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Mailed:
March 16, 2010
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re A.C.E. International Company, Inc.

Serial No. 77481947

Daniel J. Mansur and John H. Pearson, Jr. of Pearson & Pearson, LLP for A.C.E. International Company, Inc.

Verna Beth Ririe, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Bucher, Holtzman and Ritchie, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

A.C.E. International Company, Inc. seeks registration on the Principal Register of the mark **CARRERA** (*in standard character format*) for "welding helmets" in International Class 9.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining

¹ Application Serial No. 77481947 was filed on May 23, 2008 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The foreign wording in the mark translates into English as "Race."

Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark **CARRERA** (*also in standard character format*) registered for, *inter alia*, " ... protective helmets, parts and accessories therefore," also in International Class 9,² as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the issues involved in the case.

We affirm the refusal to register.

In urging registrability, applicant argues that applicant and registrant do not make the same kinds of helmets, they do not compete with each other, they do not market their respective goods in the same trade channels, and they direct their products to different classes of sophisticated consumers.

By contrast, the Trademark Examining Attorney contends that we must presume that the registration encompasses all kinds of "protective helmets," including those in applicant's more specific identification of goods, that

² Registration No. 2825465 issued on March 23, 2004; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. The foreign wording in the mark translates into English as "Race."

the respective goods move in all normal channels of trade, and that they are available to all potential consumers of "protective helmets."

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the marks

We turn first to the *du Pont* factor focusing on the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective

marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). These marks are identical, applicant does not contend otherwise, and this factor weighs heavily in favor of a finding of likelihood of confusion.

Relationship of the Goods

When the marks are identical, as noted above, the relationship between the involved goods need not be as close to support a holding of likelihood of confusion as might apply where more significant differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Melville Corp.*, 18 USPQ2d 1386, 1387 (TTAB 1991); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983); and *Ancor, Inc. v. Ancor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981).

According to applicant, registrant ("Safilo") is an Italian company that has been making a name for itself in the global market for high-end, high-technology eyewear for more than fifty years.³ According to registrant's website, it is

³ <http://www.safilo.com/en>

recognized internationally for its ski eyewear, goggles and helmets as well as cycling



sunglasses and helmets.⁴ Applicant notes from the file folder of Safilo's cited registration that these "protective helmets" were originally identified as "protective helmets for skiing and bicycling." Consistent with this prosecution history, applicant points to a treasure-trove of information, including a fourteen-page press kit from Safilo Group S.p.A. (March 2008) as well as screen-shots taken from registrant's website. Having presented this evidence, applicant decries the unfairness of this refusal to register inasmuch as Safilo's "protective helmets" clearly do not include welding helmets, and applicant does not sell protective helmets for sports-related activities.

On the other hand, it is well settled that the issue of likelihood of confusion between an applied-for mark and a registered mark must be determined on the basis of the goods as they are identified in the involved application and cited registration, not on the basis of whatever the extrinsic evidence may show. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re*

⁴ www.carreraworld.com

Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *Paula Payne Products Company v. Johnson Publishing Company*, 177 USPQ 76 (CCPA 1973); and *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). In this regard, it would be improper to permit applicant to restrict the scope of its own goods and channels of trade, or to limit or modify the registrant's goods, based upon extrinsic evidence. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Accordingly, in the present case, without resort to extrinsic evidence, we must presume that registrant's "protective helmets" might well include welding helmets.

This is consistent with other evidence in the record showing that in the common parlance, the term "protective helmet" is used interchangeably with welding helmet:

Welding instructor sparks her students' careers at Palomar

By Pat Sherman

SAN MARCOS – It's not quite the same as crocheting a summer hat, but when Nancy Wood slips on her protective helmet and picks up her torch, the skills she employs in TIG welding are similar to those required for needlework, she said...⁵

⁵ The San Diego Union-Tribune, April 18, 2008., http://legacy.signonsandiego.com/uniontrib/20080418/news_lz1mc18weld.html

Welding helmets are headgear used when performing certain types of welding to protect the eyes, face and neck from flash burn⁶

"Protecting welding helmet" and "Welding protection helmet" occur hundreds of times on this single website.⁷

Welding helmets are headgear that protect the face, neck, and eyes from dangerous sparks, heat, and infrared and ultraviolet rays emitted when welding. The two main parts to a welding helmet are the **protective helmet** itself and the window through which you can see what you are doing.⁸

In fact, as to naming the two main parts of a welding safety helmet, the Trademark Examining Attorney points out that applicant is the owner of an earlier issued registration where the identification of goods actually uses the "protective helmets" language for its welding helmets, and has the same mark registered for the filter lens or "window" component:

VISION for "protective or safety helmets, namely, welding helmets" in International Class 9;⁹ and

VISION for "filter lenses for welding helmets" in International Class 9;¹⁰

⁶ http://en.wikipedia.org/wiki/Welding_helmet

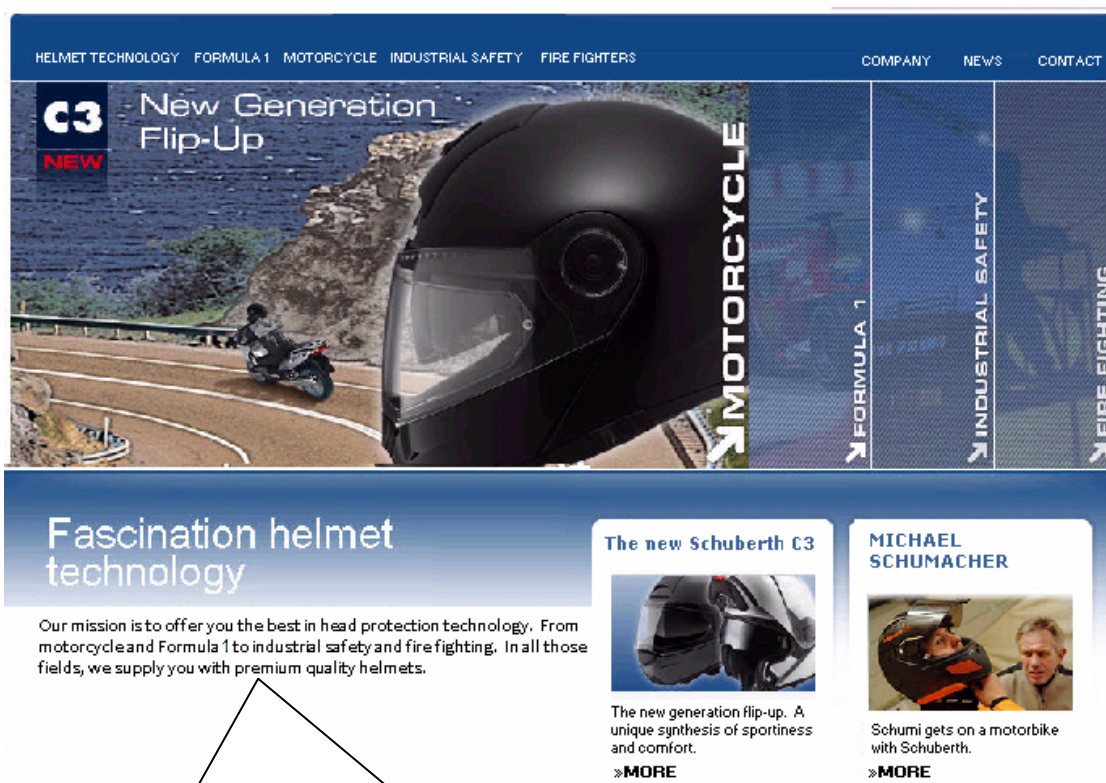
⁷ <http://www.alibaba.com/>

⁸ <http://www.wisegeek.com/what-are-welding-helmets.htm>

⁹ Registration No. 2391599 issued to A.C.E. International Company, Inc. on October 3, 2000; renewed.

¹⁰ Registration No. 2205123 issued to A.C.E. International Company, Inc. on November 24, 1998; renewed.

The Examining Attorney also placed into the record the website of a German producer of safety helmets for motorcyclists, Formula 1 racers and industrial workers, including welders:



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Our mission is to offer you the best in head protection technology. From motorcycle and Formula 1 to industrial safety and fire fighting. In all those fields, we supply you with premium quality helmets.

In addition to the above showing of the relatedness of the goods, the Trademark Examining Attorney has placed into the record a representative sampling of use-based, third-

¹¹ <http://www.schubert.com/en/home.html>

party registrations showing the same mark registered for both helmets for sports-related activities as well as welding helmets. While third-party registrations are not evidence of commercial use of the marks shown therein, or if in use, that the public is familiar with them, this is a common method of presenting probative evidence that suggests the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993) and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 n.6 (TTAB 1988):



for, *inter alia*, " ... motorcycle helmets, bicycle helmets ... laser welding devices; welding helmets; welding masks; welding torches; protection and safety apparatus, namely, ... protective helmets ... sunglasses" in International Class 9;¹²



for "plastic helmets, namely, plastic sports helmets; head protective helmets; head helmets, namely, bicycle helmets, motorcycle helmets, football helmets, catchers' helmets; safety helmets; safety and protective head helmets; engineering helmets, namely, welding helmets" in International Class 9;¹³ and

¹² Registration No. 3292581 issued on September 18, 2007.

¹³ Registration No. 3343869 issued on November 27, 2007.



for "protective helmets;
protective helmets for sports;
anti-dazzle spectacles; welding
helmets; dust protective
goggles and masks; protective
face masks not for medical
purposes; knee pads for
workers; shoes for protection
against accidents and fire;
protective clothing; gloves for
protection against accidents"
in international class 9;¹⁴

Even applicant's website confirms that safety goggles and safety glasses that protect the eyes from the burn of harmful welding rays are related accessories to welding helmets, darkening filters, hardhats and face shields.¹⁵

Accordingly, because we must presume that registrant's "protective helmets" might well include welding helmets, the same manufacturers and merchants do apply a single mark to industrial safety and sports-related helmets, and there is an obvious complementary quality between registrant's eyewear and applicant's protective filters for protecting the eyes of a welder, we find that these goods are related, and this *du Pont* factors weighs in favor of finding a likelihood of confusion herein.

¹⁴ Registration No. 3430024 issued on May 20, 2008.

¹⁵ <http://www.arclweldsafe.com>

Sophistication of the purchasers

Applicant argues that the purchasers of both applicant's and registrant's goods are sophisticated. Applicant contends that registrant sells expensive, high-end, high-tech, luxury eyewear. Applicant manufactures welding helmets and their parts, and sells them to sophisticated distributor who use great care in purchasing applicant's specialized goods precisely because it is protective equipment for the welding industry. Applicant has argued repeatedly that none of these skilled consumers would be confused between applicant's welding helmets and the protective helmets for sports activities offered by registrant.

Of course, we agree with applicant that, in reality, there are obvious differences between the respective goods. Everything in the record supports a conclusion that applicant's product is a helmet system designed for welding. It is a very specialized device for industrial safety, and has only one type of utility, namely with welding. By contrast, registrant's goods (ski and cycling eyewear and helmets) are all for sporting activities.

However, the question we must determine is not whether the *goods* will be confused, but whether there is likely to be confusion over the *source* of the goods. As noted

earlier, it is sufficient that the goods are related in some manner that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods.

Registrant's mark appears to be arbitrary for its goods. Yet applicant's mark is identical to registrant's mark in every respect. We must presume that registrant's "protective helmets" might well include welding helmets, the Trademark Examining Attorney has shown that the same manufacturers apply a single mark to industrial safety and sports-related helmets, and even applicant's website shows that there is an obvious complementary quality between, for example, registrant's type of eyewear and applicant's protective filters for protecting the eyes of a welder.

As to applicant's argument that that registrant's "protective helmets" were originally identified as "protective helmets for skiing and bicycling," the Board recently suggested one remedy in response to a similar argument:

Applicant was not without a remedy. Section 18 of the Trademark Act of 1946 gives the Board the equitable power to cancel registrations in whole or in part, "restrict

the goods or services identified in an application or registration," or to "otherwise restrict or rectify ... the registration of a registered mark." 15 U.S.C. § 1068; Trademark Rule 2.133(b). See also TBMP § 309.03(d) (2d ed. rev. 2004) and cases cited therein. Accordingly, applicant could have sought to restrict the description of goods in the cited registration to "industrial and commercial trailers sold to professional purchasers" and excluding recreational vehicles by filing a partial petition to cancel the cited registration and alleging that the proposed restriction will avoid a likelihood of confusion and that registrant is not using the mark on the products being excluded from the registration. *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co.*, 34 USPQ2d 1266, 1271 (TTAB 1994).

In re Thor Tech, 90 USPQ2d 1634, 1638, n.11 (TTAB 2009).

Here too, in light of applicant's arguments, one recourse would have been to pursue a Section 18 remedy, if deemed appropriate.

While applicant argues that its product is sold only to distributors, its identification of goods is not so restricted. Moreover, while applicant argues that registrant's "protective helmets" are actually limited to the sports of biking and skiing, they are not restricted this way in the identification of goods in the cited registration. There is no evidence in the record about the cost of registrant's goods or a showing that consumers

of registrant's goods exercise great care in purchasing such that it would minimize the likelihood of confusion.

Nonetheless, with related, if not overlapping goods, and with identical marks, even if applicant had supplied evidence as to the sophistication of all the involved purchasers, the fact that purchasers may well be sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion under these circumstances. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). At best for applicant, this *du Pont* factor is neutral.

Conclusion: Likelihood of Confusion

In conclusion, the *du Pont* factors favoring a finding of likelihood of confusion include the fact that the marks are identical, the goods are presumed to be related, and we must presume that they will move through some of the same channels of trade to the same classes of consumers.

Decision: The refusal to register this mark based upon Section 2(d) of the Lanham Act is hereby affirmed.