

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/215083

APPLICANT: Torque-Traction Technologies, Inc.

CORRESPONDENT ADDRESS:
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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

Mailed: 1-13-05

MARK: SPR

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's refusal to register its trademark pursuant to Section 2 (d) of the Trademark Act. This refusal issued because the applicant's mark "SPR," when used in connection with its goods, is likely to be confused with the mark in Reg. No. 2083145, namely "SPR" and a design element.

The applicant's goods are identified as "driveshafts and driveshaft assemblies for land vehicles, associated hardware for use on land vehicles and parts thereof, namely shafts, yokes, universal joints, bearings, end fittings, journal crosses, and driveshaft center bearings." The registrant's goods are "piston rings."

FACTS

On February 14, 2003, applicant Torque-Traction Technologies filed application number 78215083 for the typed-form mark "SPR" for use on its driveline parts. On August 11, 2003, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 2(d), because the applicant's mark was likely to cause confusion with the mark in Reg. No. 2083145. No other issues were raised in the first action. Following the applicant's February 11, 2004 response, the examiner made final the Section 2(d) refusal on March 22, 2004. The applicant submitted its Notice of Appeal on September 20, 2004 and submitted its brief on appeal on November 8, 2004. The appeal brief was forwarded to the examining attorney on November 18, 2004. The applicant has requested an oral argument.

ISSUE

Whether the applicant's typed-form mark SPR is likely to be confused with the stylized mark SPR when used on similar goods.

ARGUMENT

Applicant's mark is likely to cause confusion with the registered mark when used in connection with the identified goods.

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. TMFP section 1207.01. The court in *In re E.I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), cert. denied, 351 U.S. 973, 109 USPQ 517 (1956). The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

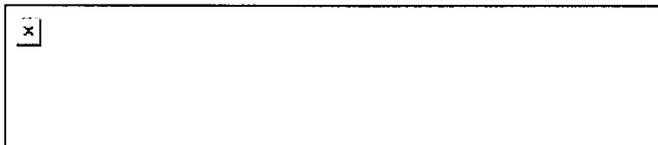
The applicant has raised several arguments in support of its claim that the marks are not confusingly similar. Chief among them are the applicant's claims that:

- The entirety of the registrant's mark differs from the applicant's mark.
- The goods in question are different.
- The marks have co-existed in the marketplace.

When these arguments are examined closely, however, it is clear that they are unpersuasive.

A. The marks are highly similar and create the same commercial impression.

At its heart, this case turns on the similarities between the applicant's typed-form mark SPR and the registrant's stylized mark. In this case, the registrant's mark is displayed as:



To the best of the undersigned examiner's knowledge following examination of the record, both marks appear to be arbitrary with regard to the goods in question.

As noted in the prosecution of this case, the examiner's Section 2(d) refusal issued because of his conclusion that applicant's typed form mark is virtually identical to the dominant element of the registrant's mark. The applicant argues that its mark differs because it is set forth in "plain block letters" whereas the registrant's mark is displayed in a distinctive typeface with a design element. However, the marks are far more similar than applicant asserts.

The applicant's mark is set forth in *typed form*. While applicant may interpret this display as "plain block letters," the legal interpretation of the mark is different. Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52 (a). The rights associated with a mark in typed or standard character form reside in the wording itself, and applicant is free to adopt any style of lettering, including lettering identical to that used by registrant. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012 (TTAB 1988); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987); *In re Hester Indus., Inc.*, 231 USPQ 881, 882, n.6 (TTAB 1986); *United Rum Merchants, Ltd. V. Fregal, Inc.*, 216 USPQ 217 (TTAB 1982); *Frances Denney, Inc. v. Vive Parfums, Ltd.*, 190 USPQ 302 (TTAB 1976); See also TMEP §1207.01(c)(iii). Thus, by filing a typed form mark, the applicant is seeking protection for displays of its mark in fonts similar to those of the registrant.

Moreover, the word portion of the registrant's mark – and not the design – is the dominant element. The applicant contends that the design element of the registered mark should be given substantial weight. However, as a matter of law, more weight is often accorded to the word portion of a composite mark because purchasers likely use the word to request goods or services. See *Trademark Manual of Examining Procedure Sect. 1207.01(b)(iv)*, citing *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Furthermore, as a matter of fact, the word portion of the registrant's mark is more prominently displayed than the design element, with the circles serving primarily as a carrier or border.

As is clearly visible in the above depiction from the Office's X-Search database, the word portion of the registered mark consists of the large bold print letters "SPR" centrally displayed on a thinner circle-design carrier. Clearly, given the visual and spatial prominence accorded to the typed element of the mark, consumers are likely to perceive the printed element as being dominant. The circle design functions merely as a pleasing design, and not the "heart" of the mark. Here, the circles function principally as a carrier for the letters SPR and do not contain any readily apparent independent meaning or significance.

Furthermore, consumers will not likely request the registrant's goods by referencing the design element. As consumers cannot pronounce the design element, when they ask for the registrant's goods, they will ask for "SPR." Here, "SPR" is spelled the same in both marks and is subject to only one likely pronunciation, namely as "ess-pea-ar." Correspondingly, it is a reasonable conclusion that consumers will pronounce the applicant's mark in the same fashion as they pronounce the registrant's mark. This

similarity alone has been held sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv).

The average consumer's memory is not infallible and his recollections of trade designations may well consist of the dominant, spoken term. Other elements of the registrant's mark are far less likely to be remembered by consumers, let alone spoken as they request the goods. Thus, while the design element cannot be disregarded, it adds little, if any, trademark significance to the registered mark. Accordingly, the term "SPR" must be seen as dominating the registered mark.

Finally, it must be noted that special attention is given to marks comprising a series of letters. It is well settled that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember words or figures, for example, such that confusion is more likely between arbitrarily arranged letters than between other types of marks. See, e.g., *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding confusion between TMS and TMM); *Dere v. Institute for Scientific Information, Inc.*, 420 F.2d 1068, 164 USPQ 347 (C.C.P.A. 1970) (finding confusion between ISI and I.A.I.); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986) (finding confusion between EB and EBS); Cf. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001) (finding confusion between registrant's KING FM and KING-TV and applicant's KYNG).

This principle was set forth in the decision of the Court of Customs and Patent Appeals in *Crystal Corp. v. Manhattan Chemical Mfg. Co.*, 75 F.2d 506, 25 USPQ 5, 6 (C.C.P.A. 1935) wherein the following reasoning was applied in holding Z.B.T. likely to be confused with T.Z.L.B. for talcum powder: "We think that it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely."

In summation, the marks are highly similar and share the same written and spoken element. The differences between the marks at issue are not sufficient to preclude a likelihood of confusion and special attention is given to marks comprising a series of letters. Finally, any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

B. The goods and trade channels are highly related.

With regard to the applicant's goods and the registrant's goods, the applicant has asserted simply that they are different, with applicant's goods being driveline components and registrant's goods comprising engine parts. However, the goods need not be *identical* for a likelihood of confusion to exist. In fact, applicant's position is overly narrow and misapprehends the standard for comparing goods in a

likelihood of confusion analysis.

The Trademark Trial and Appeal Board consistently has held that the respective goods need not be identical or even competitive to support a holding of likelihood of confusion. The likelihood of confusion regarding the source of the goods is the determining factor, and not the likelihood of confusion between particular goods themselves. See *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), and cases cited therein; TMEP §§1207.01 *et seq.*

Broadly speaking, the Trademark Trial and Appeal Board has held that marketing by different parties of different types of automotive parts and accessories under the same or similar marks is likely to cause confusion. See *In re Jeep Corporation*, 222 USPQ 333, 334 (TTAB 1984) (citing *Monarch Mufflers, Inc., v. Goerlick's, Inc.*, 148 USPQ 20 (TTAB 1965) (MONARCH for brake linings for automotive use likely to cause confusion with MONARCH for exhaust mufflers for motor vehicles); *AP Parts Corp. v. Automotive Products Associated*, 156 USPQ 254 (TTAB 1967) (AP for clutches, brakes, steering joints, tie-rod joints, and suspension joints for land vehicles, aircraft or watercraft likely to cause confusion with AP for mufflers for explosive engines); *Sieberling Rubber Co. v. General Battery and Ceramic Corp.*, 167 USPQ 766 (TTAB 1964) (HOLIDAY for storage batteries likely to cause confusion with HOLIDAY for pneumatic rubber tires and automobile floor mats); *In re Market Tire Co. of Maryland, Inc.*, 171 USPQ 636 (TTAB 1971) (ADMIRAL for vehicle tires likely to cause confusion with ADMIRAL for radiator antifreeze); *In re Uniroyal, Inc.*, 177 USPQ 29 (TTAB 1973) (KODIAK for vehicle tires likely to cause confusion with KODIAK and design for antifreeze and KODIAK for automobile heaters); *In re Magic Muffler Service, Inc.*, 184 USPQ 125 (TTAB 1984) (MAGIC for vehicle parts, namely mufflers likely to cause confusion with MAGIC for motors for motor vehicles); *In re Trelleborgs Gummifabriks Aktiebolag*, 189 USPQ 106 (TTAB 1975) (T and design for, *inter alia*, hoses, namely rubber hoses and inner tubes for tires and pneumatic, semisolid and solid tires likely to cause confusion with T and design for, *inter alia*, motor oil, oil additives and fuel additives); *In re Red Diamond Battery Co.*, 203 USPQ 472 (TTAB 1979) (RED DIAMOND for storage batteries likely to cause confusion with DIAMOND for pneumatic rubber automobile and vehicle tires); *In re Delbar Products, Inc.*, 217 USPQ 859 (TTAB 1981) (ULTRA for outside mounted vehicle mirrors likely to cause confusion with ULTRA and design for automobile parts, namely pistons and pins, valves, water pumps, oil pumps, universal joints, gears, axle shafts, hydraulic brake parts, automatic transmission repair kits and parts, engine bearings and jacks).

Moreover, as demonstrated in the registrations previously made of record, several parties (including, apparently, the applicant's parent company Dana Corporation) use the mark on piston rings and driveshaft components. This serves to demonstrate that such goods are often produced by the same source. Of particular note are the following registrations showing the use of one mark on:

- "Piston rings for internal combustion engines" and "drive train components for land vehicles,

namely driveshafts.” Reg. No. 1412025.

- “Piston rings” and “driveshafts, driveshaft assemblies, and associated hardware; end, slip, ball weld and tube yokes and yoke assemblies.” Reg. Nos. 1564166 and 1682538.
- “Piston rings” and “driveshafts, driveshaft assemblies and associated hardware, namely, end, slip, ball weld, tube yokes, yoke assemblies and center bearings.” Reg. No. 2282199.
- “Piston rings” and “driveshafts.” Reg. No. 1400808.

Thus it is likely that consumers are accustomed to seeing both the applicant’s goods and the registrant’s goods sold under same or similar marks. Such consumers are likely therefore to be confused as to the source of those goods.

C. The alleged coexistence of the marks does not render confusion unlikely.

Finally, the applicant’s arguments regarding the co-existence of the marks are unpersuasive. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant’s assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id.* at 1026-1027.

Therefore, the applicant’s argument regarding the alleged peaceful co-existence of the marks is of little probative value.

D. Summary

In summary, the applicant’s mark is highly similar in appearance, sound and commercial impression to the dominant portion of the registered mark. Further, the goods at issue are highly related to each other and are found in the same trade channels. Because consumers would mistakenly believe that the goods of the applicant and those of the registrant emanated from a common source, there is a likelihood of confusion as to the source of the goods. The refusal to register the applicant’s mark pursuant to Section 2(d) of the Trademark Act should therefore be affirmed.

Respectfully submitted,

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