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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Hearing:  
January 18, 2001

Paper No. 12  
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mack Trucks, Inc.

Serial No. 75/386,729

Serial No. 75/606,017

Cynthia Clarke Weber of Sughrue, Mion, Zinn, Macpeak & Seas for  
Mack Trucks, Inc.

Matthew J. Pappas, Trademark Examining Attorney, Law Office 104  
(Sidney Moskowitz, Managing Attorney).

Before Seeherman, Hairston and Holtzman, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Mack Trucks, Inc. has filed applications to register the  
marks VISION<sup>1</sup> and VISION BY MACK,<sup>2</sup> both for "trucks."

The Trademark Examining Attorney has refused registration  
under Section 2(d) of the Trademark Act on the basis of the

<sup>1</sup> Application Serial No. 75/386,729; filed November 7, 1997 alleging a  
bona fide intention to use the mark in commerce.

<sup>2</sup> Application Serial No. 75/606,017; filed December 15, 1998 alleging a  
bona fide intention to use the mark in commerce.

registered mark VISION for "beverage delivery trailers."<sup>3</sup>

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was held.

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks, the strength of the marks, and the relatedness of the goods or services.

Turning first to the marks, it is the Examining Attorney's position that the marks are similar in sound, appearance, connotation and commercial impression. The Examining Attorney argues that the dominant portion of each mark is the word VISION and that the addition of applicant's corporate name to the registrant's mark does not overcome the similarity. The Examining Attorney maintains that the third-party registrations introduced by applicant are entitled to little weight on the issue of likelihood of confusion because those registrations are not evidence of use or that the public is familiar with the marks therein.

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<sup>3</sup> Registration No. 1,256,028; issued November 1, 1983; combined affidavit under Sections 8 and 15 filed.

Applicant's mark VISION (in the '729 application) is identical to the mark in the cited registration. Moreover, applicant's related mark VISION BY MACK incorporates the registered mark in its entirety. Even with the additional wording, the marks convey similar meanings and create similar overall commercial impressions.

We are not persuaded by applicant's argument that the term MACK, as a famous trademark and the subject of a number of federal registrations, is the dominant component of VISION BY MACK and outweighs the commercial impact of VISION in the composite mark. First, the addition of the term BY MACK to the mark fails to change the meaning or commercial impression conveyed by the term VISION in the registered mark and the meanings of the two marks remain essentially the same. Even the fame of the term MACK, if shown, would not overcome the likelihood that the two marks would be confused because the MACK name would do nothing to prevent consumers from mistakenly assuming, when the marks are used in connection with related goods, that registrant is somehow associated with applicant or that there is at least some relationship between them. Moreover, it is generally held that the addition of a house mark or other such matter to one of two otherwise similar marks will not serve to avoid a likelihood of confusion. See, e.g., *In re Pierce*

Foods Corporation, 230 USPQ 307 (TTAB 1986); and In re Dennison Manufacturing Company, 220 USPQ 1015 (TTAB 1983).

Applicant claims that "the fact that so many VISION marks have been permitted to coexist on the Principal Register" shows that VISION is a "weak, diluted mark," and thereby entitled to only a limited scope of protection. Applicant argues (without support) that there are over 1500 current federal registrations for VISION marks "in all classes of goods and services." Applicant has also relied on copies of seventeen use-based third-party registrations (including the cited registration) to show that VISION marks "for closely related or identical goods...coexist" in the vehicular field. We note, in particular, applicant's claim that

"The most telling example of this is that VISION for 'beverage delivery trailers' currently coexists on the Federal Register and in practice with NEW VISION for 'towable trailers' [Registration No. 2,216,807]" (Brief p.5).

Based on applicant's characterization of the goods in this manner, applicant goes on to argue that "[beverage delivery trailers" and "towable trailers"] are, for all intents and purposes, identical, since beverage delivery trailers are 'towable trailers.'" Relying on *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974), applicant argues that the third-party registrations

are entitled to the assumption that the marks therein have been placed in use. Applicant further argues that consumers are conditioned to such use, and that therefore "consumers have learned to distinguish between the various VISION marks, either on the basis of minor differences in the marks, or differences in the goods." Applicant concludes that the owners of all the registered VISION marks in the vehicle field do not believe there is a likelihood of confusion "and they all peacefully coexist" in the marketplace.

There are several problems with applicant's reasoning. To begin with, the factor to be considered in determining likelihood of confusion under *du Pont* is the number and nature of similar marks "in use on *similar* goods" (emphasis added). See *In re E.I. du Pont de Nemours & Co.*, *supra*. Thus, the alleged existence of some 1500 registrations for "vision" for "all classes of goods and services," even if true, is irrelevant to the question of whether the marks applied to the goods involved herein are likely to cause confusion.

Nor does it matter that third-party marks "coexist on the register." The relevant consideration is whether those marks are in use for similar goods, and third-party registrations are not evidence of use of the marks therein. In this regard, applicant has misapplied the principles of *Massey* to the present case. That case involved an appeal from a decision of the Board in a

cancellation proceeding. The Court stated, inter alia, that "a holder of a registered mark enjoys the benefit of his certificate as prima facie evidence of...his continued use of the mark...." (*Supra* at 274). Clearly, only the owner of a registration is entitled to rely on the evidentiary presumptions accorded a registration. See *In re Hester Industries, Inc.*, 231 USPQ 881 (TTAB 1986). Those registrations, when relied on by anyone other than the owners thereof, do not establish that the marks shown therein are actually in use, much less that the marks "coexist peacefully" in the marketplace.<sup>4</sup> See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989).

Even if we assume that the marks in those registrations are in use, this evidence would not convince us that the mark VISION is "weak" for the identified goods. Contrary to applicant's contention, none of the third-party registrations is for the same goods as those in the cited registration. Applicant's claim that the goods in Registration No. 2,216,807 are "identical" to the goods in the cited registration is simply not true. Those goods,

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<sup>4</sup> Applicant's reliance on *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996) is misplaced as well. The Board's finding of no likelihood of confusion in that case was based on the applicant's evidence of widespread third-party use of BROADWAY for restaurant services. Although third-party registrations were of record in that case, those registrations did not constitute evidence of use of the mark.

mischaracterized by applicant as "towable trailers," are actually "recreational vehicles, namely towable trailers, and excluding motorhomes," goods which are distinctly different from "beverage delivery trailers." In fact, all of the goods in the third-party registrations, most notably, bicycles, bicycle frames, motor homes, automobiles and recreational vehicles, are specifically different from the "beverage delivery trailers" involved in this case.

We are also unpersuaded by applicant's apparent claim, based on the third-party registrations, and relying on *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910 (TTAB 1988), that VISION is a weak mark because it is a "suggestively laudatory term." Applicant maintains that VISION is suggestive of goods that are "a product of the envisioned future...hence its popularity as a trademark." As set forth in *Dayco*, third-party registrations may be used to show the dictionary or commonly understood meaning of a term in a particular field.<sup>5</sup> For example, the suggestive meaning of the word "vision" is apparent in the registered mark HAVAVISION for trucks equipped to provide mobile television services. We also note that eight of the other third-party

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<sup>5</sup> The Board in *Dayco* found the third-party registrations submitted in that case to be probative to demonstrate that the word IMPERIAL has been adopted by others in the vehicular field to refer to "that term's ordinary significance as a laudatory designation."

"vision" registrations are for various types of vehicle mirrors, or goods such as windshield wipers, windshield wiper blades and windshield visors, types of goods which are used to improve a field of vision. There is no question that the term VISION has an ordinary, well-understood, dictionary meaning in the context of such goods, and it might explain its "popularity" as a mark for those types of goods. However, that suggestive meaning is simply not applicable to the goods in either the involved applications or the cited registration. Even assuming that the term VISION does have some vague suggestive meaning in relation to the goods in this case, the evidence fails to establish that the term is highly suggestive of beverage delivery trailers or weak in relation to those goods.

Turning to the goods, the Examining Attorney argues that trucks and trailers are related goods in that trailers are dependent on trucks in order to haul cargo. The Examining Attorney has relied on a dictionary definition of "trailer" as "[a] large transport vehicle designed to be hauled by a truck or tractor" and copies of at least fourteen use-based third-party registrations covering both types of goods under the same marks.<sup>6</sup>

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<sup>6</sup> The Examining Attorney has also attached a number of third-party registrations which issued on the basis of foreign registrations rather than use in commerce and are therefore of limited probative value.

Applicant maintains that although "[m]ost goods classified in...Class 12...are related to each other in purpose..., in a weak mark analysis, such relatedness is not enough to demonstrate a likelihood of confusion." Applicant contends that both trucks and beverage delivery trailers are expensive items, purchased by professionals for use in business, and that there is no evidence in the record to show that trucks and "beverage delivery trailers" move through the same channels of trade.<sup>7</sup>

Where the marks are identical, as in one of these cases, it is only necessary that there be a viable relationship between the goods in order to support a holding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983). Nevertheless, more than a viable relationship exists between the goods in these cases. In fact, registrant's trailers are encompassed by the trucks identified in these applications. As set forth in *The Random House Dictionary of the English Language* (2<sup>nd</sup> ed.), of which we have taken judicial notice, a "truck" is described as "any of various forms of vehicle for carrying goods and materials, usually consisting of a single self-propelled unit *but also often composed of a trailer*

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<sup>7</sup> At the oral hearing, applicant for the first time raised the argument that the beverage trailers in the cited registration are "refrigerated." There is no evidence that beverage delivery trailers must be refrigerated, or even if so, that some form of vehicle other than "trucks" would be required to transport such trailers.

vehicle hauled by a tractor unit."<sup>8</sup> (Emphasis added). It can be seen from this definition that applicant's trucks could consist of a tractor paired with a trailer, such as registrant's beverage delivery trailer. As such, these are goods which purchasers would naturally expect to emanate from the same source.

Moreover, it is not even necessary that the goods of the applicant and registrant be similar or competitive or even sold through the same channels of trade to support a finding of likelihood of confusion. See *Luzier Inc. v. Marlyn Chemical Co., Inc.*, 442 F.2d 973, 169 USPQ 797 (CCPA 1971) and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Thus, even if registrant's goods are not considered to be specifically encompassed by applicant's goods, they are, nonetheless, closely related. It is clear from the dictionary

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<sup>8</sup> The Board may take judicial notice of dictionary definitions. In *re 3Com Corp.*, 56 USPQ2d 1060 (TTAB 2000). The word "tractor" in this context refers to the "cab" of a truck or "a truck with short chassis and no body used in combination with a trailer for the highway hauling of freight."

definition of "trailer" submitted by the Examining Attorney, that trucks and trailers are complementary transport vehicles designed to be used together for a common commercial purpose, i.e., to haul freight. Such complementary use been recognized as a relevant consideration in determining a likelihood of confusion. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In addition, the fourteen third-party registrations submitted by the Examining Attorney show, in each instance, that the same marks are registered for both trucks and trailers.<sup>9</sup> While the particular types or functions of the trailers are not specified, the registrations suggest that the respective goods are of a type which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, supra at 1785-1786; and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

We agree that trucks and beverage delivery trailers are expensive, and that the overlapping customers for those goods would be relatively careful and knowledgeable purchasers. However, even such purchasers of expensive goods are not immune from source confusion, particularly under circumstances where, as

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<sup>9</sup> Applicant has made of record a number of its registrations including Registration No. 1,146,847 for the mark MACK for trucks. The Examining Attorney has submitted a copy of applicant's pending application (Serial No. 75/558,995) for the mark MACK for trailers.

here, closely related goods are sold to the same purchasers under marks which are identical in one case and substantially similar in the other.<sup>10</sup> See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Finally, to the extent that there is any doubt on the issue of likelihood of confusion, it is settled that such doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

**Decision:** The refusal to register in each case is affirmed.

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<sup>10</sup> We note applicant's contention that the Board should not decide there is a "marketplace problem" because registrant has "yet to object to Applicant's use which has been extensive to date." For one thing, the involved applications are based on an intent to use the marks in commerce. There is no evidence of any use of these marks whatsoever, let alone extensive use. In any event, we would not infer merely from registrant's lack of objection that there is no "marketplace problem." See, e.g., *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).