and auto components. Again, as was the case in Saab-Scania, *supra*, the marks in the instant case are not as similar as LAREDO / LAREDO and SIGMA / . We also agree with applicant that, unlike the Jeep and Mitsubishi cases, this case does not involve goods as closely related as tires and vehicles. Moreover, it would be inappropriate to apply a *per se* rule regarding likelihood of confusion when similar marks are used in connection with automobiles and auto components.

On the other hand, as discussed earlier, over the past decade, at least three of opposer's programs have involved sales of modified trucks to the United States Army. These were all based on the Chevrolet Silverado truck platform, as was applicant's SmarTruck II. In fact, opposer's COMBATT program and applicant's SmarTruck program are described as being complementary in one article placed into the record by applicant:

The Smart Truck [sic] is one of two complementary programs that the NAC hopes will lead the way toward a new light tactical truck for the U.S. army and other military services. The second program is called the commercially-based tactical truck, or COMBATT.

The Combat [sic] and the Smart [sic] programs are "brothers and sister," said Fuller. "Our vision is to combine the successes of each program and come up with one platform.

Unlike Smart Truck [sic], the Combatt is more focused on vehicle mobility, ruggedness for off-road operation and the use of hybrid-electric propulsion systems, for higher fuel efficiency.³⁰

However, as noted earlier, opposer has not marketed any vehicles under a "SMART-" based mark, opposer has not used any "SMART-" based marks in connection with sales of auto components to the United States military or any other governmental agency, and opposer has offered no engineering or design services under a "SMART-" based mark. Even if opposer's armored vehicles offered to the United States Army may bear some superficial resemblance to applicant's SmarTruck II prototype, i.e., both may be designed to carry offensive weapons and both may be built on the same modified Silverado truck platform - even if applicant's SmartTruck II

³⁰ "Expanding Military Missions Fuel Market for Custom Trucks," by Sandra I. Erwin, *National Defense Magazine*, January 2, 2002; (applicant's notice of reliance, Appendix A, Exhibit 17).

has the Chevrolet "bowtie logo" visible on its steering wheel - the fact that opposer has never used a "SMART-" based mark in connection with any of these goods and services makes these facts irrelevant to our consideration of trademark likelihood of confusion.

Having found no relationship between opposer's goods and services and applicant goods and services, we find that this factor strongly favors applicant.

Trade channels

We turn then to the du Pont factor focused on the similarity or dissimilarity of established, likely-to-continue trade channels.

Applicant intends to sell military or para-military vehicles. This type of vehicle is not something a private citizen would be able to purchase at a private auction or automobile dealership. (K. Mulrenin testimony, p. 14). Certain offensive features of applicant's goods (e.g., grenades and guided missiles) would be illegal for the would-be private consumer even to purchase. (K. Mulrenin testimony, p. 58).

To the extent opposer's **SMARTTRAK** mark has been used in connection with its all-wheel drive and anti-lock braking

systems, presumably the majority of these systems were manufactured and shipped directly to GM's Oldsmobile assembly plants.³¹ In the event that these drive/braking systems are available under this mark as aftermarket replacement systems/parts, this would presumably involve shipment to GM and Chevrolet dealerships that continue to repair vehicles sold under the Oldsmobile brand, or marketing through retail auto parts stores carrying such parts.

As such, there is virtually no overlap in the trade channels of these parties, and this factor favors applicant's position herein.

Conditions of sale

As to the conditions under which and buyers to whom sales are made, this is a strong factor against finding likelihood of confusion herein. Applicant's goods are sophisticated and expensive. As the record shows, ICRC conceived of this sophisticated armored security vehicle, made a proposal requiring Congressional approval, and received a contract from the United States Army to design, engineer and build the **SMARTRUCK** vehicle. As to the

³¹ As seen *supra*, footnote 28, this specific stream of commerce may well have ended.

expense of these vehicles, the cost of the prototype vehicles was in the neighborhood of \$2 million.

(K. Mulrenin testimony, p. 16). The record shows that later purchasers of applicant's goods/services (e.g., including any sales of similar vehicles to disaster relief and medical response organizations) would be expected to pay a six-figure price tag for each of these vehicles (even without any of the offensive weapons).³² They would all be knowledgeable and sophisticated purchasers. Hence, we conclude it is unlikely that they would ever associate opposer's **SMARTTRAK** internal drive and braking system found in the past on the Oldsmobile Bravada with applicant's **SMARTRUCK** security vehicle or with applicant's **SMARTRUCK** services to design/engineer such a security vehicle.

The marks

We turn then to a consideration of the similarity or dissimilarity of the marks in their entireties as to

³² "... The Army says SmarTruck II's could be produced in a few months with cost of the basic platform being about \$100,000." "It has a military bearing," Newsday, January 17, 2003 (opposer's notice of reliance, Appendix B); "... The brain, flatbed and vehicle together are estimated to cost about \$100,000, [Ms. GerMaine Fuller-Simms] said. The additional modules, which will constitute the 'lion's share' of the expense, will vary in price." "Army Unveils its Latest Technology-Laden 'SmarTruck II Prototype,'" Inside the Army, January 13, 2003.

appearance, sound, connotation and commercial impression. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). We begin by considering opposer's **SMARTTRAK** mark. While opposer argues that "the terms TRUCK and TRAK are so similar in sound and appearance, differing only by two letters, as to be considered virtually identical," applicant contends that the marks **SMARTRUCK** and **SMARTTRAK** are clearly not identical as they neither look the same nor sound alike.

Both marks are nine letters long, they are both pronounced as two-syllable words and both have a similar cadence. However, while the marks have similarities in appearance and sound, they are certainly not identical.

The first five letters of both marks consist of the same word, "Smart." We agree with opposer that despite the telescoped nature of applicant's mark, it is likely to be perceived by prospective purchasers as a combination of the words "Smart" and "Truck" [not "Smar-Truck" or "Smart-Ruck" (applicant's Brief, p. 14.)], and "[r]egardless of how applicant characterizes it, the mark **SMARTRUCK** is clearly associated with the term SMART." (Opposer's reply brief, pp. 3 - 4)

In fact, both **SMARTTRAK** and **SMARTRUCK** have similar, suggestive connotations in connection with the goods and services set forth in the application and the goods specified in opposer's **SMARTTRAK** registration. In the context of both applicant's armored vehicles and opposer's drive and anti-lock braking systems, the word "Smart" carries the suggestive connotation of "intelligent" or "having some computational ability of its own ... [s]mart devices usually contain their own microprocessors or microcomputers."³³ It is clear from the descriptions of applicant's armored vehicles and opposer's drive and anti-lock braking systems contained in the record that the respective goods are "smart" - i.e., that the respective goods or parts thereof contain their own microprocessors.

We find that given the highly suggestive nature of the term "Smart" with respect to the respective goods, and the fact that it is the first portion of these two-component marks, prospective purchasers would be likely to look to other portions of the composite marks to find distinguishing matter. While arguably, in each case, this second

³³ We take judicial notice of the above-noted definition of "smart" from WEBSTER'S NEW WORLD DICTIONARY OF COMPUTER TERMS (3rd ed.). University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

syllable/word is also suggestive of the respective goods and/or services, the connotations of "Truck" and "Trak" (which is clearly equivalent to the word "Track") are quite different. Additionally, as we note in our discussion about the number and nature of similar marks registered in connection with similar goods and services, *infra*, purchasers in the fields of vehicles, vehicle components and related automotive services, upon seeing a composite mark containing the word "Smart," are likely to look to other portions of the mark, which are quite different in connotation, to find distinguishing matter. Thus, despite the similarities in the marks occasioned by both marks beginning with the term "Smart," we find that the differences in the connotations and overall commercial impressions of the marks **SMARTTRUCK** and **SMARTRAK** weigh against finding that the marks are substantially similar.

The remaining registrations having a "SMART-" formative mark that opposer has placed into the record pertain to various services. None of these marks is similar to **SMARTTRUCK** in sound or appearance. As to connotation, in the context of these enumerated services, the word "Smart" suggests that the customer who leases or finances a GM vehicle through GMAC, purchases GMAC warranties or shops at

its auctions is very savvy, i.e., "smart" connoting a wise shopper,³⁴ rather than suggesting "intelligent" in the sense of having microprocessors or rapid computational ability. We find that this connotation causes these service marks to be even less similar in commercial impression to applicant's **SMARTRUCK** mark than is **SMARTTRAK**.

Finally, particularly in view of the significant differences between the involved goods and services, as discussed *supra*, the marks are not sufficiently similar for confusion as to source or sponsorship to be likely.

Fame of SMARTTRAK mark

We turn next to the alleged fame of the **SMARTTRAK** mark for the goods identified in opposer's registration. While the record contained a photograph of a badge allegedly attached to the rear of an Oldsmobile Bravada SUV on which the mark **SMARTTRAK** appeared (Ellerbrock rebuttal testimony, Exhibits 10A - 10D), we have no information about the total volume of sales of the **SMARTTRAK** drive and braking component, or how prominently this mark was actually used in

³⁴ "Today's savvy shoppers know that not only is SmartLease an affordable way to drive the new GM vehicle they want ..."

...

"Leasing is a 'SMART' idea if you want ..."

(Ellerbrock Exhibit #23).

connection with Oldsmobile Bravada vehicles over the years, the actual length of use, the volume of advertising directed to this feature specifically, etc. Hence, we do not conclude that opposer's **SMARTTRAK** mark is famous in connection with combination all-wheel drive and four-wheel anti-lock braking systems for motor land vehicles.

Strength of marks

In support of its position that the word "Smart" is a weak portion of marks pertaining to vehicles, vehicle parts and vehicle services, applicant has offered into the record multiple "SMART-"based marks registered by third parties for vehicles, vehicle parts and vehicle services:

SMART SWITCH	for "electronic sensors in control circuits for automobile sunroofs" in International Class 9; ³⁵
SMART ALARM	for "anti-intrusion alarms for vehicles" in International Class 12; ³⁶
TURN SMART	for "vehicle signal indicators" in International Class 12; ³⁷

³⁵ Registration No. 2745995 issued to Inalfa Sunroofs USA, LLC on August 5, 2003 based upon claims of first use anywhere at least as early as August 8, 1991 and first use in commerce at least as early as February 12, 1992. The word "Switch" is disclaimed apart from the mark as shown.

³⁶ Registration No. 2688029 issued to Electronic Controls Company on February 18, 2003 based upon claims of first use anywhere and first use in commerce at least as early as November 15, 1994. The word "Alarm" is disclaimed apart from the mark as shown.

SMARTBELT

for "inflatable belt restraint systems, for personnel for use in vehicles, comprised of air bag(s), restraint belt(s), guide tube(s), and inflator(s)" in Int. Class 12;³⁸

smart(P)ark

for "automobile driver control products, recreational vehicle control products and heavy duty truck driver control products namely, brake actuators, brake controller, brake solenoids, electronic park brake devices namely, park brake actuators, park brake controllers, park brake sensors, park brake solenoids" in International Class 9;

"automobile driver control products, recreational vehicle control products and heavy duty truck driver control products namely, park brake cables, park brake housings, park brake equalizers, park brake motors, park brake switches" in Int. Class 12;³⁹

SMART RIDE

for a "service program for financing cars" in International Class 36;⁴⁰

THERMO SMART

for "land vehicle accessories; namely hydraulic heat exchangers and

³⁷ Registration No. 2851361 issued to Auto Care Products, Inc. on June 8, 2004 based upon claims of first use anywhere and first use in commerce at least as early as November 4, 2003.

³⁸ Registration No. 2654708 issued to Goodrich Corporation on November 26, 2002 based upon claims of first use anywhere and first use in commerce at least as early as April 2, 2002.

³⁹ Registration No. 2960151 issued to Dura Automotive Systems, Inc. on June 7, 2005 based upon claims of first use anywhere and first use in commerce in both classes at least as early as January 31, 2005.

⁴⁰ Registration No. 2789396 issued to Fifth Third Bancorp on December 2, 2003 based upon claims of first use anywhere and first use in commerce at least as early as May 2, 2003.

	engine oil coolers" in Int. Class 12; ⁴¹
SMART START	for "automobile dealership services featuring previously owned cars and trucks" in International Class 35; ⁴²
SMART WAX	for "automobile wax" in Int. Class 3; ⁴³
SMART REPAIRS	for "automobile body repair and finishing for others, upholstery repair, and glass windshield replacement" in Int. Class 37; ⁴⁴
SMARTCARS	for "retail sales of automobiles via auto dealerships" in Int. Class 42; ⁴⁵
SMART-MAT	for "cargo mats made of rubber and/or plastic for the cargo area of a vehicle" in International Class 27; ⁴⁶

⁴¹ Registration No. 1795785 issued to Electric Fan Engineering on September 28, 1993 based upon claims of first use anywhere and first use in commerce at least as early as June 19, 1992; renewed.

⁴² Registration No. 2695464 issued to Hall Auto World, Inc. on March 11, 2003 based upon claims of first use anywhere and first use in commerce at least as early as February 8, 2002.

⁴³ Registration No. 2819866 issued to Smart Marketing on March 2, 2004 based upon claims of first use anywhere at least as early as January 5, 2003 and first use in commerce at least as early as January 9, 2003. The word "Wax" is disclaimed apart from the mark as shown.

⁴⁴ Registration No. 2661132 issued to Ronald W. Hope on December 17, 2002 based upon claims of first use anywhere and first use in commerce at least as early as July 1, 1999. The word "Repairs" is disclaimed apart from the mark as shown.

⁴⁵ Registration No. 1746163 issued to Smart Cars, Inc. on January 12, 1993 based upon claims of first use anywhere and first use in commerce at least as early as September 1988; renewed.

⁴⁶ Registration No. 2160968 issued to Loadhandler Industries, Inc. on May 26, 1998 based upon claims of first use anywhere and first use in commerce at least as early as July 7, 1997; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

SMART DEAL NETWORK	for "automobile dealership services" in International Class 42;
SMARTBED	for "recreational vehicles; namely, camper-trailers, vacation/travel trailers, fifth-wheel trailers, truck campers, motor homes, and pickup truck canopies" in International Class 12; ⁴⁷
SMART FIRE	for "automobile engine electronic ignition module" in Int. Class 7; ⁴⁸

Applicant has also included copies of a trademark application from the United States Patent and Trademark Office, along with related records of an opposition brought against DaimlerChrysler by the opposer herein, for the mark **SMART** for "sub-compact automobiles featuring colored exterior body panels which can be changed easily, low fuel consumption, ease of parking, and crash protection comparable to larger cars." (Applicant's Notice of Reliance, Appendix B and Appendix G).⁴⁹ Applicant also

⁴⁷ Registration No. 3021873 issued to Western Recreational Vehicles, Inc. on November 29, 2005 based upon claims of first use anywhere and first use in commerce at least as early as July 14, 2005.

⁴⁸ Registration No. 2265381 issued to Adrenaline Research, Inc. on July 27, 1999 based upon claims of first use anywhere and first use in commerce at least as early as November 1995; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. The word "Smart" is disclaimed apart from the mark as shown.

⁴⁹ Application Serial No. 74734869 was filed on September 27, 1995 by MercedesBenz A.G. [This application was later assigned to DaimlerChrysler AG and then to a subsidiary, SMART G.m.b.H.]. General Motors opposed this application on July 22, 2002 [Opposition No. 91153626]. On April 13, 2005, this opposition was

introduced a newspaper article showing that DaimlerChrysler's / SMART G.m.b.H.'s **SMART** vehicle continues to be shown at auto shows with a likely prospect for future sales in the United States. (Applicant's Notice of Reliance, Appendix H).

We agree with applicant that opposer has failed to show any common law rights or registrations for the mark SMART alone for vehicles, vehicle parts and vehicle services. Applicant argues that DaimlerChrysler's being issued a relatively recent registration for services identical to those claimed by opposer undermines the foundation of opposer's argument of likelihood of confusion herein.⁵⁰

dismissed with prejudice. Registration No. 3147044 issued on September 26, 2006 under Section 44(e) of the Act based on German registration no. 39514027.

⁵⁰ On May 4, 2004, Registration No. 2837584 issued to DaimlerChrysler AG, a related company to the owner of the **SMART** registration for vehicles [Registration No. 3147044]. While acknowledging that these registrations are *not* based on use in the United States, applicant argues that opposer's failure to oppose this registration for **SMART** alone for, *inter alia*, the following leasing and other vehicle-related services further weakens opposer's position in this case:

"referrals in the fields of auto care services, automobile leasing, automobile parking and automobile transportation; invoicing service in the field of automobiles to replace leased or rental automobiles" in International Class 35;

"insurance services, namely underwriting extended warranty contracts in the field of automobiles; insurance administration in the field of automobile insurance" in International Class 36;

With particular focus on the word "Smart" in connection with vehicles and vehicle parts, a registration for vehicles and vehicle-related services by one of opposer's major competitors, when added to the listing of successfully registering "SMART-" based marks listed above for some of the same types of goods, we find that the word "Smart" is not a strong formative in the field of vehicles and vehicle parts, and that also supports a finding herein of no likelihood of confusion.

Opposer's "family of marks" claim

The final du Pont factor on which opposer has placed a great deal of emphasis is the variety of goods and services on which its "SMART-" based marks are allegedly used. As noted earlier, opposer claimed in its notice of opposition "that it has used "a *family* of 'SMART-' based names and marks in connection with its automotive and related business operations." Then, in its final brief, opposer refers to

"auto care services, particularly, cleaning, maintenance and repair of automobiles" in International Class 37; and

"leasing of automobiles, automobile parking, transportation of passengers by automobiles, and transportation of goods and automobiles by trucks" in International Class 39.

"Smart" as its "signature formative."⁵¹

Accordingly, we turn to opposer's contention that it owns a family of marks, raising the term "Smart" to the level of a GM "signature formative."

This doctrine has applicability in those situations where the opposer had established a family of marks characterized by a particular feature, so that the applicant's subsequent use of its mark containing the feature will cause the relevant purchasing public to assume that applicant's mark is yet another member of the opposer's family. See Blansett Pharmaceutical Co. Inc. v. Camrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992) [defendant's alleged "NOL-" prefixed family of marks for pharmaceutical products is not relevant]; Econo-Travel Motor Hotel Corp. v.

⁵¹ "Applicant also takes issue with Opposer's reference to its 'signature formative' stating that Applicant is unaware of its meaning in trademark law. However, 'formative' is commonly used in trademark jargon to refer to multiple forms of a mark with a common prefix or word. See MCCARTHY ON TRADEMARKS § 23:61 (2005) [discussing the 'family' of marks doctrine, a relevant enquiry is the extent in which the family has been promoted 'to create an association of common origin for all marks containing the family *formative* or "surname"']. Opposer is clearly referencing this particular formative – SMART – as a GM signature. See Opposer's Main Brief, p. 12 ('the "SMART" formative has become a signature of GM (and its wholly-owned subsidiary, GMAC) in the automotive industry'). Therefore, Opposer's repeated reference to its 'signature formative' is not such a stretch of typical trademark language as to render Applicant confused."

(Opposer's reply brief, p. 4).

Econ-O-Tel of America, Inc., 199 USPQ 307 (TTAB 1978)

[opposer failed to show "ECONO-" family in ECONO-TRAVEL, ECONO LODGE AND SANDY ECONO]; and Porta-Tool, Inc. v. DND Corp., 196 USPQ 643 (TTAB 1977) [opposer failed to establish a "PORTA-" family of marks].

It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar goods or related goods or services is insufficient to establish, as against an applicant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to applicant's first use of its challenged mark, the various marks said to constitute the family, or at least a good number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. See J & J Snack Foods Corp. v.

McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir.

1991) [^{MCDugal}**MC**Pretzel likely to be confused with well-known

McDonald's family of marks]; Truescents LLC v. Ride Skin Care LLC, 81 USPQ2d 1334 (TTAB 2006) [opposer fails to establish ownership of a family of GENUINE marks for skincare

products]; Hester Industries Inc. v. Tyson Foods Inc., 2

USPQ2d 1645 (TTAB 1987) [opposer cannot acquire family mark

in CHIK'N for chicken]; American Standard, Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978) [no showing of family of marks as purchasers would not be likely to regard the term AQUA as a source identifying factor for water faucets]; and Cambridge Filter Corp. v. Sensodyne Corp., 189 USPQ 99 (TTAB 1975) [opposer has not demonstrated a family in the suffix CAP or FLO in the air filter field]; and Ft. Howard Paper Co. v. Nice-Pak Products, Inc., 127 USPQ 431 (TTAB 1960) [no NAP family of marks for napkins].

We find that opposer has not proven that it has a family of SMART marks. The evidence introduced by opposer consists of copies of its registrations for the marks  , **SMARTLEASE**, **SMARTBUY**, **SMARTPROTECTION**, **SMART BEGINNINGS**, **SMARTEDGE** and **SMARTLANE**; articles retrieved from LEXIS/NEXIS regarding opposer's "SMART-" based goods and services; and a large number of promotional materials for individual "SMART-" based products. There are numerous examples in brochures and web pages where multiple "SMART-" based marks are used on the same page. For example, pages on opposer's website group together its "Smart Products," listing "SmartLease by GMAC," "SmartLease Plus" and

"SmartBuy." Further down the page are listed "SmartCare" and "SmartNotes."⁵²

However, we note that the first use of marks such as **SMART BEGINNINGS**, **SMARTEDGE**, and **SMARTLANE** occurred after applicant's filing date. In its use of other "SMART-" based marks, opposer often emphasizes the highly suggestive nature of the mark in the context of a "savvy" consumer being drawn to opposer's SmartLease services, etc. In most cases, there are additional bulleted programs, or items in seriatim listings, that do not share the "SMART-" formative. Specifically, we find that opposer has failed to design its promotional brochures and web pages in a way that highlights this allegedly common surname.

In any event, opposer's strongest case for demonstrating that it has advertised and used its marks as a family of "SMART-" based marks is in the field of automobile financing and leasing services. However, the existence of a "SMART-" surname in the field of automobile financing and leasing services would not necessarily enhance opposer's claim of likelihood of confusion inasmuch as these services are too far afield from applicant's goods and services

⁵² <http://209.61.155.43/moframes/division/gmac/products/g200.htm>, (opposer's first Notice of Reliance, Appendix I, Bates GM00000047).

(involving heavily-armored, land vehicles) to tilt the balance of du Pont factors in opposer's favor.

Furthermore, while we need not reach the issue of whether the word "Smart" is sufficiently distinctive to serve as the surname for a family of marks in automotive-related fields, we note the marketing environment in which opposer finds itself, as seen, *supra*, when the focus was on the number and nature of similar marks registered and used in connection with related goods and services. We saw numerous third-party registrations demonstrate other "SMART-" based marks registered in connection with vehicles, vehicle parts and vehicle services. Applicant has also shown from publications "SMART-" based marks in use in the marketplace.⁵³

⁵³ For example, applicant submitted articles referring to third-party uses of vehicles or vehicle related goods:

- o From applicant notice of reliance, Appendix H, an article about DaimlerChrysler's SMART vehicle:

SMART. Although the name is a head-scratcher to most consumers, these eight-foot minis will certainly attract attention if they end up on U.S. highways.

Intended for urban use, the smallest Smart car is capable of 84 mph and gets about 50 miles per gallon, spokeswoman Julia Knittel says.

The DaimlerChrysler unit will display its lineup for the first time at the North American International Auto Show in Detroit next month, although no date has been set for U.S. sales.

"Carmakers hope small will ride tall again in USA," by Chris Woodyard, U.S.A. Today, December 26, 2004.

Given these extensive third-party claims in these automotive-related fields, opposer is faced with a formidable challenge in attempting successfully to make "SMART-" into its surname in the field of vehicles, vehicle parts and related automotive services. In this context, we find that there is insufficient evidence relating to opposer's use and advertising of its marks together such that we can conclude that the relevant purchasing public has come to recognize "SMART-" as the "surname" of a family of opposer's marks. Therefore, we must determine the issue of likelihood of confusion based upon the individual marks that are the subject of opposer's registrations.

Opposer's burden of proof herein

Opposer, as the plaintiff herein, had the burden of showing a likelihood of confusion by a preponderance of the evidence. We agree with applicant that opposer has failed to prove it will be damaged by registration of applicant's **SMARTRUCK** mark, citing to Chase Brass & Copper Co.

-
- o From applicant's notice of reliance, Appendix I, an article about SMARTKEY for electronic security and ignition systems for cars having a proximity chip.

"They call it 'SmartKey" - but it's a stupid idea," by Mark Rehtin, Automotive News, May 16, 2005.

Incorporated v. Special Springs, Inc., 199 USPQ 243

(TTAB 1978.) [BLUE DOT springs for aftermarket automotive distributors (a finished product) not likely to be confused with BLUE DOT and design (at right)



for brass rods sold to various manufacturers including those in the automotive industry (a semi-finished product) as there is no evidence to show that the same persons will purchase or come into contact with the goods of applicant and opposer].

Applicant's argues this point as follows:

The Board in Chase Brass & Copper, supra, found that Special Springs could register BLUE DOT for springs used as part of vehicle ignition systems despite the existence of Opposer's BLUE DOT mark used for brass rods to make automatic components. The Board noted that Applicant's goods were used in the timing of electrical energy transmitted from the distributor to the spark plugs; the Opposer's goods were used to manufacture parts incorporated into automobile components such as carburetors. The Board believed the actual purchasers would be different, although both may be from the same automotive company. The purchasers of the Applicant's springs would be engineers and would be highly skilled and knowledgeable about what products they were selecting. Association between the goods, even bearing an identical mark, would not be expected.

Applicant's brief, pp. 16 - 17. We agree with applicant's assessment inasmuch as the instant case does not involve identical marks, the marks herein are

both somewhat suggestive but have different connotations and commercial impressions, and the goods and services are more distantly related than is the case in Chase Brass & Copper.

Conclusion:

After weighing all of the relevant du Pont factors, we find that opposer has failed to meet its burden of proof in demonstrating a likelihood of confusion herein. Applicant's involved goods and services are not related to the goods and services identified in opposer's registrations for "SMART-" based marks. Conversely, any of opposer's traditional goods or services that may be related in some way to applicant's goods and/or services are not proffered under a "SMART-" based mark. Even if the goods and services were more closely related than we have found them to be, the involved marks are not confusingly similar given the apparent weakness of the "SMART-" formative in the fields of vehicles, vehicle parts and vehicle services, compounded by the difference in connotation between **SMARTTRAK** and **SMARTRUCK**. We have seen that both parties' relevant *goods* are expensive and will be moving in significantly different and generally discrete channels of trade to sophisticated consumers. Similarly, *applicant's services* are expensive and will only

be offered to the most sophisticated of customers. While opposer clearly offers automotive-related services to ordinary consumers, the *services* covered by its SMART-formative service marks *are not related to applicant's goods and/or services*.

Hence, we find that opposer, as plaintiff in this action, has not met its burden of demonstrating that there is a likelihood of confusion herein.

Decision: The opposition is dismissed and the application will be forwarded for the issuance of a notice of allowance in International Classes 12 and 42.