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Paper No. 20  
JQ

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re **Patrick J. McGroder, III**

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Serial No. 75/184,809

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Frank J. McGue for applicant.

Steven R. Berk, Trademark Examining Attorney, Law Office  
102 (Thomas V. Shaw, Managing Attorney).

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Before Simms, Quinn and Wendel, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Patrick J. McGroder, III  
to register the mark ROYAL PONTIAC for goods ultimately  
identified as "clothing, namely, T-shirts, [and] leather  
jackets sold in connection with a museum of high powered  
automobiles."<sup>1</sup>

The Trademark Examining Attorney refused registration

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<sup>1</sup> Application Serial No. 75/184,809, filed October 21, 1996,  
based on an allegation of a bona fide intention to use the mark  
in commerce.

under Sections 2(a) and 2(d) of the Trademark Act. With respect to Section 2(a), the Examining Attorney maintains that applicant's mark falsely suggests a connection with General Motors Corporation which manufactures automobiles under the mark PONTIAC. As to Section 2(d), the Examining Attorney's position is that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark PONTIAC for various goods and services, as to be likely to cause confusion. The cited registrations, all of the mark PONTIAC (typed form) and owned by General Motors Corporation, are as follows: "maintenance and repair service for automotive vehicles, parts, and accessories";<sup>2</sup> "automobiles and truck dealership services";<sup>3</sup> "radios, calculators, and pre-recorded audio tapes concerning automobile operation for automobile purchasers";<sup>4</sup> "motor vehicle accessories, namely, windshield sunshades";<sup>5</sup> "printed materials, namely, manuals, brochures, and catalogs pertaining to the features and controls, operation, maintenance, service and repair, and technical

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<sup>2</sup> Registration No. 647,239, issued June 18, 1957; renewed.

<sup>3</sup> Registration No. 1,667,109, issued December 3, 1991; combined Sections 8 and 15 affidavit filed.

<sup>4</sup> Registration No. 1,704,693, issued August 4, 1992; combined Sections 8 and 15 affidavit filed.

<sup>5</sup> Registration No. 1,708,004, issued August 18, 1992; combined Sections 8 and 15 affidavit filed.

facts and specifications of motor vehicles";<sup>6</sup> "snow brushes for motor vehicle windows";<sup>7</sup> and "motorists' emergency kits consisting of battery booster cables, water bag, flat-tire fixer, first-aid kit, safety flares, rain poncho, bungee cord, tape, hand cleaner with towel, repair wire, and a help signalling flag."<sup>8</sup>

When the refusals were made final, applicant appealed.<sup>9</sup> Applicant and the Examining Attorney filed briefs.<sup>10</sup> An oral hearing was not requested.

With respect to the Section 2(a) refusal, applicant argues that consumers would not be likely to assume a connection between applicant's mark and registrant. Applicant also asserts that his mark does not uniquely

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<sup>6</sup> Registration No. 1,708,167, issued August 18, 1992; combined Sections 8 and 15 affidavit filed.

<sup>7</sup> Registration No. 1,725,765, issued October 20, 1992; combined Sections 8 and 15 affidavit filed.

<sup>8</sup> Registration No. 1,748,293, issued January 26, 1993; combined Sections 8 and 15 affidavit filed.

<sup>9</sup> The Examining Attorney originally issued a final refusal under Section 2(d) only, solely on the basis of Registration No. 1,711,830 owned by General Motors Corporation of the mark PONTIAC for "clothing, namely, caps." After an appeal and appeal brief were filed, the application was remanded to the Examining Attorney for consideration of an amendment to the identification of goods. The Examining Attorney, in an Office action dated July 13, 1998, accepted the amendment, and went on to refuse registration under Section 2(a), and to add seven registrations as cited under Section 2(d). It later came to light that the first registration cited, Registration No. 1,711,830, was canceled pursuant to Section 8, and the refusal based thereon was withdrawn.

<sup>10</sup> The Examining Attorney named above assumed responsibility of this case at the time of the filing of the appeal brief.

point to registrant. As to likelihood of confusion, applicant points to differences between the marks and goods. In support of his position on the two refusals, applicant submitted an article from a printed publication, a copy of a canceled registration of registrant's, a copy of a portion of applicant's Web page, listings from an encyclopedia and a gazetteer, and copies of correspondence between applicant and registrant. The correspondence, according to applicant, evidences registrant's acquiescence to the registration sought herein.

The Examining Attorney maintains that the term "persons" in Section 2(a) includes legally created entities such as corporations and that the "person" in this case is General Motors Corporation. The Examining Attorney argues that "[h]ere, the applicant simply modifies the term PONTIAC with the word ROYAL to suggest a regalness to the applicant's particular car and/or suggest some type of alteration making the applicant's particular automobile better than the typical PONTIAC automobile. Therefore, the first prong [of the Section 2(a) test, i.e., that the involved mark is the same as, or a close approximation of the name or identity of registrant, and that it would be recognized as such] is most certainly met." The Examining Attorney notes that applicant's goods have no connection

with registrant. The Examining Attorney does not dispute that there are different meanings for the term "Pontiac," but that applicant's clothing is connected to his planned museum containing PONTIAC cars and that, therefore, consumers will presume a connection with General Motors Corporation.

With respect to the Section 2(d) refusal, the Examining Attorney contends that the marks are similar, that the goods are related inasmuch as large automakers have expanded into ancillary goods, and that the cited mark is famous.

The Examining Attorney also contends that the correspondence between applicant and registrant does not evidence registrant's consent to the registration sought in the present application.

The Examining Attorney introduced the following evidence pertaining to the refusals: excerpts of seven printed publications retrieved from the NEXIS database showing use of the term "Royal Pontiac," and a Web page retrieved from the Internet showing a third-party's museum featuring the history of General Motors Corporation, all of which demonstrate, in the Examining Attorney's view, "that the prospective customer of ROYAL PONTIAC T-shirts or leather jackets from a car museum is likely to believe the

clothing to be related to General Motor['s] PONTIAC cars"; a listing of automotive links which, according to the Examining Attorney, show that "[c]ar buffs associate different car makes and models with diverse goods and services"; and listings of nine car clubs in connection with the Examining Attorney's statement that "the PONTIAC is so famous that there are at least nine car clubs devoted to cars of that make."

Mr. McGroder and his factory "muscle car" collection have been the subjects of several articles in printed publications, one of which is of record. The article in *Autoweek* (April 17, 1995) indicates that applicant's collection of 43 "muscle cars" ranks among the finest of such collections in the world. According to the article, Mr. McGroder collects nothing but factory cars designed exclusively for either racing or the street. Applicant restores the cars to exact factory condition. Applicant's mark ROYAL PONTIAC has a connection with a specific car, and a brief review of the history of this car, as set forth at applicant's Web page, follows:

1963 Pontiac "Swiss Cheese" Catalina

The Pontiac Super Duty program, which had begun in 1961, had progressed rapidly throughout 1962. Pontiac's engineers became research and development leaders by constantly

testing their new 421 SD...In a radical move, Pontiac created eleven very special hand-built cars, destined for a hand-picked elite team of drivers. These vehicles came to be known as the "Swiss Cheese" cars.

The base for the cars was a Catalina two-door sedan chassis because its open channel design made it considerably lighter. This chassis received a series...of holes to further reduce weight--hence the name Swiss Cheese.

Of the eleven "Swiss Cheese" Pontiac Catalinas built, two are in the McGroder Collection. The very first car built was one of two cars delivered to the late racing legend Mickey Thompson. The car was used as a back-up for his program and as such has less than 100 miles. It has been restored to concours condition with all correct original parts.

The second Swiss Cheese car in the McGroder Collection is the car assigned to Royal Pontiac and driven by Jim Wagners. It was constantly raced and updated and has been restored to concours race condition including all proper lettering. The car was the national record holder and class winner at the NHRA National meet. Notably, it is one of the most photographed and publicized Pontiacs in racing history.

Further historical perspective is added by the NEXIS articles furnished by the Examining Attorney. The articles indicate that "ROYAL PONTIAC" was used by Ace Wilson in connection with his drag racing car and his car dealership in Royal Oak, Michigan.

**False Suggestion of a Connection**

In order to warrant a refusal under this portion of Section 2(a), the Examining Attorney, who has the burden of proof, must show that (i)the mark is the same as, or a close approximation of, the name or identity previously used by the other person; (ii)the mark would be recognized as such in that it points uniquely and unmistakably to that person; (iii)the person named by the mark is not connected with the activities performed by the applicant under the mark; and (iv)the prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods. In re Urbano, 51 USPQ2d 1776 (TTAB 1999); In re North American Free Trade Association, 43 USPQ2d 1282 (TTAB 1997); and In re Kayser-Roth Corp., 29 USPQ2d 1379 (TTAB 1993). This test to be met for finding a false suggestion of a connection with another's persona differs from that for finding a likelihood of confusion as to the source of one's goods.

In the present case, the sparse record introduced by the Examining Attorney falls short of establishing that applicant's mark is the same as or even a close approximation of registrant's name or identity. Although it is common knowledge that PONTIAC is a brand name for an



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automobile which has been around for many years, and that American consumers are likely to know about this brand, we cannot conclude based on this record that this trademark functions as the persona of registrant. That is to say, there is nothing in the record to demonstrate that PONTIAC is a persona of General Motors Corporation. On this basis alone, the Section 2(a) refusal must be reversed.

In addition, the Examining Attorney has failed to show that the mark ROYAL PONTIAC, or even PONTIAC, points uniquely to General Motors Corporation. In contrast to the Examining Attorney's insufficient evidence, applicant's evidence establishes other meanings of the term "Pontiac" which the Examining Attorney has acknowledged. The encyclopedia and dictionary entries of the term "Pontiac" show it to be the name of the Ottawa Indian chief, as well as the name of a city in Michigan and other geographic locations. Thus, based on the record in this case, there is insufficient proof that the term "Pontiac" would be recognized as pointing uniquely to General Motors Corporation.

The refusal under Section 2(a) fails for lack of proof, and accordingly is reversed.

**Likelihood of Confusion**

Although we have found that the record falls short of showing that applicant's mark falsely suggests a connection with registrant, we find that the refusal based on a likelihood of confusion with registrant's mark is well taken.

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 likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to compare applicant's mark ROYAL PONTIAC with registrant's mark PONTIAC. Although we stress that we have considered these marks in their entirety, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this connection, "PONTIAC," which

identifies the brand of car that is the subject identified by applicant's clothing items, is the dominant part of applicant's mark. The term "ROYAL" is a laudatorily suggestive term meaning, in pertinent part, "of superior quality." *Webster's Third New International Dictionary* (unabridged ed. 1993).<sup>11</sup> In view thereof, the term "ROYAL" is relegated to a subordinate role in the source-identifying function of the mark. In comparing the marks, we further note that the record is devoid of evidence of any third-party uses or registrations of the same or similar marks in the automobile and clothing fields.

With respect to the goods and/or services, it is not necessary that the goods and/or services be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods and/or services originate from or are in some way associated with the same source. In re

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<sup>11</sup> Dictionary definitions are proper subject matter for judicial notice.

International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

We recognize the obvious differences between clothing and the goods and/or services identified in registrant's registrations. Nonetheless, given the facts that the registrations cover automobile services and related goods and accessories, and that applicant's T-shirts and leather jackets are intended to be sold in an automobile museum, we find there to be a sufficient relationship between them such that, when sold under similar marks, there is likely to be confusion in the marketplace. In passing, we also note, in this regard, that one of registrant's registrations covers, at least as an item included in an emergency kit, rain ponchos.

It is common knowledge that T-shirts, jackets and other logo-imprinted products are widely used as promotional items for a diverse range of goods and services, not to mention for specific brands of cars. In point of fact, as acknowledged by applicant, his clothing items are intended to be sold as souvenirs at his car museum. In connection with this practice, the Board, in other cases, has stated that the licensing of commercial trademarks for use on collateral products such as clothing, which are unrelated in nature to goods on which the marks

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are normally used, has become a common practice in recent years. See: *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 n. 3 (CCPA 1981)[“‘collateral product’ use is a matter of textbook discussion”], *aff’g*, 204 USPQ 396 (TTAB 1979)[collateral product use “has become a part of everyday life which we cannot ignore”]; and *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1945-46 (TTAB 1996) and cases cited thereat. See also: *Jaguar Cars Ltd. v. Skandrani*, 18 USPQ2d 1626 (S.D. FL 1991). We also point out that applicant’s clothing likely would be relatively inexpensive and the subject of an impulse purchase. See: *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984).

Another factor to consider in this case is that registrant’s PONTIAC mark is well known. Although the Examining Attorney’s evidence bearing on fame is weak, we view it as beyond dispute that the PONTIAC mark has been used for many years by registrant, and that the mark, as a brand name in the automobile industry, has had extensive exposure to the purchasing public. The renown of registrant’s PONTIAC mark is a factor weighing in favor of affirmance of the refusal to register. See: *Recot Inc. v. Becton*, 54 USPQ2d 1894 (Fed. Cir. 2000), on remand, 56

USPQ2d 1859 (TTAB 2000); and Kenner Parker Toys Inc. v. Rose Art Industries Inc., 22 USPQ2d 1453 (Fed. Cir. 1992). In point of fact, applicant's mark is an adaptation of registrant's well known brand of automobile and related goods and services.

In urging that the refusals to register be reversed, applicant places significant weight on his correspondence with registrant which, according to applicant, indicates that registrant is aware of applicant's use of the mark and acquiesces thereto. Registrant initiated the contact upon its review of an advertisement run by applicant in the printed publication *Musclecar Review*.<sup>12</sup> Registrant's trademark licensing manager wrote that he "had been advised that you are using Chevrolet Motor Divisions' names, logos and body designs in connection with your business." The letter went on as follows:

This is to advise you that your use of the Chevrolet names, logos and body designs constitutes trademark infringement and is deceptive toward the public. I must insist that you immediately discontinue using these or any other General Motors trademarks in advertising or in any other manner in connection with your business (e.g., on invoices, business cards and signs) which implies your business is endorsed or sponsored by Chevrolet Motor Division.

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<sup>12</sup> A poor photocopy of the advertisement is of record.

Applicant responded by letter,<sup>13</sup> indicating that Mr. McGroder's passion is to collect rare factory-backed muscle cars from the 1960s, with his ultimate goal of opening a museum to display these cars. The letter further indicated that applicant's collection "is widely recognized as the premier collection of these particular automobiles in the world," pointing out that applicant "has worked to restore the sixteen Chevrolet automobiles in his collection to perfection." The letter expressed a desire to amicably resolve the matter with registrant, stating that "Mr. McGroder has done much to perpetuate Chevrolet motor history and wishes to have an amicable relationship with Chevrolet." In addition to requesting more information from registrant, the letter concluded by stating that "Mr. McGroder is dedicated to the preservation of this era of American motor cars" and that registrant "would want to support rather than try to restrict his devotion to history."

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<sup>13</sup> This letter, dated April 21, 1998, was first submitted with applicant's reply brief. In doing so, applicant acknowledged that submission of evidence after appeal is generally untimely. See: Trademark Rule 2.142(d). As applicant pointed out, however, the submission here came after the Examining Attorney first raised a question in his brief relative to the correspondence between applicant and registrant. We agree with applicant that he is entitled to respond and, accordingly, we have considered the letter in reaching our decision.

The final letter in this round of correspondence is from registrant wherein registrant writes as follows:

General Motors owns many Federally Registered Trademarks including Chevrolet, the Bow Tie logo, Chevy, Heartbeat of America, Corvette, the Corvette emblems, Monte Carlo, Camaro and many others. General Motor [sic] also has several pending registrations in the apparel category including Impala, Impala Emblem, and Impala body design.

In regard to Mr. McGroder [sic] use of the Impala name and body designs, we were unaware the vehicles depicted in the identified advertisement are restored vehicles owned by your client. Since Mr. McGroder was obviously promoting his personal vehicles as well as his museum and there is no evidence of deception to the public, I will consider the matter closed.

Although we have considered this evidence in making our decision, it is not dispositive of the issues herein. Firstly, the letters from registrant make no mention of the mark PONTIAC which is the mark involved herein. This is not surprising inasmuch as applicant's advertisement, which prompted registrant's contact with applicant, does not include use of the mark PONTIAC. Although the advertisement shows a T-shirt bearing a picture of the 1963 Pontiac "Swiss Cheese" Catalina with the name "ROYAL" on its side, it does not appear that the PONTIAC mark is used. Secondly, in this particular case, a consent or



acquiescence to registration of a mark featuring "PONTIAC" does not necessarily follow from any consent to use the various Chevrolet marks. Simply put, the correspondence falls short of establishing registrant's consent or, in applicant's term, "acquiescence" to the specific registration sought by applicant herein.

Likewise, registrant's canceled registration does not compel a different result in this appeal. As indicated above, registrant owned a registration of the mark PONTIAC for "clothing, namely, caps" which was canceled under Section 8. Applicant contends that this fact is evidence that registrant has lost interest in the clothing field.

We simply cannot draw the inference proposed by applicant by the mere cancellation of registrant's prior registration for clothing. Moreover, the issue before us involves likelihood of confusion with registrant's existing registrations.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

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We conclude that consumers familiar with registrant's cars sold under the mark PONTIAC would be likely to believe, upon encountering applicant's mark ROYAL PONTIAC for T-shirts and leather jackets sold in connection with a museum of high powered automobiles, that the goods originated with or were somehow associated with or sponsored or licensed by registrant.

Decision: The Section 2(a) refusal is reversed. The Section 2(d) refusal is affirmed.

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