

**THIS OPINION IS NOT A
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Mailed:
April 6, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sonex Research, Inc.

Serial No. 77435929
Serial No. 77979007

Thomas J. Moore of Bacon & Thomas PLLC for Sonex Research, Inc.

Julie A. Watson, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Quinn, Bergsman and Kuczma,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Sonex Research, Inc. ("applicant") filed an application on the Principal Register for the mark SONEX, in standard character form, for "internal combustion engines for manned aerial vehicles and systems," in Class 7, as amended (Serial No. 77435929). Applicant also filed an application to register the mark SONEX, in standard character form, for "internal combustion engines for unmanned aerial vehicles," in Class 7, as amended (Serial No. 77979007).

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The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the previously registered mark SONEX, in standard character form, for "aircraft, and aircraft kits comprised of aircraft parts and plans to build complete aircraft," in Class 12.¹ In addition, in application Serial No. 77979007 for the mark SONEX for "internal combustion engines for unmanned aerial vehicles," the examining attorney also refused registration on the ground that the specimens of record do not show use of the mark for the products identified in the application.

Because the two appeals involve common questions of fact and law, we have consolidated the appeals.²

Likelihood Of Confusion

Our determination of likelihood of confusion 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 likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*,

¹ Registration No. 3257450, issued July 3, 2007.

² Applicant's counsel consented to the consolidation in a telephone conference on April 4, 2012.

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315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See 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").

- A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

The marks are identical.

- B. The similarity or dissimilarity and nature of the goods described in the application and registration, the channels of trade and classes of consumers.

We note at the outset that because the marks are identical, the extent to which applicant's identified goods and registrant's identified goods must be the same or similar to support a finding of likelihood of confusion is lessened. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). Where the marks are the same, as in this case, it is only necessary that there be a viable relationship between the goods to support a finding of likelihood of confusion. *See In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

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Applicant is seeking to register SONEX for "internal combustion engines for manned [and unmanned] aerial vehicles and systems" and the cited registration is for "aircraft, and aircraft kits comprised of aircraft parts and plans to build complete aircraft."

The USPTO looks to the ordinary meaning of words for the purpose of determining the scope of the identification of goods. TMEP §1402.03 (8th ed. 2011). The term "aerial vehicles" encompasses "aircraft." Thus, an "aircraft kit" comprised of "aircraft parts" "to build a complete aircraft" may include an internal combustion engine for manned and/or unmanned aerial vehicles because an engine generally needed to build a complete aircraft.

Applicant argues that "[i]t is well known and well established that aircraft engines are manufactured by different sources, as compared to the aircraft."³ While this may be true for aircraft and aircraft internal combustion engines,⁴ we focus our analysis on aircraft kits comprising parts to build a complete aircraft. An essential part of an aircraft is the engine and a consumer encountering both a SONEX aircraft kit and a SONEX internal

³ Applicant's Brief, pp. 6-7.

⁴ We note that this is attorney argument and it is not supported by any evidence in the record.

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combustion engine for manned and unmanned aerial vehicles is likely to believe that the two products emanate from the same source because of the similarity of the marks.

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in either of the applications or the cited registration, it is presumed that applicant's internal combustion engines for manned and unmanned aerial vehicles and registrant's kits for building complete aircraft move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). There is no evidence in the record regarding the channels of trade and classes of consumers for internal combustion engines for manned and unmanned aerial vehicles or for kits for building complete aircraft. However, since an internal combustion engine for manned and unmanned aerial vehicles may be a component of a kit for building a complete aircraft, we may logically assume that those products move in the same channels of trade and are sold to the same classes of consumers.

In view of the foregoing, we find that the goods are related and there is a presumption that they move in the

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same channels of trade and are sold to the same classes of consumers.

C. The degree of care exercised by consumers.

Applicant, without any evidentiary support, argues that because of the nature of the goods at issue, consumers will exercise a high degree of care. We recognize that the purchase of internal combustion engines for manned and unmanned aerial vehicles and kits for building aircraft are complex products and infrequent purchases for which the purchaser will have a focused need and to which the purchaser will direct his/her complete attention. However, even these careful consumers are not immune to trademark confusion. Thus, although this factor favors a finding of no likelihood of confusion, given the fact that the marks are identical and the goods are related, it is not sufficient to outweigh the other factors.

D. Balancing the *du Pont* factors.

In view of the facts that the marks are identical, the goods are related and we must presume that they move in the same channels of trade and are sold to the same classes of consumer, we find that applicant's mark SONEX, for "internal combustion engines for manned [and unmanned] aerial vehicles and systems," is likely to cause confusion with the registered mark SONEX for "aircraft, and aircraft kits

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comprised of aircraft parts and plans to build complete aircraft." In reaching the conclusion that applicant's mark is likely to cause confusion with the previously registered identical mark, we are also mindful that the products at issue are not impulse purchases. To the extent that this factor raises doubt as to the likelihood of confusion, any such doubt must be resolved in favor of the registered mark. *In re Hyper Shoppes*, 837 F.2d 463, 6 USPQ2d 1025, 10025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364, 367 (TTAB 1984).

Whether The Specimens Are Acceptable?

As indicated above, in application Serial No. 77979007 for the mark SONEX for "internal combustion engines for unmanned aerial vehicles," the examining attorney refused registration on the ground that the specimens of record do not show use of the mark for the products indentified in the application. Applicant submitted two specimens.

The most relevant part of the first specimen, filed October 4, 2010, is set forth below.

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SONEX RESEARCH, INC.

23 Hudson Street

Annapolis, MD 21401

Tel: 410-266-5556; Fax: 410-266-5653

E-mail: info@sonex-na.com

Website: www.sonexresearch.com

SONEX SIGNS LICENSE AND COLLABORATION AGREEMENTS FOR ITS UAS HEAVY FUEL ENGINE TECHNOLOGY

Released via PRNewswire

ANNAPOLIS, MARYLAND, November 7, 2006 - **SONEX RESEARCH, INC.** (OTC SONX), a leader in the field of combustion technology, announced that it has licensed a part of the patented Sonex Combustion System (SCS) heavy fuel engine (HFE) technology to Insitu, Inc. (Bingen, WA), a pioneer developer of long-range, unmanned, autonomous aircraft. Insitu is best known for its long endurance, low cost unmanned aerial systems (UAS) including the Insight™, the ScanEagle® UAS, developed in partnership with Boeing [NYSE: BA], and the GeoRanger™, UAS, developed in partnership with Fugro Airborne Surveys. Sonex and Insitu have also entered into a Collaboration Agreement under which the parties will consult and cooperate to identify potential new projects including the continued development and commercial application of the SCS HFE™ technology.

Pursuant to an Exclusive License Agreement signed this week with Insitu, over the next sixty days Sonex will receive cash payments for non-refundable advance royalties and an exclusivity fee. The license is exclusive to Insitu for UAS engines up to a certain engine size. Sonex will also receive per unit royalties from Insitu for each engine produced. The Collaboration Agreement also provides for minimum consulting fees to Sonex over the next two years. Further details of the two agreements remain confidential to maintain the competitive positions of both companies.

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The second specimen, filed May 9, 2011, is the invoice set forth below.

SONEX RESEARCH, INC.

23 Hudson Street
Annapolis, MD 21401
Tel: 410-266-5556; Fax: 410-266-5653
E-mail: info@sonex-na.com
Website: www.sonexresearch.com

INVOICE

Invoice #1070209

July 2, 2009

Via e-mail: [REDACTED]
[REDACTED]

Re: [REDACTED] PO: 005570

Description:

Assembly and delivery of one carbureted Brison 95 SCS HFE equipped with a DA ignition system and straight pipe u-bend exhaust. Shipped via UPS 2nd Day Air.

AMOUNT DUE THIS INVOICE

\$ [REDACTED]

Terms: Net 30 days

Make check payable to: Sonex Research, Inc.
23 Hudson Street
Annapolis, MD 21401

The first specimen is a November 7, 2006 press release issued through PRNewswire announcing that applicant has "licensed a part of the patented Sonex Combustion System (SCS) heavy fuel engine (HFE) technology to Insitu, Inc." The press release does not reference a SONEX brand internal

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combustion engine. There are two deficiencies with the press release: it is not affixed to the products and it does not show the use of the mark SONEX.

A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. Trademark Rule 2.56(b)(1), 37 CFR §2.56(b)(1). Press releases do not fall within the spectrum of acceptable specimens of use. See *Dynacolor Corp. v. Beckman & Whitley, Inc.*, 134 USPQ 410, 411 (TTAB 1962) (press release announcing availability of the product does not constitute public use of the mark). See also *In re Bright of America, Inc.*, 205 USPQ 65, 71 (TTAB 1979) ("it is apparent from the language of Section 45 of the Statute and the interpretation thereof by the Court in *In re Chicago Rawhide Manufacturing Co.* [455 F.2d 563, 173 USPQ 8 (CCPA 1972)] that invoices, announcements, order forms, bills of lading, instruction sheets as well as other types of leaflets and brochures and other printed advertising material used as such, including catalogs, catalog sheets, circulars, publicity releases, and the like do not constitute acceptable specimens of use of a mark referred to therein as a trademark for goods."). (Emphasis added).

Likewise, invoices are not generally acceptable specimens of use. *In re Chicago Rawhide Manufacturing Co.*,

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173 USPQ at 9 (use of mark on invoice which accompanies goods is not used on goods as required by the Act); *The Jim Dandy Co. v. Siler City Mills, Inc.*, 209 USPQ 764, 769 (TTAB 1981).

Applicant argues that it is impracticable for applicant to place the mark on the goods because its customer "has instructed Applicant that the trademark should not appear on the goods" *citing* paragraph No. 5 of the Amendment to Allege Use ("The customer for the goods sold under the trademark has instructed Applicant that the trademark should not appear on the goods.").⁵ Trademark Rule 2.56(b)(1), 37 CFR §2.56(b)(1) provides that "[t]he Office may accept another document related to the goods or sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods." This provision of the rules is intended to apply to situations where "the nature of the goods makes use on these items impracticable." TMEP §904.03(k) (8th ed. 2011).

For example, in rare circumstances it may be impracticable to place the mark on the goods or packaging for the goods if the goods are natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars.

⁵ Applicant's Brief, p. 9 (Serial No. 77979007). Applicant speculates that its customer may not "want the source of the engine to be traceable by users of the unmanned aerial vehicles." (Applicant's Brief, p. 10).

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In such instances, an acceptable specimen might be an invoice, a bill of lading, or a shipping document that shows the mark for the goods. ...

A mere assertion of impracticability does not suffice to establish that traditional trademark use is impracticable. Rather, the record must indicate that the goods are, in fact, of such a nature.

TMEP §904.03(k).

The circumstances of this case are not analogous to the situations described in the TMEP involving natural gas, grain sold in bulk or chemicals transported in tanker cars. While applicant's customer may have instructed applicant that the trademark should not appear on the goods, applicant could have placed the mark on a hang-tag, a sticker or on some other easily removable matter. For whatever reason, applicant has chosen not to affix its mark on its internal combustion engines in any form whatsoever. *See In re Settic, Inc.*, 80 USPQ2d 1185, 1189 (TTAB 2006) (Board held that there were a variety of ways applicant could have used its mark in the traditional manner without making it available to the end user).

Assuming *arguendo* that the customer's instructions not to place the mark on a product makes the product one on which it is impracticable to place the mark on the goods, neither specimen submitted by applicant shows the mark SONEX

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used to identify an internal combustion engine. The press release references the Sonex Combustion System heavy fuel engine technology, not a SONEX internal combustion engine.⁶ The description of the product on the invoice is a "Brison SCS HFE." "SCS" is the abbreviation for "Sonex Combustion System" and "HFE" is the abbreviation for "heavy fuel engine."⁷ Thus, the invoice identifies the sale of a Brison Sonex Combustion System heavy fuel engine. Accordingly, even if the specimens could be considered displays used in association with the goods, they would not be acceptable because they do not display the mark sought to be registered.

In view of the foregoing, we find that applicant has failed to submit an acceptable specimen showing the use of the mark SONEX used in connection with an internal combustion engine for an unmanned aerial vehicle.

Decision: The refusals to register are affirmed.

⁶ Although applicant asserts that "[t]he specimen announces an 'Exclusive License Agreement' by which the goods will be produced by Applicant located in Maryland, and shipped to Applicant's customer located in Bingen, Washington," (Applicant's Brief, p. 10), we cannot find any such corroboration for that contention in the press release.

⁷ See applicant's press release.