

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vision Wheel, Inc.

Serial Nos. 77498758 and 77498755¹

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114 (K. Margaret Le, Managing Attorney).

Before Bucher, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Vision Wheel, Inc. seeks registration on the Principal
Register of the marks V-TEC in standard characters² and

¹ Inasmuch as the issues raised by these appeals are similar, the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 77498758, unless otherwise noted; however, we have of course, considered all arguments and evidence filed in each case.

² Application Serial No. 77498758, filed on June 13, 2008, based on an allegation of first use in commerce on January 31, 2004 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

~~V-TEC~~³ for goods identified as "custom wheels for vehicles" in International Class 12.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered mark VTEC in typed form for "vehicles, namely, automobiles, motorcycles, motorized wheelbarrows and motorized land vehicles; engines for automobiles; engines for motorcycles; engines for other motorized land vehicles" in International Class 12,⁴ as to be likely to cause confusion, mistake or deception.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See

³ Application Serial No. 77498755, filed on June 13, 2008, based on an allegation of first use in commerce on January 31, 2004 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

⁴ Registration No. 2784942, issued on November 18, 2003, Section 8 and 15 declaration accepted and acknowledged.

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Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in terms of their appearance, sound, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In terms of sound, applicant's marks and registrant's mark are identical. Further, the marks consist of the same lettering in the same order V T E C, and, as such, are similar in appearance. The differences in appearance occasioned by the hyphen and, in the case of the mark in Serial No. 77498755, the stylization, are not sufficient to outweigh the similarities. The hyphen does not affect the pronunciation or overall commercial impression of applicant's marks, and is therefore not a basis on which to distinguish the marks. See Goodyear Tire & Rubber Co. v. Dayco Corp., 201 USPQ 485, 488 n.4 (TTAB 1978) (FAST-FINDER with hyphen is in legal contemplation substantially identical to FASTFINDER without hyphen). See also Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040, 2042 (TTAB 1989) (marks PRO-PRINT and PROPRINT identical but for hyphen and confusion likely).

Thus, the marks are very similar in sound, appearance and commercial impression.

With regard to connotation, applicant argues that the:

Examining Attorney's own evidence shows the Cited Registration is not an arbitrary term, but rather, is an abbreviation and acronym used by the Registrant to stand for the descriptive wording 'Variable Valve Timing and Lift Electronic Control' -a valvetrain system to improve the volumetric efficiency of a four-stroke internal combustion engine. ... the Registrant's specimen of record shows that VTEC as used by Registrant refers to the valvetrain system used in the engines and stands for "Variable Valve Timing and Lift Electronic Control."

Br. p. 20.

In addition, applicant argues that registrant's specimens of record "intentionally communicated to and educated the purchasing public about the functional advantage and technology embedded in its VTEC engine system as a marketing strategy to attract the purchasing public to certain Honda and Acura vehicles [and] the term VTEC is always used in a secondary manner together with the house marks of Honda..." Br. p. 21. Applicant relies on *In re Hershey*, 6 USPQ2d 170, 1472 (TTAB 1988) for its position that it is appropriate to look to the specimens of use to determine connotation or meaning of a mark. We first note, that *Hershey* involved a Section 2(a) refusal that the applied-for term was offensive. The Board needed to

determine how the term would be perceived by consumers in view of the fact that the term had more than one meaning. Here, VTEC by itself has no meaning, and while we acknowledge the record shows that registrant associates VTEC with the meaning "variable valve timing and lift electronic control," we must consider the marks as they appear on the drawing pages, and, based on the drawing pages the marks do not have a particular connotation distinct from each other.

Applicant also argues that registrant's mark is weak because it stands for descriptive wording. Assertions that the mark in a cited registration is descriptive constitute an impermissible collateral attack. Moreover, acronyms or initialisms are deemed to be merely descriptive of goods or services only if the wording it stands for is merely descriptive of the goods or services and the acronym or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents or stands for. See, e.g., *Modern Optics, Inc. v. The Univis Lens Co.*, 43 CCPA 970, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956) ("[A]s a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous

therewith"). While there is evidence in the record that VTEC is an abbreviation for a "variable valve timing and lift electronic," we do not find this sufficient to deem this term so weak that the mere addition of a hyphen or minor stylization distinguishes the marks enough to obviate likely confusion. Thus, due to the points of similarities in sound, appearance and commercial impression, we find they outweigh any possible dissimilarity in connotation that may be perceived.

We turn then to consider the respective goods. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. *Safety-Kleen Corp. v. Dresser Indus. Inc.*, 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975). It is sufficient to find goods to be related where the circumstances surrounding their marketing are such that they would be encountered by the same potential purchasers under circumstances that would give rise to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). Finally, we must make our determination based on the goods as they are identified in the application and registration and not based on evidence of their actual use. *Hewlett-Packard Co. v. Packard Press*

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Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

The examining attorney argues that:

In the field of land vehicles and related automotive accessories and parts, the Board has consistently upheld relatedness analysis determinations and has found that purchasers who would encounter same or similar marks for such products would likely be confused as to the source. ... Board decisions also reflect the marketplace reality that manufacturers of vehicles often produce parts and accessories for vehicles marketed under the same mark, as the original equipment manufacturer ("OEM"), and thus, marketing by different parties of various automotive parts under the same or similar marks would be likely to cause confusion as to the source.

Br. p. 6.

In support of her position that the goods are related and travel in the same channels of trade, the examining attorney submitted excerpts from various websites. She highlights websites that show that Honda (the registrant) manufactures wheels for its vehicles and argues that:

[A]n Internet search will enable a potential purchaser to locate a replacement wheel, customized to fit a specific model also manufactured by applicant. ... Specifically, the evidence demonstrates that any potential purchasers browsing the Internet can locate the webpages of both car dealerships and retailers of replacement parts for land vehicles, and these websites clearly show detailed photos of the respective goods offered for purchase. The evidence shows that, for example, the identical

Honda trademark on the wheels of a new car ... and on replacement wheels. ... Similarly, consumers who would encounter the V-TEC mark on wheels would likely be confused as to the source, given that these consumers would also encounter the VTEC mark on automobiles, especially factoring that car manufacturers produce and market many parts of new automobiles, including wheels, under the same or similar marks. Based on the application and registration, it is presumed that the respective goods identified by Applicant and Registrant would be commercially distributed and marketed without limitation, and would be available to purchasers at the retail stores, distributorships, ordering services, online retail stores, and specialty stores and outlets.

Br. pp. 7-8.

In response, applicant argues that the examining attorney primarily relies on several prior Board decisions and has not provided sufficient evidence to establish, *prima facie*, a relatedness between the involved goods.⁵

⁵ With its brief in Application Serial No. 77498758, applicant submitted several exhibits consisting of either reprints of the evidence already submitted by the examining attorney or printouts of additional pages from the same website from which the examining attorney submitted pages. These additional pages simply serve to provide the context of the examining attorney's information and we overrule the examining attorney's objection. Cf. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 829 (Fed. Cir. 1986) ("Let it be clear that by citing only a portion of an article, that portion is not thereby insulated from the context from whence it came"). This is distinguished from the circumstances presented in *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1598 fn. 3 (TTAB 1999) wherein the applicant was attempting to introduce full-text excerpts of additional articles that were not part of the record on appeal. We note that had we not considered this evidence, it would not change the result as applicant showed through its brief in Application Serial No. 77498755 the web pages already made of record by the examining attorney are sufficient to support applicant's assertions.

Quoting Federated Foods, 192 USPQ at 26, applicant asserts that "the fact that disparate goods in the same general field may be sold by a retailer will not necessarily support a finding that confusion is likely." Br. p. 5. Applicant contends that "the fact that certain general retailers in automobile parts and accessory industry have websites listing 'engine' and 'wheels' as products for sell [sic] under different categories" is not sufficient proof that applicant's custom wheels under the mark V-TEC would cause source confusion with registrant's VTEC mark on engines or vehicles. Applicant asserts that in the actual relevant market a consumer cannot "as a practical matter, purchase wheels or any parts of a vehicle without first identifying the proper year, maker and model of the specific vehicle on which the wheels or parts will be used." Br. p. 6.

Applicant and the examining attorney seem to agree that the record herein supports the conclusion that automobile makers are original equipment manufacturers [OEM] of wheels, engines, engine components, and completely assembled new automobiles. However, as applicant noted, there is no *per se* rule regarding this relationship, as each case presents its own specific set of facts and commercial realities, some of which may change over the

decades. Hence, the physical relationship and use of a house mark on an array of automobile components alone is not sufficient for the examining attorney to establish a *prima facie* case that wheels are related to automobiles, auto engines or their parts.

Applicant argues that the automobile owner wanting to purchase aftermarket, custom wheels will be sophisticated enough to know the source of such wheels, or would not be able to purchase such custom wheels without the assistance of expert, trained store personnel, or without computerized matrices, to ensure proper fitment based upon the make, model, and year of the involved vehicle.

We are not convinced by the limited evidence of record that automobiles and/or vehicle engines from the OEM are sufficiently commercially related to custom, aftermarket wheels such that confusion is likely. While the evidence shows that car manufacturers use their house marks on various parts of their automobiles and their factory replacement parts, it does not show that they use various product or secondary marks in such a ubiquitous fashion and there is no evidence to establish that VTEC is a house mark. The fact that one website may offer refurbished OEM wheels along with custom wheels does not establish that custom wheels and factory replacement wheels regularly

travel in the same channels of trade.⁶ More importantly, this does not establish that automobiles and engines travel in the same channel of trade as custom wheels, and, in fact, the evidence shows that automobiles are sold through authorized dealer networks.

Thus, this record does not support a finding that automobiles and engines are related to custom wheels or marketed in such a way as to be likely to cause confusion. Further, we find that the conditions of sale minimize any potential confusion. As the record shows each purchase of a wheel necessarily involves a careful process wherein a consumer must identify the year, manufacturer and model of a specific vehicle. In addition, automobiles and engines are very expensive items and custom wheels cannot be characterized as inexpensive general consumer items. In view thereof, we conclude that, despite the similarity of

⁶ The one example in the record is the excerpt from the website LW&T Lakeshore Wheel & Tire. It contains the following statement:

Welcome to Lakeshore Wheel & Tire! We are your online resource for quality refinished OEM (factory original) aluminum alloy and chrome wheels (i.e. rims). We offer many services including alloy wheel replacement and repair, chrome upgrading, match painting, and a wonderful alloy rim exchange program. Now offering top of the line Custom Wheels, including Rozzi, HPD, Mazzi, ION Alloys, and More! We are committed to excellence and customer service.

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the marks, the examining attorney has not established a *prima facie* case of likelihood of confusion.

Decision: The refusals to register under Section 2(d) of the Trademark Act are reversed.