Paper No. 31
ejs

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 30, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Texaco Inc.

v.

Texlon Corporation

Opposition No. 92,897
to application Serial No. 74/262,159
filed on April 3, 1992

William G. Pecau of Pennie & Edmonds for Texaco Inc.

Texlon, Inc., pro se.

Before Seeherman, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Texaco Inc. has opposed the application of Texlon, Inc.[1] to register TEXLON as a trademark for "oil based motor

---

[1] In its "informal" answer and its formal answer applicant referred to itself as both Texlon, Inc. and Texlon Corporation. Noting this discrepancy, the Board contacted by telephone A. C. Galvin, the officer of applicant who signed the original paper, who stated that the correct name of applicant is Texlon Corporation. The Board thereupon allowed applicant 20 days in which to submit a written request to correct the mistake in its

oil additive for improving the performance of motor vehicles for retail sale to the general public."[2] As grounds for opposition opposer has alleged that it and its predecessor have been engaged in all phases of the oil and gas industry; that since prior to applicant's claimed date of first use in November 1991, opposer and its predecessor have conducted business under the trade name TEXACO; that its company name, TEXACO, is famous; that since 1903 opposer has used the mark TEXACO for various petroleum products, including automotive oils and greases; that since prior to November 1991 opposer has used various marks beginning with the prefix TEX, including TEXLUBE, TEXLITE, TEXGOLD and TEXLIN, for petroleum based products, and that the public regards these marks as being part of a family of marks belonging to opposer; that opposer owns registrations for TEXACO and its other TEX-prefix marks; and that applicant's mark so resembles opposer's marks TEXACO and its TEX-prefix family of marks that, when it is applied to applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

---

corporate name. No such request was ever filed; accordingly, Office records continue to reflect applicant's name as Texlon, Inc.

[2] Application Serial No. 74/262,159, filed April 3, 1992 and asserting first use and first use in commerce in November 1991.

In its answer applicant admitted "that Texaco is a major energy corporation" and essentially denied the remaining allegations in the notice of opposition.

The record includes the pleadings; the file of the opposed application; and the testimony, with exhibits, of opposer's four witnesses. Opposer has also submitted, under a notice of reliance, applicant's responses to certain of opposer's interrogatories and requests for admission, and certified status and title copies of its registrations for the following marks and goods and/or services:[3]

TEXACO	Petroleum products, comprising fuel-oils, gas-oils, illuminating-oils, lubricating-oils, and asphalt-oils[4] and for gas station services[5]

[3] Applicant also made of record Registration No. 1,651,153 for TEXLIN, but Office records show that this registration was cancelled in 1998 for failure to file a Section 8 affidavit. Similarly, Office records show that Registration No. 1,015,093 for TEXANDO has expired. Another registration made of record by opposer, No. 124,602 for TEXACO with a star design for oils and greases, was due for renewal on February 25, 1999. At this point Office records do not reflect that a renewal application has been filed, but neither do they indicate that the registration has expired. The existence of this registration would not make a difference in our decision herein; therefore, in order to avoid any question about our decision should it transpire that a timely, acceptable application for renewal was not filed, we have chosen not to discuss this registration, and do not base our decision on it.

[4] Registration No. 57,902, issued December 4, 1906; Section 8 affidavit accepted; Section 15 affidavit received; renewed four times.

[5] Registration No. 704,947, issued August 24, 1965; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

TEXLUBE	Petroleum products--viz., lubricating-oils[6]
TEXLITE	Kerosene-oil[7]
TEXGOLD	Soluble oil[8]
TEXAMATIC	Lubricating and hydraulic oils intended for use in hydraulic transmissions of automotive vehicles[9]
TEXCHEK	Testing of lubricant samples for preventive maintenance of engines[10]
TEXCHEK PLUS	Testing of lubricant samples for preventive maintenance of engines[11]
TEXNAP	Processing oils[12]

[6] Registration No. 128,185, issued December 23, 1919; renewed three times.

[7] Registration No. 129,404, issued February 17, 1920; renewed three times.

[8] Registration No. 933,473, issued May 9, 1972; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

[9] Registration No. 483,623, issued May 4, 1948; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice.

[10] Registration No. 927,947, issued January 25, 1972; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

[11] Registration No. 1,322,745, issued February 26, 1985; Section 8 affidavit accepted; Section 15 affidavit received.

[12] Registration No. 926,388, issued January 4, 1972; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

TEXOL	Petroleum products--viz., lubricating-oils[13]
TEXCLAD	Lubricants, particularly for use with earth moving machinery[14]
(with the representation of the star disclaimed)	Lubricating oils[15]
	Petroleum, asphalt oils, cutting oils, cylinder oils, gas oils, gasoline, lubricating greases, kerosene, naphtha, illuminating oils, lubricating oils, road oils, and paraffin[16]
	Gas station services[17]

[13] Registration No. 128,186, issued December 23, 1919; Section 8 affidavit accepted; Section 15 affidavit received; renewed three times.

[14] Registration No. 792,826, issued July 20, 1965; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

[15] Registration No. 76,131, issued December 14, 1909; renewed four times.

[16] Registration No. 150,620, issued January 3, 1922; Section 8 affidavit accepted; Section 15 affidavit received; renewed three times.

[17] Registration No. 794,948, issued August 24, 1965; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

	Gasoline[18] and gas station services[19]
	Gasoline[20] and gas station services[21]

Applicant did not make any evidence of record.

Opposer and applicant filed briefs on the case; an oral hearing was not requested.

Priority is not in issue in view of opposer's registrations, which are of record. See **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer has used such marks as TEXACO, the TEXACO and star logo, TEXAMATIC, TEXCHEK, TEXGOLD, TEXPAR, TEXNAP since long prior to applicant's use of TEXLON in 1991.

---

[18] Registration No. 1,222,305, issued January 4, 1983; Section 8 affidavit accepted; Section 15 affidavit received.

[19] Registration No. 1,315,019, issued January 15, 1985; Section 8 affidavit accepted, Section 15 affidavit received.

[20] Registration No. 1,222,306, issued January 4, 1983; Section 8 affidavit accepted; Section 15 affidavit received.

[21] Registration No. 1,315,020, issued January 15, 1985; Section 8 affidavit accepted; Section 15 affidavit received.

Turning to the issue of likelihood of confusion, we first note that, although opposer has asserted in its pleading and argued in its brief that it has a family of TEX-prefix marks, the evidence of record does not support this conclusion. Although opposer does have registrations for and uses various marks beginning with the letters TEX, it is well settled that the mere ownership of a number of marks showing a common feature is insufficient to establish a claim of ownership of a family of marks characterized by the feature in the absence of evidence that the various marks said to constitute the family were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. See **Hester Industries Inc. v. Tyson Foods Inc.**, 2 USPQ2d 1646 (TTAB 1987). The promotional materials submitted by opposer are insufficient to demonstrate that the general public would regard the TEX-prefix as the surname of a family of marks owned by opposer. Compare, **J&J Snack Foods, Corp. v. McDonald's Corp.**, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

Secondly, we note that although throughout its brief opposer has referred to its motor oil as TEXACO HAVOLINE, in fact the trademark TEXACO does not appear on the labels for this motor oil, and apparently has not since at least 1987.

In determining the issue of likelihood of confusion we have considered all the duPont factors for which there is evidence in the record. With respect to the goods, applicant's goods are identified as "oil based motor oil additive for improving the performance of motor vehicles for retail sale to the general public." Opposer has registered and used marks consisting of or containing the term TEXACO for a variety of petroleum products and related services, including TEXACO for gas-oils, lubricating oils and gas station services; TEXACO logos, consisting of the word TEXACO with a T-with-Star design, for gasoline and lubricating oils and gas station services; TEXLUBE and TEXOL for lubricating oils; and TEXCHECK and TEXCHEK PLUS for testing of lubricant samples for preventive maintenance of engines. The lubricating oils identified in opposer's various registrations would encompass motor oils, and by their very nature are closely related to oil-based motor oil additives such as that identified in applicant's application. Further, there is a close relationship between the various petroleum products opposer sells, such as gasoline and anti-freeze, and a motor oil additive. All of these products are petroleum based, and all are used in motor vehicles to improve or aid the performance of the vehicle engine. Similarly, gas station services are related to motor oil additives, in that gas stations provide various

petroleum-based products for use in motor vehicles, including motor oil additives. Applicant's motor oil additive could not only be sold to the same customers who purchase opposer's various petroleum products or who use opposer's gasoline station services but, because many of the gasoline stations selling opposer's TEXACO gasoline are independently owned, applicant's motor additives could even be sold at TEXACO service stations.[22]

We also note that for many years opposer has produced a motor oil. Although this product currently bears the product mark HAVOLINE, it also features opposer's logo of a T-within-a-star. Opposer has produced a market research survey showing that in an "unaided awareness study", i.e., showing the logo without any information about the company, 92% of the people interviewed associated this logo with opposer. In addition, opposer frequently promotes its HAVOLINE motor oil in conjunction with references to its TEXACO trademark or trade name. This study, combined with opposer's long use of the trademark HAVOLINE, and significant sales and promotion of this motor oil, indicate a public awareness that motor oil emanates from opposer, and is further evidence of the related nature of motor oil additives with gasoline and gasoline station services.

---

[22] Although normally the Board will not find likelihood of confusion if the opposer were creating the situation which would

With respect to the marks, applicant's mark TEXLON and opposer's marks TEXACO, TEXLUBE and TEXOL are similar, in that all begin with the letters TEX. Moreover, the second syllables in opposer's TEXLUBE and TEXOL marks are suggestive of the goods for which they are used--LUBE for lubricating oils, and OL for oil, while the second syllable of applicant's mark, LON, is suggestive of a major ingredient of applicant's motor oil additive, which is commonly sold under the trademark TEFLON. Because opposer's marks and applicant's mark have a common formulation, and thus create similar commercial impressions, consumers are likely to believe that lubricating/motor oils sold under the marks TEXLUBE and TEXOR, and oil-based motor oil additives sold under the mark TEXLON, emanate from the same source.

As for opposer's mark TEXACO, as well as its various TEXACO logos, an additional factor favoring opposer is the fame of these marks. Opposer has presented evidence of use and advertising of its TEXACO marks for almost 50 years. There are over 14,000 TEXACO service stations located throughout the United States, and sales of TEXACO brand gasolines average $5 billion per year. Other TEXACO branded products sold at retail, in the ten-year period between 1985 and 1995, were in excess of $6 billion. Opposer advertises its products and services in a wide variety of media,

---

lead to confusion, in this case opposer's TEXACO gasoline is

including television, radio, magazines, billboards, and through point of sale displays in service stations. It also sponsors various events, including 50 years of sponsoring weekly radio broadcasts of Metropolitan Opera performances; a NASCAR race car which bears the TEXACO mark; and NCAA football. Since 1987 opposer has spent over $75 million a year advertising its products and services, and in the ten years between 1985 and 1994 advertising expenditures were over $700 million. Eighty percent of opposer's advertising expenditures are for television advertising, and ninety percent of those commercials feature TEXACO gasoline and service stations.

It is well-established that when a mark is famous, this factor plays a dominant role in determining likelihood of confusion. **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). That is certainly the case here. The long-standing and widespread use of the TEXACO marks, significant sales, and major promotion of the TEXACO marks, leave us in no doubt that TEXACO is a famous mark, and would be recognized by virtually every motorist in the United States. Those same motorists, of course, would be the customers for applicant's motor-oil additive. Because of the fame of TEXACO, we find that such consumers, seeing TEXLON for a motor-oil additive,

---

sold, for the most part, through independent service stations.

are likely to believe that this product emanates from opposer.

We note applicant's argument that many businesses use TEXAS or TEX as part of their names. Applicant has not only submitted no evidence to support this argument,[23] but opposer's evidence specifically contradicts applicant's position. Specifically, opposer's witnesses, each of whom has many years of experience with the marketing and selling of gasoline and lubricants and other petroleum-based products, have all testified that they are unaware of any companies using a TEX-prefix as part of their trademarks for lubricant or gasoline products or services related thereto. In any event, in view of the fame achieved by opposer's mark TEXACO due to the length of use, sales and advertising, this mark has certainly become a strong mark.

Additional factors favoring opposer are that motor-oil additives are inexpensive items which are purchased by the public at large, and therefore will not be chosen with a great deal of care in terms of analyzing the trademark. For the reasons indicated above, such consumers are likely, upon seeing TEXLON on an oil-based motor oil additive, to quickly draw the conclusion that this is a TEXACO product. Thus, we are not persuaded by applicant's argument that consumers will read the product label, will find no reference to

opposer, and will recognize that applicant's address is different from opposer's.

With respect to applicant's label, we note that it prominently features a five-pointed star. A five-pointed star is also one of opposer's major trademarks and, as noted above, has a very strong consumer recognition as indicating opposer. Although applicant is not seeking to register the star design, and our decision herein would be the same even if such a design did not appear on the labels, the usage of a star design reinforces the likelihood that consumers will assume a connection between applicant's product and opposer.

Finally, applicant points out that opposer has failed to produce evidence of any episodes of actual confusion. However, as applicant itself has indicated in its brief, and as the record reflects, applicant did not begin to use the mark TEXLON for any products until December 1991, and ceased promoting these products in August 1992, and ceased all sales in September 1992. Its sales during that period were under $1300, and none of them were made in retail stores. In view of this extremely limited use, we conclude that there has not been sufficient opportunity for confusion to occur, such that the lack of evidence of actual confusion does not weigh against opposer.

---

[23] The attachment to applicant's answer, consisting of directory listings, was never properly made of record.

Accordingly, we find that applicant’s use of the mark TEXLON for its identified goods is likely to cause confusion with opposer’s registered marks TEXACO, its various logos featuring the term TEXACO, TEXLUBE and TEXOL.

Decision: The opposition is sustained.

E. J. Seeherman

C. E. Walters

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board