

This Opinion is Not a
Precedent of the TTAB

Hearing: June 19, 2018

Mailed: June 22, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Inter-Industry Conference on Auto Collision Repair

v.

LM Industries Group, Inc.

by change of name from Local Motors, Inc.

—
Opposition No. 91225743
—

Jennifer Goliveaux and Laura Franco of Winston & Strawn LLP,
for Inter-Industry Conference on Auto Collision Repair.

David Wong, Dwight D. Lueck, and Caitlin R. Byczko of Barnes & Thornburg LLP,
for LM Industries Group, Inc.

—
Before Bergsman, Greenbaum and Heasley,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

LM Industries Group, Inc., by change of name from Local Motors, Inc.
("Applicant") seeks registration on the Principal Register of the mark ICAR (in
standard characters) for "land vehicles," in International Class 12.¹

¹ Application Serial No. 86375490 was filed on August 24, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce.

The USPTO Assignment Section recorded Applicant's change of name to LM Industries Group, Inc. from Local Motors, Inc. on January 26, 2018 at Reel 6258, frame 0492.

The Inter-Industry Conference on Auto Collision Repair (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and dilution under Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c).² Opposer alleged ownership of eight registered marks incorporating the term ICAR in the field of auto body repair and damage analysis, including Registration No. 1607727 for the mark I-CAR (typed drawing form) for “educational services consisting of conducting training course in auto body repair and damages analysis,” in Class 41.³ For the sake of economy, we will confine our analysis to the issue of likelihood of confusion between Applicant’s mark and the mark in Registration No. 1607727. Of all the marks and services in Opposer’s pleaded registrations, I-CAR in typed drawing form for the above-noted services is the most similar to Applicant’s mark and goods. If the opposition cannot be sustained on the basis of this registered mark, it could not be affirmed on the basis of the other pleaded marks. *See The North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015) (citing *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010)).

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

² Opposer’s claim that Applicant’s mark “may disparage or falsely suggest a connection with Opposer in violation of 15 U.S.C. § 1052(a)” is waived because Opposer did not pursue that claim in its brief. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013), *aff’d per curiam*, 565 F. App’x 900 (Fed. Cir. 2014).

³ Registered July 24, 1990; second renewal.

I. Evidentiary Issue

Pursuant to Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a) and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 704.12 (June 2017), Opposer requests that the Board take judicial notice of an excerpt from the CUICAR website at cuicar.com.⁴ In support, Opposer cites *Caldwell v. Caldwell*, 2006 WL 618511 at *4 (N.D. Cal. 2006) (“The court agrees with the proposition that, as a general matter, websites and their contents may be proper subjects for judicial notice.”) (citing *Wible v. Aetna Life Ins. Co.*, 375 F. Supp.2d. 956, 965-66 (C.D. Cal. 2005) (taking judicial notice of an “Opinion Letter of the California Department of Insurance,” Amazon.com webpages, and excerpts from the American Academy of Allergy Asthma & Immunology website)). In *Wible*, the court held that it may take judicial notice of “documents that are public records and capable of accurate and ready confirmation by sources that cannot reasonably be questioned.” 375 F. Supp.2d. at 965.

The Board may take judicial notice of a fact that is “not subject to reasonable dispute because it (1) is generally known within the trial court’s territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” Fed. R. Evid. 201(b). We will not take judicial notice of the CUICAR website because there is no evidence that the website is generally known throughout the United States and because, due to the transitory nature of the Internet, the accuracy of that website is not capable of ready

⁴ 39 TTABVUE 2-8.

determination by sources whose accuracy cannot be reasonably questioned.⁵ See *Motion Picture Ass'n of Am. Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (no judicial notice for results from Internet search engines and from eBay website); see also *In re Total Quality Grp. Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (refusing to take judicial notice of an online dictionary definition that is not available in a print format on the ground that the Board was unsure whether the material was readily available and whether the material was reliable because the source was unknown).

Also, there is no reason for us to take judicial notice of the CUICAR website because the Trademark Rules specifically provide a procedure for introducing websites into evidence. See Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2) (“Internet materials may be admitted into evidence under a notice of reliance ... so long as the date the internet materials were accessed and their source (e.g., URL) are provided.”).

Opposer’s request that the Board take judicial notice of the CUICAR website at cuicar.com is denied.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application file. The record also includes the following items:

⁵ We disagree with the District Court to the extent that it held that the Amazon.com webpages and excerpts from the American Academy of Allergy Asthma & Immunology website were public records.

A. Opposer's testimony and evidence.

1. Notice of reliance on Opposer's pleaded registrations including copies printed from the USPTO electronic database showing the current status and title to the registrations;⁶
2. Notice of reliance on Applicant's responses to Opposer's interrogatories and requests for admission;⁷
3. Notice of reliance on the discovery deposition of John B. Rogers, Jr., Applicant's Chief Executive Officer;⁸
4. Testimony declaration of Mike Brey, Opposer's Controller;⁹
5. Testimony declaration of John Van Alstyne, Opposer's Chief Executive Officer and President;¹⁰
6. Notice of reliance on printed publications filed pursuant to Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e);¹¹
7. Testimony declaration of Ann Gonzalez, Opposer's Director of Strategic Development;¹²

⁶ 13 TTABVUE.

⁷ 14 TTABVUE.

⁸ 16 TTABVUE (public version). The entire Rogers deposition transcript including confidential testimony and exhibits is posted at 15 TTABVUE.

Trademark Rule 2.120(k)(3)(1), 37 C.F.R. § 2.120(k)(3)(1), provides that a discovery deposition or any part thereof may introduced into evidence through a notice of reliance. In this regard, TBMP § 704.09 advises that to avoid an overly large record or irrelevant evidence, "parties should, where appropriate, file only those portions of a discovery deposition transcript that are relevant to the pleaded claims, counterclaims, or affirmative defenses." Nevertheless, Opposer introduced the entire Rogers deposition transcript which we find to have little, if any relevance, to the pleaded claims.

⁹ 18 TTABVUE (public version). The entire Brey declaration including confidential testimony and exhibits is posted at 17 TTABVUE.

¹⁰ 19 TTABVUE (public version). The entire Van Alstyne declaration including confidential testimony and exhibits is posted at 20 TTABVUE.

¹¹ 21 TTABVUE.

¹² 22 TTABVUE.

8. Opposer's supplemental responses to Applicant's first and second sets of interrogatories filed pursuant to Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5), so as to avoid an unfair interpretation of Opposer's responses to Applicant's discovery responses relied upon by Applicant;¹³ and
9. Opposer's notice of reliance on excerpts from websites posted on the Internet.¹⁴

B. Applicant's testimony and evidence.¹⁵

1. Notice of reliance on Opposer's responses to Applicant's first and second sets of interrogatories and requests for admission;¹⁶
2. Notice of reliance on excerpts from websites purportedly showing third-party use of ICAR;¹⁷
3. Notice of reliance on third-party registrations that purportedly include the term ICAR,¹⁸ excerpts from Applicant's website,¹⁹ and excerpts from Opposer's website;²⁰

¹³ 31 TTABVUE (public version). Opposer's entire responses to Applicant's interrogatories, including the portions designated as confidential, are posted at 32 TTABVUE.

¹⁴ 33 TTABVUE.

¹⁵ Applicant filed a notice of reliance on Applicant's application file, the file histories for Opposer's pleaded registrations (13 TTABVUE), the testimony declarations of "Jay" [sic] Rogers (15 and 16 TTABVUE), Mike Brey (17 and 18 TTABVUE), John Van Alstynne (19 and 20 TTABVUE), and Ann Gonzalez (22 TTABVUE). 23 TTABVUE. Since the evidence is already of record, Applicant did not need to file a notice of reliance. Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a) ("When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.").

¹⁶ 24 TTABVUE 7-43.

¹⁷ 24 TTABVUE 45 through 26 TTABVUE. We do not consider the website at 26 TTABVUE 75-78 because it has an illegible URL. See Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), requiring that Internet materials introduced through a notice of reliance provide the URL and date the materials were accessed.

¹⁸ 27 TTABVUE 6-54.

¹⁹ 27 TTABVUE 56-74.

²⁰ 27 TTABVUE 78-209.

4. Notice of reliance on news articles posted on websites that purportedly refer to Applicant;²¹ and
5. Testimony declaration of John B. Rogers, Applicant's Chief Executive Officer.²²

III. Standing

Opposer has established its standing by properly introducing into evidence its pleaded registrations. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant does not contest Opposer's standing.²³

IV. Priority

Because Opposer's pleaded registrations are of record, priority is not at issue with respect to the services identified in Opposer's pleaded registrations. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). Applicant does not contest Opposer's priority.²⁴

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of

²¹ 28 TTABVUE.

²² 29 TTABVUE.

²³ Applicant's Brief, p. 9 (36 TTABVUE 11).

²⁴ Applicant's Brief, p. 8 (36 TTABVUE 10).

likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); see also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

- A. The strength and fame of Opposer's mark and the number and nature of similar marks in use in connection with similar services.

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning.)”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

1. The inherent strength of Opposer's trademark.

Opposer's mark I-CAR is an acronym derived from its trade name, Inter-Industry Conference on Auto Collision Repair.²⁵ As such, it is at worst suggestive of Opposer's

²⁵ Opposer's response to Applicant's interrogatory No. 1 (24 TTABVUE 9) (“The term I-CAR is both an acronym for Opposer's full company name Inter-Industry Conference on Auto Collision Repair, and a long standing trade and service mark of Opposer.”); Gonzalez Testimony Decl. ¶3 (22 TTABVUE 3).

“educational services consisting of conducting training course in auto body repair and damages analysis” and, thus, inherently distinctive. “[T]he fact that mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection.” *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985); *see also The Maytag Co. v. Luskin’s, Inc.*, 228 USPQ 747, 750 (TTAB 1986) (“there is nothing in our trademark law which prescribes any different protection for suggestive, nondescriptive marks than that which is accorded arbitrary and fanciful marks.”); *Husky Oil Co. of Del. v. Huskie Freightways, Inc.*, 176 USPQ 351, 352 (TTAB 1972).

2. The commercial strength of Opposer’s mark.

Opposer contends that its I-CAR mark is a famous mark.²⁶ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis; famous marks enjoy a broad scope of protection or exclusivity of use because they have extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). “[L]ikelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing*

²⁶ Opposer’s Brief, p. 4, 29 (34 TTABVUE 12, 37).

Co., 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003))). Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the mark at issue, by “the length of time those indicia of commercial awareness have been evident,” by widespread critical assessments, by independent sources’ notice of the products identified by the marks, as well as by the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Although raw numbers of product sales and advertising expenses sometimes suffice to prove fame, raw numbers alone may be misleading. Some context in which to place the raw numbers may be reasonable (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Opposer introduced the evidence and testimony listed below to prove that its I-CAR mark is famous:

- Applicant was founded in 1979 “when representatives from six segments of the automotive collision repair industry, namely, collision repair providers, insurance companies, OEMs (original equipment manufacturers, including

specifically and principally automobile makers), educational providers, suppliers, and other related industry providers, banded together to create a single entity to provide training and other services to collision repair professionals.”²⁷

- Mike Brey, Opposer’s Controller, testified that Opposer obtains its revenues primarily from student tuition and licensing.²⁸ Opposer’s revenues are substantial but not overwhelming;²⁹
- Opposer’s marketing expenditures are modest;³⁰

²⁷ Van Alstyne Testimony Decl. ¶3 (19 TTABVUE 3); *see also* Gonzalez Testimony Decl. ¶¶3-4 (22 TTABVUE 3). Although Opposer’s witnesses testified as to when Opposer was founded, they did not testify as to when Opposer began using the I-CAR service mark. Nevertheless, Mike Brey, Opposer’s Controller, testified about Opposer’s revenues dating back to June 1981. Brey Testimony Decl. Exhibit A (17 TTABVUE 6) (confidential). Accordingly, we presume that Opposer has used its mark since at least June 1981 or approximately 37 years. While long use of a mark is indicative of commercial success, it is not conclusive evidence of fame. *See Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1635-36 (TTAB 2007) (“Long use and/or registration of a mark, without evidence of the extent of consumer exposure to or recognition of the mark over the years, is not sufficient to prove fame.”); *Saks & Co. v. Snack Food Ass’n*, 12 USPQ2d 1833, 1836 (TTAB 1989) (“In making our determination we have taken into consideration the long use and advertising of ‘SFA’ made by opposer, but the evidence of record is not sufficient for us to find ‘SFA’ is a famous mark which consumers are likely to associate with opposer when used for such different services as those rendered by applicant.”); *SBS Prods. Inc. v. Sterling Plastic & Rubber Prods. Inc.*, 8 USPQ2d 1147, 1150 (TTAB 1988) (“while petitioner has shown long use of the ‘SBS’ mark for many years and has shown that it has enjoyed sales of \$8 million-\$10 million annually since 1979, it can hardly be said to have reached the status of a famous mark which could prevent another from adopting the same or similar mark in another field.”).

²⁸ Brey Testimony Decl. ¶3 (18 TTABUE 3).

²⁹ Brey Testimony Decl. Exhibit A (17 TTABVUE 6). Opposer designated its revenues “Confidential – Attorney’s Eyes Only,” so we refer to them in only general terms.

Also, we note that Opposer did not place these figures in context so we do not know how they compare with the revenues of competitors. *See Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1309. In other words, there is no testimony or evidence regarding Opposer’s market share.

³⁰ Brey Testimony Decl. Exhibit B (17 TTABVUE 8). Opposer designated its marketing expenditures “Confidential – Attorney’s Eyes Only,” so we refer to them in only general

- Opposer has “received a number of awards and recognitions,” including the ASAE Gold Circle Award for Marketing/Advertising Excellence (1991);³¹
- State Farm Insurance, Tesla Motors, Honda/Acura, Audi, Ford, Fiat Chrysler, General Motors, Nissan/Infiniti, Porsche and Volvo require I-CAR training to be authorized repair facilities;³²
- “There are currently over 600 technical schools that license the I-CAR PDP-EE curricula”;³³
- Opposer offers I-CAR training in all 50 states;³⁴
- “In 2016 alone, I-CAR trained nearly 10,000 businesses and over 70,000 individual students in the United States”;³⁵

terms. Because Opposer did not place the marketing expenditures in context, we cannot compare them to competitors. Accordingly, we have no basis for corroborating whether the marketing expenditures are as “significant” as Mr. Brey contends. Brey Testimony Decl. ¶4 (18 TTABVUE 3).

³¹ Van Alstyne Testimony Decl. ¶4 (19 TTABVUE 3). “The ASAE is the premier organization for association management, representing trade associations and individual membership societies that cover nearly every sector of the economy, and countless professionals.” *Id.*

Although Mr. Van Alstyne testified that Opposer has received a number of awards and recognitions, he listed only one.

³² Van Alstyne Testimony Decl. ¶5 (19 TTABVUE 4). Opposer did not provide any dates regarding when these entities required I-CAR training.

³³ Van Alstyne Testimony Decl. ¶8 (19 TTABVUE 5). While licensing to 600 technical schools appears impressive, we do not know how many technical schools exist, whether competitors have licensed their curricular to a comparable number of technical schools, or how many students have received the I-CAR training.

³⁴ Van Alstyne Testimony Decl. ¶12 (19 TTABVUE 6-7); *see also* Opposer’s response to Applicant’s interrogatory No. 3 (24 TTABVUE 10).

³⁵ Van Alstyne Testimony Decl. ¶12 (19 TTABVUE 6-7).

- “[A]pproximately 30% of all repair shops in the United States have had some form of training with I-CAR”;³⁶
- Opposer offers three I-CAR recognition programs: (i) I-CAR PLATINUM (35,000 recognized professionals); (ii) I-CAR GOLD CLASS (4,400 facilities), and (iii) I-CAR ROAD TO GOLD (2,300 participating facilities).³⁷
The participants in the I-CAR GOLD CLASS and I-CAR ROAD TO GOLD represent 20% of the repair shops in the United States;³⁸
- The Better Business Bureau of the Mid-South recommends that consumers use I-CAR trained professionals;³⁹ and
- Opposer’s I-CAR services have received unsolicited media coverage.⁴⁰

While we have noted some shortcomings as to the probative value of the individual pieces of evidence, we must look at the evidence in its entirety to determine whether Opposer has proven that its mark is famous. *Cf. West Florida Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (in analyzing priority,

³⁶ Van Alstyne Testimony Decl. ¶14 (19 TTABVUE 8-9). Mr. Van Alstyne did not testify as to when these repair shops received training.

³⁷ Van Alstyne Testimony Decl. ¶¶13 and 14 (19 TTABVUE 7-8). Mr. Van Alstyne did not testify as to when the individuals and facilities received their recognition.

³⁸ Van Alstyne Testimony Decl. ¶14 (19 TTABVUE 8). Mr. Van Alstyne did not testify as to when this figure became applicable.

³⁹ Van Alstyne Testimony Exhibit K (19 TTABVUE 313) (“BBB: Choosing an auto body shop,” *The Jackson Sun* (May 4, 2012), “Check the shop’s qualifications by asking about advanced technician training from a national organization such as the Inter-Industry Conference on Auto Collision Repair (I-CAR) or National Institute for Automotive Service Excellence (ASE).”).

Autoblog.com (July 1, 2008) identified I-CAR and ASE as “the two ‘biggies’ when it comes to certifying auto service technicians through testing.” 21 TTABVUE 9.

⁴⁰ Gonzalez Testimony Decl. Exhibit J (22 TTABVUE 370-378 and 382-395).

“whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.”).

Opposer is a successful 37 year old company specializing in “accessible, on-demand and relevant education, knowledge, services and solutions for the automotive Collision Repair Inter-Industry.”⁴¹ In this regard, a substantial segment of the automobile collision repair industry has received Opposer’s training and has been exposed to Opposer’s I-CAR mark. Also, the Better Business Bureau recommends that consumers use I-CAR trained professionals⁴² and one author identified Opposer as one of “the two ‘biggies’ when it comes to certifying auto service technicians through testing.”⁴³

Applicant argues to the contrary that Opposer’s mark is not famous because (i) Opposer has provided only raw data regarding its revenues and has not placed it in context, (ii) Opposer has not differentiated between its different I-CAR marks, and (iii) there is no evidence that the “consuming public” associates I-CAR with Opposer.⁴⁴

While raw data without context is not as probative as raw data in context in assessing whether a mark is famous, the raw data is nonetheless probative. As noted

⁴¹ Van Alstyne Testimony Decl. ¶3 (19 TTABVUE 3); Gonzalez Testimony Decl. ¶3 (22 TTABVUE 3).

⁴² Van Alstyne Testimony Exhibit K (19 TTABVUE 313).

⁴³ 21 TTABVUE 9.

⁴⁴ Applicant’s Brief, p. 14 (36 TTABVUE 16).

above, the Court of Appeals for the Federal Circuit held that some context in which to place raw numbers may be “reasonable,” not that it is a prerequisite for admissibility. *See Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1309.

The evidence and testimony show that the term I-CAR is the dominant element of Opposer’s marks and that it is that term which the relevant public has come to identify with Opposer’s services. Specifically, Opposer’s recognition programs, I-CAR PLATINUM, I-CAR GOLD CLASS, and I-CAR ROAD TO GOLD all prominently feature the term I-CAR. Thus, we find that the above-noted evidence is probative of whether I-CAR has achieved fame.

Finally, the evidence in its entirety demonstrates that the relevant public, such as automobile insurance companies, automobile manufacturers and dealerships, and automobile collision repair facilities, associate I-CAR “educational services consisting of conducting training course in auto body repair and damages analysis” with Opposer. For example, Opposer’s recognition programs have been encountered by a substantial segment of the relevant public and a substantial segment of repair shops have received I-CAR training.

On this record, we find that Opposer’s I-CAR mark has achieved fame in the field of educational services in the field of automobile collision repair and is a commercially strong mark. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1409 (TTAB 2010) (finding that opposer acquired niche market fame).

3. The number and nature of similar marks in use in connection with similar services.

Applicant contends that it has introduced “substantial evidence of third-party use and registration of the term ‘icar’ in connection with various automobile-related goods and services,”⁴⁵ so that the relevant consumers will be able to distinguish between Applicant’s marks and Opposer’s marks.⁴⁶ Applicant has introduced excerpts from the following third-party websites showing the use of the term I-CAR or a variation thereof in connection with automobile related services:

Automobile Collision Repair Services

- i.C.A.R. Houston Paint & Body (icarhouston.com) advertising itself as iCAR HOUSTON, located in Cypress, Texas, advertises automobile collision repair services.⁴⁷ In this website excerpt, i.C.A.R. Houston displays Opposer’s stylized I-CAR mark in a logo that states “I-CAR Trained.”⁴⁸ However, Opposer, in its Reply Brief where Opposer rebuts the probative value of Applicant’s third-party use evidence, notes ICAR HOUSTON but does not identify ICAR HOUSTON as a licensee, I-CAR authorized facility, or otherwise explain that entity’s authorization to use Opposer’s stylized I-CAR mark.⁴⁹ Accordingly, we construe this website for what it shows on its

⁴⁵ Applicant’s Brief, p. 10 (36 TTABVUE 12).

⁴⁶ Applicant’s Brief, pp. 9-13 (36 TTABVUE 11-15).

⁴⁷ 24 TTABVUE 45-54.

⁴⁸ 24 TTABVUE 46. Opposer’s pleaded registration No. 2160440, registered May 26, 1998; renewed (13 TTABVUE 14-18).

⁴⁹ Opposer’s Reply Brief, pp. 5-7 (39 TTABVUE 17-19).

face (*i.e.*, i.C.A.R. Houston Paint & Body using the service mark iCAR HOUSTON advertises that it has received I-CAR training).

Automotive Repair Services

- ICar Complete Auto Care (icarautocare.com), located in Shrewsbury, Massachusetts, advertises automotive repair services;⁵⁰ and
- iCAR Body Shop (realillusion.com) advertises itself as a “virtual garage for interactive vehicles.”⁵¹

Online Sales of Automobile Parts

- iCar-Part.com is a webpage for online sales of auto parts;⁵² and
- icarparts.com advertises online sales of automobile parts.⁵³

Car Washing Services

- ICARWASH (icarwashboston.com) advertises car washing services.⁵⁴

Automobile Dealership Services

- iCars Chicago (icarschicago.com), located in Skokie, Illinois, advertising automobile dealership services;⁵⁵
- iCar Autos Inc. (icarautos.net), located in Fredericksburg, Virginia, advertising automobile dealership services;⁵⁶

⁵⁰ 26 TTABVUE 56.

⁵¹ 26 TTABVUE 86.

⁵² 26 TTABVUE 69.

⁵³ 26 TTABVUE 74.

⁵⁴ 26 TTABVUE 79.

⁵⁵ 24 TTABVUE 55-57.

⁵⁶ 24 TTABVUE 59-61.

- ICAR AUTO SALES (icarnj.com), located in Lakewood, New Jersey, advertising automobile dealership services;⁵⁷
- iCAR AutoSales (yellowpages.com/cave-springs-ar/mip/icar-auto-sales-503940424), located in Cave Springs, Arkansas, advertising automobile dealership services;⁵⁸
- ICars Automall Inc. (icarsautomall.com), located in Foley, Alabama, advertising automobile dealership services;⁵⁹
- iCARS.net, located in Burbank, California, advertising automobile dealership services, including providing parts and accessories;⁶⁰
- iCARZ (icarzinc.net), located in Sacramento, California, advertising automobile dealership services;⁶¹
- iCar Auto Center (icarautocenter.com), located in Arcadia, California, advertising automobile dealership services;⁶²

⁵⁷ 25 TTABVUE 3.

⁵⁸ 25 TTABVUE 10-11. Opposer introduced through a notice of reliance a webpage from instantstreetview.com displaying a building featuring a sign for The Engine Hut as rebuttal evidence “regarding (i) alleged weakness of the I-CAR mark and (ii) [Opposer’s] lack of enforcement of its mark.” (33 TTABVUE 4 and 76). The photograph of the building does not display the address of the building. Opposer would have us infer that iCAR Auto Sales in Cavern Springs, Arkansas is no longer operational. However, Opposer has presented only one side of the building. iCAR Auto Sales could be operating out of one of the other sides of the building.

⁵⁹ 25 TTABVUE 4-8.

⁶⁰ 25 TTABVUE 13-17.

⁶¹ 26 TTABVUE 4.

⁶² 26 TTABVUE 6-11.

- iCar Denver (icardenver.com), located in Denver, Colorado, advertising automobile dealership services;⁶³
- icarsnow.com, located in Monroe, North Carolina, advertises automobile dealership services;⁶⁴
- ICARS AUTO SALES (icarsautosales.com), located in Arlington, Texas, advertising automobile dealership services;⁶⁵
- The Carz & Stuff website (carzandstuff.com) posted an advertisement for iCAR Auto Sales;⁶⁶
- International Celebrity Auto Resale Facebook page shows ICAR used as an abbreviation for International Celebrity Auto Resale;⁶⁷ and
- iCARUSA.com, located in Lenoir City, Tennessee, advertises automobile dealership services.⁶⁸

Automobile Leasing Services

- iCar.lease (icar.lease/) advertising automobile leasing services;⁶⁹

⁶³ 26 TTABVUE 18-24.

⁶⁴ 26 TTABVUE 59-61. Opposer introduced through a notice of reliance a copy of a webpage with the URL icarsnow.com that states “Make your Union Acceptance Company Payment **CLICK HERE**” as rebuttal evidence “regarding (i) alleged weakness of the I-CAR mark and (ii) [Opposer’s] alleged lack of enforcement of its mark.” (33 TTABVUE 3 and 64). Opposer wants us to infer that icarsnow.com is no longer rendering automobile dealership services.

⁶⁵ 26 TTABVUE 71-72.

⁶⁶ 26 TTABVUE 73.

⁶⁷ 26 TTABVUE 51-52.

⁶⁸ 26 TTABVUE 80-81.

⁶⁹ 26 TTABVUE 12-17. Opposer introduced through a notice of reliance a copy of a webpage with the URL icar.lease/ purportedly as rebuttal evidence “regarding (i) alleged weakness of the I-CAR mark and (ii) [Opposer’s] lack of enforcement of its mark.” (33 TTABVUE 3 and

- icar Auto Lease (icarautoleasing.com), located in Burbank, California advertises automobile leasing services;⁷⁰ and
- E-Z Rent-A-Car (e-zrentacar.com) using ICAR as a symbol for a midsize car.⁷¹

Limousine Services

- The Limo Service website for iCAR LLC (icar.company), located in Martinsville, New Jersey, advertises “Let iCAR provide iCARE service” in connection with limousine services.⁷² It appears that “The Limo Service” is a trade name for iCar LLC.⁷³

Vehicle Transporting Services

- The USHIP website (uship.com) lists ICAR Inc. as a trucking company that transports automobiles.⁷⁴

Automobile Racing Exhibitions

- International Car LLC motor race tour website (topspeedmods.com) uses ICAR as an abbreviation for International Car.⁷⁵

66). The webpage states that the webpage is unavailable and explains that the website “may be experiencing technical difficulties, or you may need to adjust your browser settings.”

⁷⁰ 26 TTABVUE 67-68 and 88-89.

⁷¹ 26 TTABVUE 25-27. According to the University of Oregon Business Affairs website (ba.uoregon.edu) Enterprise and National used “ICAR” as an abbreviation for an intermediate size car. 26 TTABVUE 44-45.

⁷² 26 TTABVUE 28-39; *see also* 26 TTABVUE 65.

⁷³ 26 TTABVUE 29-30.

⁷⁴ 26 TTABVUE 62.

⁷⁵ 26 TTABVUE 48-50. Opposer introduced through a notice of reliance a webpage from nstaracing.com” purportedly as rebuttal evidence “regarding (i) alleged weakness of the I-CAR mark and (ii) [Opposer’s] alleged lack of enforcement of its mark.” (33 TTABVUE 4 and

Mobile Telephone Application

- iCarMode (icarmode.com) appears to be some sort of mobile telephone application that allows mobile phone use while driving.⁷⁶

Also, Applicant introduced five third-party registrations listed below that incorporate the term “ICAR.”⁷⁷ Third-party registrations based on use in commerce that individually cover a number of different goods or services may have probative value to the extent that they serve to suggest that the listed goods or services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d mem.* 864 F.2d 149 (Fed. Cir. 1988).

78). The webpage is an article entitled “John Robbins Carries On A Family Tradition” (no date) that states “the article originally appeared on Speed Sport online.” The article reports that “Robbins will be taking his passion for short-track racing a little further as he has purchased the ICAR Top Speed Modified Tour and will begin promoting it this season as the NSTA Top Speed Modified Tour.”

⁷⁶ 26 TTABVUE 82-85. The quality of the posting is not good. It is the responsibility of the party making submissions to the Board via the electronic database to ensure that the testimony or evidence has, in fact, been properly made of record. *See* Trademark Rule 2.126(a)(2), 37 C.F.R. § 2.126(a)(2) (exhibits must be clear and legible); *see also Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350-51 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d at 1758 n.16 (“the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board”); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is reasonable to assume that it is opposer’s responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible and identified as to source and date.”).

⁷⁷ 27 TTABVUE 6-54.

Mark	Reg. No.	Goods or Services
ICARS	3359285	Chauffeured transportation services
	4683537	Providing tracking services and information concerning tracking of assets in transit, namely, vehicles, trailers, drivers, cargo and delivery containers for business inventory purposes
iCarsChicago	5033468	Automobile dealership services
	5144469	Automobile dealership services
iCarwash ⁷⁸	4993146	Automobile detailing services

The evidence of third-party use in this case is similar to the evidence of third-party use in *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015), where the Court noted that the quantity of the third-party use was “powerful on its face” even without the specifics as to the extent and impact of such use. 115 USPQ2d at 1674-75. In this case, we have before us, *inter alia*, evidence of

⁷⁸ 27 TTABVUE 50. The registrant is a Canadian individual with an address in Alberta, Canada. The registration claims first use anywhere as of May 1, 2013 and first use in commerce as of May 1, 2014. Opposer introduced an excerpt from the icarwashautodetailing.com website displaying registrant’s address and telephone number as shown on registrant’s specimen (27 TTABVUE 54). The website displays two locations both in Alberta, Canada. (33 TTABVUE 68-74). Nevertheless, the certificate of registration is “prima facie evidence of the validity of the registered mark and of the registration of the mark, the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.” Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

third-party use of ICAR or variations thereof in connection with the following automobile related services:

- 1 third-party user in connection with automobile collision repair services;
- 2 third-party users in connection with automobile repair services,
- 2 third party users in connection with online sales of automobile parts;
- 1 third-party user in connection with car washing services;
- 14 third-party users in connection with automobile dealership services (although one third-party use may be questionable);
- 2 third-party users in connection with automobile leasing services;
- 2 third-party users identifying ICAR as a symbol for a midsize car;
- 1 third-party user in connection vehicle transportation services;
- 1 third-party user in connection with automobile racing exhibitions; and
- 1 third-party user in connection with mobile telephone application for use when driving.

The evidence is sufficient to show that the term ICAR or a variation thereof has been extensively adopted, registered and used as a service mark in the automobile industry and, therefore, that ICAR or a variation thereof has significance in the automobile industry.

4. Analyzing the strength of Opposer's mark.

Opposer's I-CAR mark is a commercially strong mark that has achieved niche fame in the automobile collision repair industry. However, as discussed above, I-CAR, ICAR and variations thereof have been extensively adopted, registered and used in

connection with other automotive services. Therefore, Opposer's mark I-CAR is entitled to a broad scope of protection or exclusivity of use in the automobile collision repair industry, but it is entitled only to a restricted scope of protection outside of that field. *See Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010) (citing *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)). In other words, outside the automobile collision repair industry, Opposer's I-CAR mark is not entitled to such a broad scope of protection that it is a bar to the registration of every mark comprising, in whole or in part, the term I-CAR or a variation thereof; it will only bar the registration of marks "as to which the resemblance to [plaintiff's mark] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two." *Id.*

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014). *See also Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted). In comparing the marks, we are mindful that "[t]he proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in

terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721; *see also* *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

Opposer’s mark is I-CAR and Applicant’s mark is ICAR. The marks are essentially identical in appearance and they are identical in sound. Little if any significance can be attributed to the hyphen in the Opposer’s mark I-CAR and lack of a hyphen in Applicant’s mark ICAR. *See, e.g., Nahshin v. Prod. Source Int’l LLC*, 107 USPQ2d 1257, 1258 n.2 (TTAB 2013) (“the presence or absence of a hyphen is insignificant to our ultimate decision.”); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) (hyphen did not distinguish MAGNUM from MAG-NUM); *Goodyear Tire & Rubber Company v. Dayco Corporation*, 201 USPQ 485, 489 n.4 (TTAB 1978) (“Fast-Finder” with hyphen is in legal contemplation substantially identical to “Fastfinder” without hyphen).

As noted above, Opposer’s mark I-CAR is an acronym for its trade name the Inter-Industry Conference on Auto Collision Repair.⁷⁹ Because Opposer was formed by

⁷⁹ Opposer’s response to Applicant’s interrogatory No. 1 (24 TTABVUE 9) (“The term I-CAR is both an acronym for Opposer’s full company name Inter-Industry Conference on Auto Collision Repair, and a long standing trade and service mark of Opposer.”); Gonzalez Testimony Decl. ¶3 (22 TTABVUE 3); Opposer’s response to Applicant’s request for admission No. 3 (24 TTABVUE 26).

“representatives from six segments of the automotive collision repair industry, namely, collision repair providers, insurance companies, OEMs (original equipment manufacturers, including specifically and principally automobile makers), educational providers, suppliers and other related industry providers,”⁸⁰ because Opposer advertises its I-CAR services in connection with its trade name – Inter-Industry Conference on Auto Collision Repair,⁸¹ and because Opposer co-brands its I-CAR mark with OEM partner such as Honda, Nissan, Ford and GM,⁸² relevant consumers in the industry (e.g., automobile insurance companies, automobile manufacturers and dealerships, and automobile collision repair facilities) would tend to be aware of the meaning of Opposer’s mark.

Not so with other consumers. *See Hercules Inc. v. Nat’l Starch and Chem. Corp.*, 223 USPQ 1244, 1248 (TTAB 1984) (“It has long been held that in the absence of evidence establishing that purchasers would be aware of the term or terms from which the marks were derived, how the marks came to be adopted is immaterial to the issue whether confusion is likely from their contemporaneous use.”); *Varian Assoc., Inc. v. Leybold-Heraeus GmbH*, 219 USPQ 829, 833 (TTAB 1983) (“Derivation is especially not relevant where there is little likelihood that purchasers would be aware of the term or terms from which the mark was derived.”); *Aerojet-General Corp. v. Computer Learning & Sys. Corp.*, 170 USPQ 358, 362 (TTAB 1971) (fact that letter

⁸⁰ Van Alstyne Testimony Decl. ¶3 (19 TTABVUE 3).

⁸¹ Van Alstyne Testimony Exhibit B (19 TTABVUE 43).

⁸² Van Alstyne Testimony Decl. ¶7 and Exhibit B (19 TTABVUE 5 and 52-74).

marks are acronyms derived from different words unimportant because average purchaser probably unaware of derivation). Also, we note that Opposer refused to describe what Opposer's mark "conveys" or is "intended to convey" to purchasers.⁸³

Applicant contends that its mark engenders a different commercial impression, that of an "individualized, personalized, customized" car,⁸⁴ but because its mark has not been used in commerce, this assertion is speculative. Other interpretations are just as likely. This is especially true with a mark like ICAR, where the letter "I" is likely to be perceived as meaning "Internet." See *In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2001) (ITool is merely descriptive of software that is an Internet tool); see also *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1813 (TTAB 2018) (the letter "I" in IPAD means Internet-enabled or accessible).

In analyzing whether the marks are similar, we note that the overwhelming majority of third parties using variations of ICAR use ICAR in connection with another term (e.g., iCAR Auto Sales, ICAR HOUSTON, ICARS AUTO MALL) rather than as standalone marks as in the case before us. Accordingly, because the marks are nearly identical in appearance and are identical in sound, and because any finding as to the connotation and commercial impression regarding Applicant's mark is speculative (although unlikely to be similar to Opposer's mark), we find that the

⁸³ Opposer's response to Applicant's interrogatory No. 22 (24 TTABVUE 21).

⁸⁴ Rogers Discovery Dep., pp. 82 and 88 (16 TTABVUE 87 and 93); Rogers Testimony Decl. ¶13 (29 TTABVUE 4) ("[Applicant] chose the ICAR mark because the letters tied into [Applicant's] focus on co-creation and micro-manufacturing and suggested customization and the owner's involvement in the creation of the vehicle.").

similarities between the marks outweigh the differences and, therefore, the marks are similar.

C. The similarity or dissimilarity and nature of the goods and services.

The second *du Pont* factor involves the “similarity or dissimilarity and nature of the goods or services as described in an application or registration” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014). Our analysis under this factor is based upon the identifications of goods in the application and the services in Opposer’s pleaded registration rather than any actual or intended use of the subject marks. *Id.* at 1161-63; *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.* 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Moreover, where essentially identical marks are involved, as is the case here, the degree of similarity between the parties’ goods and services that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993) (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”); *Century 21 Real Estate Corp. v. Century Life Of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Time Warner Entertainment Co.*

v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is only necessary that there be a viable relationship between the goods and services to support a finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). The issue here, of course, is not whether purchasers would confuse the parties' goods and services, but rather whether there is a likelihood of confusion as to the source of these goods and services. *In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Applicant's goods are identified as "land vehicles." We must presume that Applicant's goods include all types of vehicles, and not just the "individualized, personalized, customized" cars that Applicant intends to mark market under its ICAR mark. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Opus One*, 60 USPQ2d at 1817; *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Opposer's pleaded registration is for "educational services consisting of conducting training course in auto body repair and damages analysis." As described by John Van Alstyne, Opposer's Chief Executive Office and President, Opposer's "mission is to deliver increasingly accessible, on-demand and relevant education, knowledge, services and solutions for the automotive Collision Repair Inter-Industry."⁸⁵ Thus,

⁸⁵ Van Alstyne Testimony Decl. ¶3 (19 TTABVUE 3); *see also* Opposer's response to Applicant's interrogatory No. 2 (24 TTABVUE 9) ("Opposer is the principal provider of high-

Opposer argues that its educational services are related to land vehicles because Opposer's courses are in the field of automobile collision repair and Opposer often partners with automobile manufacturers to create customized training materials and to promote their relationship,⁸⁶ because many automobile manufacturers require I-CAR training to become authorized repair facilities,⁸⁷ and because I-CAR certified repair facilities display I-CAR designations in their shops and on their websites.⁸⁸ Finally, Opposer asserts that "there is no reason to assume that Applicant itself would never partner with I-CAR in the future to develop and offer training on repairs specific to Applicant's vehicles, particularly as technology improves and advances such as 3D printing are increasingly adopted by more 'traditional' repair facilities."⁸⁹

Opposer concludes as follows:

Given that land vehicles are the very subject of [Opposer's] educational and technical goods and services, [Opposer's] close association with the automotive industry and with vehicle makers, and because [Opposer's] mark regularly appears in close association with the marks of car companies and other OEMs, consumers are likely to believe that ICAR-branded automobiles "originate from, or are in some way associated with" I-CAR.⁹⁰

Contrary to Opposer's conclusion that "land vehicles" and "educational services consisting of conducting training course in auto body repair and damages analysis"

quality technical education, information and related goods and services, for and endorsed by, the automotive collision repair business in the United States and globally.").

⁸⁶ Van Alstyne Testimony Decl. ¶7 (19 TTABVUE 5).

⁸⁷ Van Alstyne Testimony Decl. ¶¶5 and 15 (19 TTABVUE 4 and 8).

⁸⁸ Van Alstyne Testimony Decl. ¶¶16 and 17 (19 TTABVUE 8-9).

⁸⁹ Opposer's Brief, p. 27 (34 TTABVUE 35).

⁹⁰ Opposer's Brief, p. 26 (34 TTABVUE 34).

are related because land vehicles are the subject of Opposer's educational services, we find that the goods and services are related only in the sense that they are both in the automotive field. *See Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) ("the issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category."); *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 USPQ 222, 224 (TTAB 1983) ("The Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers."); *Cooper Indus., Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983) ("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required "relatedness."). Moreover, the goods and services are noncompetitive, they are not used together in any kind of complementary fashion, and they have nothing in common with respect to their essential characteristics or sales appeal. That many different automobile manufacturers require repair facilities to receive I-CAR training to be designated as authorized repair facilities is indicative of the noncompetitive nature of the goods and services.⁹¹ It is illogical for automotive

⁹¹ We note that in Opposer's response to Applicant's interrogatory No. 17 (24 TTABVUE 18), Opposer stated that its "primary competitors are automotive vehicle manufacturers,

manufacturers to require their repair shops to receive training from a competitor to become an authorized repair facility. Likewise, Opposer's argument that Applicant might want to become a partner with Opposer to develop and offer training on repairs specific to Applicant's vehicles is unpersuasive unless the parties agree that confusion is unlikely because they will not enter into a relationship that is likely to cause confusion due the similarity of the marks and nature of the goods and services. The parties only will enter into a relationship that is mutually beneficial.

Moreover, there is no evidence of conjoint use of the marks in connection with the goods and services or that they would be encountered in the same marketing milieu to establish that they are complementary. *See Sholl Dental Lab. Co. v. McKesson & Robbins, Inc.*, 150 F.2d 718, 66 USPQ 223, 226 (CCPA 1945) ("we deem it proper to say that, while not controlling, conjoint use is a fact proper to be considered along with other facts present in particular cases."); *Davia*, 110 USPQ2d at 1815; *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (goods frequently purchased in a single shopping trip found to be complementary).

With respect to the essential characteristics of the goods and services, there is no evidence that any third parties use the same or similar marks in connection with educational services in the automotive field and in connection with land vehicles.

parts/materials/equipment suppliers; and career technical schools, although all can also be collaboration partners and/or customers of [Opposer]." Nevertheless, Opposer did not identify any automotive vehicle manufacturers, or parts, materials and equipment suppliers that render educational or training services in the field of automobile body repair and damage analysis.

We find that the cumulative differences between “land vehicles” and “educational services consisting of conducting training course in auto body repair and damages analysis” is sufficient that they would not come to the attention of the same consumers under circumstances suggesting a common origin. Therefore, we find that the parties’ goods and services are not related.

D. Established, likely-to-continue channels of trade and buyers to whom sales are made.

Opposer was formed by “representatives from six segments of the automotive collision repair industry, namely, collision repair providers, insurance companies, OEMs (original equipment manufacturers, including specifically and principally automobile makers), educational providers, suppliers and other related industry providers.”⁹² Not surprisingly, Opposer markets its services “to a wide variety of individuals, businesses, educational institutions and others interested in the automotive and auto repair industries” such as “automotive repair facilities, automotive vehicle manufacturers, insurance companies who market auto policies, and career and technical schools.”⁹³

Opposer promotes its goods and services on its website located at www.i-car.com; at automotive industry conferences and events, such as the NACE/Cars Conference and Expo and the SEMA Show automotive specialty products trade event, as well as its own conferences and industry events; through its wide network

⁹² Van Alstyne Testimony Decl. ¶3 (19 TTABVUE 3); *see also* Opposer’s response to Applicant’s interrogatory No. 20 (24 TTABVUE 20) (“Opposer’s board is represented by repair facilities, automotive vehicle manufacturers, insurance companies, career technical schools and suppliers to the industry.”).

⁹³ Gonzales Testimony Decl. ¶4 (22 TTABVUE 3).

of instructors; as well as through its signage at auto repair shops. Opposer markets and sells its goods and services to a wide variety of individuals and companies including those interested in the automotive and auto repair industries. For example, Opposer markets directly to consumers to educate them on safe and quality repairs to promote I-CAR's services and its Gold Class repair facilities. Opposer also markets and sells directly to automotive repair facilities, automotive vehicle manufacturers, insurance companies who market auto policies, and career technical schools.⁹⁴

Because Opposer co-brands its I-CAR mark with OEM partners such as Honda, Nissan, Ford and GM,⁹⁵ the only segment of the population that is not aware that Opposer's services and land vehicles may emanate from a different source are ordinary consumers. Thus, Opposer "does extensive marketing directly to consumers to educate them on safe and quality repairs and to promote [Opposer's] services and its GOLD CLASS repair facilities."⁹⁶ However, as noted above, Opposer's marketing expenditures are modest. There is no testimony or evidence regarding the portion of Opposer's marketing expenditures directed toward ordinary consumers. It is hard to imagine, given the nature of Opposer's services and its core customers, that Opposer expends significant resources or effort on marketing to ordinary consumers. What we are missing is testimony or evidence regarding the effectiveness of Opposer's marketing to ordinary consumers.⁹⁷

⁹⁴ Opposer's response to Applicant's interrogatory No. 4 (24 TTABVUE 10). Opposer did not identify any products in its response to Applicant's interrogatory No. 23 (24 TTABVUE 21).

⁹⁵ Van Alstyne Testimony Decl. ¶7 and Exhibit B (19 TTABVUE 5 and 52-74).

⁹⁶ Gonzales Testimony Decl. ¶¶4 and 6 (22 TTABVUE 3 and 4).

⁹⁷ For example, Ann Gonzalez testified that Opposer engages in public relations campaigns "including public service safety tips, news articles and paid placements through NewUSA, the country's premier PR advertising and news feature placement service." Gonzalez

Opposer asserts that ordinary consumers will encounter Opposer's educational services and Applicant's land vehicles in the same marketing context because vehicle owners need repair facilities, many automobile manufacturers and insurance companies mandate that their authorized repair facilities be I-CAR trained, and I-CAR trained repair facilities display their I-CAR certifications in their shops on their websites.⁹⁸ The problem with Opposer's argument is that Opposer did not introduce any testimony or evidence regarding how an ordinary consumer selects an automobile body repair facility, specifically whether the vehicle owner notices the I-CAR certification in a repair shop, whether the vehicle owner has any knowledge as to what I-CAR training signifies, whether technical training is a factor in the consumers' selection process, and whether a substantial segment of consumers simply go to the repair facility recommended by their insurance adjuster. In other words, there is nothing in the record that tells us how and why a consumer selects an automobile collision repair facility.

Accordingly, we find that the channels of trade and classes of consumers weigh against finding that there is a likelihood of confusion.

Testimony Decl. ¶6 (22 TTABVUE 4). But there is no testimony or evidence regarding how many publications have printed Opposer's materials, how many readers have encountered those articles, or the effectiveness of those campaigns. Also, Ms. Gonzalez testified that Opposer has posted a website at i-car.com since 1996 which has had an increase in monthly users over the past four years. While the website posts consumer information, there is no testimony or evidence showing how many ordinary consumers access Opposer's website. Gonzalez Testimony Decl. ¶10 (22 TTABVUE 5). Finally, there is no testimony or evidence regarding how many ordinary consumers view Opposer's social media websites. Gonzalez Testimony Decl. ¶11 (22 TTABVUE 5).

⁹⁸ Applicant's Brief, pp. 25-26 (34 TTABVUE 33-34).

E. Conditions under which and buyers to whom sales are made, i.e. “impulse” versus careful, sophisticated purchasing.

Based on the nature of the goods (“land vehicles”) and services (“educational services consisting of conducting training course in auto body repair and damages analysis”) involved, one would expect that purchasers would exercise a heightened degree of care when making their purchasing decision. However, there is no testimony or evidence regarding the customer care in which Opposer’s “educational services” or Applicant’s “land vehicles” are purchased. Nevertheless, Opposer argues that “without limitation to the classes of consumers for Applicant’s vehicles, the Board ‘must include ordinary consumers as among prospective purchasers of [its] goods.’”⁹⁹

With respect to Opposer’s “educational services consisting of conducting training course in auto body repair and damages analysis,” an automobile collision repair facility, insurance company recommending an automobile collision repair facility, or automobile manufacturer or dealership would be expected to exercise sophistication and a heightened degree of care when selecting a contractor to provide educational services in the field of automotive collision vehicle repair.

With respect to Applicant’s “land vehicles,” because vehicle purchases tend to be expensive, are not an everyday purchase, and may be purchased after examination or test driving, for a specific purpose, after a comparison with other vehicles, to satisfy personal taste, or as a status symbol, even ordinary consumers may be expected to

⁹⁹ Opposer’s Brief, p. 33 (34 TTABVUE 41).

exercise a heightened degree of care when making a vehicle purchase. *See Weiss Assoc., Inc. v. HRL Assoc's., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990) (in making purchasing decisions regarding expensive goods, “the reasonably prudent person standard is elevated to the standard of the ‘discriminating purchaser.’”); *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1841 (TTAB 1989) (automobiles would be purchased only upon careful consideration); *see also McGregor-Doniger, Inc. Drizzle, Inc.*, 599 F.2d 1126, 202 USPQ 81, 92 (2nd Cir. 1979) (in making a hypothetical comparison to illustrate a point, the Court said “the average purchaser of an automobile will no doubt devote more attention to examining different products and determining their manufacturer or source than will the average purchaser of a ball of twine.”).

To the extent that Opposer contends that “ordinary consumers, employing nothing more than ordinary care in their purchasing decisions” must be considered in analyzing the degree of consumer care,¹⁰⁰ it seems to us that the “ordinary consumer” simply goes to the automobile collision repair facility recommended by its insurance company. On the other hand, the “ordinary consumer” that selects an automobile repair facility on his or her own will exercise a heightened degree of care because he or she will research the quality of the repair services rendered by individual facilities.

In view of the foregoing, we find that the degree of care likely to be exercised by the relevant ordinary purchasers does not support finding that there is a likelihood of confusion.

¹⁰⁰ Applicant’s Brief, p. 33 (34 TTABVUE 41).

F. Analyzing the factors.

Despite the similarities of the marks and the niche fame of Opposer's mark, we find that the number of third-party users for automobile related services, the differences between the goods and services, channels of trade, and classes of consumers, as well as the heightened degree of sophistication and care in the decision-making process in purchasing Opposer's educational services and Applicant's automotive goods, warrant a finding that there is no likelihood of confusion. In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

VI. Dilution by Blurring

Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), provides that:

the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

15 U.S.C. § 1125(c)(1). Therefore, to prevail on a dilution claim under the TDRA, a plaintiff must show that:

- (1) it owns a famous mark that is distinctive;

(2) the defendant is using a mark in commerce that dilutes the plaintiff's famous mark;

(3) the defendant's use of its mark began after the plaintiff's mark became famous; and

(4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach Servs., 101 USPQ2d at 1723-24.

Opposer argues that Applicant's mark ICAR would blur the distinctiveness of its I-CAR mark. Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B), defines dilution by blurring as "an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."

A. Whether Opposer introduced sufficient evidence of fame for dilution?

A threshold question in a federal dilution claim is whether the mark at issue is "famous." *Coach Servs.*, 101 USPQ2d at 1724. Under Section 43(c), a mark is famous if it "is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Section 15(c)(2)(A), 15 U.S.C. § 1125(c)(2)(A). By using the "general consuming public" as the benchmark, Section 43 of the Trademark Act eliminated the possibility of "niche fame." *Coach Servs.*, 101 USPQ2d at 1724. As noted above, Opposer proved that its mark is famous in connection with "educational services consisting of conducting training course in

auto body repair and damages analysis,” or niche fame. But that does not constitute fame for purposes of proving dilution.

“Fame for dilution requires widespread recognition by the general public.” *Coach Servs.*, 101 USPQ2d at 1725. “To establish the requisite level of fame, the ‘mark’s owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark. An opposer must show that, when the general public encounters the mark ‘in almost any context, it associates the term, at least initially, with the mark’s owner.’ *Id.* (quoting *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180-81 (TTAB 2001)). “In other words, a famous mark is one that has become a ‘household name.’” *Id.* (quoting *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 72 USPQ2d 1078, 1083 (9th Cir. 2004) (quoting *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564, 1575 (9th Cir. 2002))). Opposer’s evidence of fame does not come close to proving this level of renown.

B. Whether Opposer’s mark became famous prior to the filing date of Applicant’s application?

Additionally, the owner of an allegedly famous mark must show that its mark became famous “prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding.” *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Toro*, 61 USPQ2d at 1174)). However, even if we were to assume arguendo that Opposer’s mark achieved fame for purposes of protection against dilution, based on Opposer’s testimony and evidence regarding fame, we could not determine when I-CAR became famous, nor did Opposer address

when its I-CAR mark became famous in its main brief or reply brief. For example, some of the most important facts underlying our finding that Opposer's mark has achieved niche fame do not have associated dates, including the following:

- testimony that State Farm Insurance and a number of automobile manufacturers require I-CAR training to be authorized repair facilities, but Opposer did not include any dates when these entities required I-CAR training;
- there are "currently" over 600 technical schools that license I-CAR curricular, but Opposer did not provide the number of technical schools that licensed I-CAR curricula as of the filing date of Applicant's application;
- approximately 30% of all repair shops in the United States have had some form of I-CAR training, but Opposer did not provide the number of repair shops that had I-CAR training as of the filing date of Applicant's application;
- 35,000 professionals have I-CAR PLATINUM certification, 4,400 repair facilities have I-CAR GOLD CLASS status, and 2,300 repair facilities have I-CAR ROAD TO GOLD status, but Opposer did not provide any information about the status of these professionals or facilities as of the filing date of Applicant's application; and
- The I-CAR GOLD status and I-CAR ROAD TO GOLD status participants represent 20% of the repair facilities in the United States, but Opposer did not provide any information regarding the percentage of I-CAR GOLD and

I-CAR ROAD TO GOLD status participants as of the filing date of Applicant's application.

Accordingly, Opposer failed to meet its burden of proving that its I-CAR mark became famous prior to the filing date of Applicant's application.

Absent a showing of fame and a showing that Opposer's mark became famous prior to the filing date of Applicant's application, we need not address the remaining statutory factors for dilution by blurring. *See Coach Servs.* 101 USPQ2d 1726.

Decision: The opposition is dismissed with prejudice.