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MARK: ANVIL



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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:
<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Tomberlin Product Group, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

5707-8

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant is attempting to register the mark ANVIL for "Land vehicles, namely, electric utility cars" in International Class 12. Registration was refused in accordance with Trademark Act Section 2(d), 15 U.S.C. 1052(d), on the ground that the mark is confusingly similar to U.S. Registration No. 2,680,860 for the mark ANVIL and design.

FACTS

The applicant filed this application under Sections 1(b) seeking to register the mark ANVIL for "Land vehicles, namely, electric utility cars" in IC 12. The mark was refused registration on the Principal Register under Section 2(d) citing Registration No. 2,680,860 for the mark ANVIL and design "for tires in International Class 12." The applicant responded by arguing against the stated refusal. The examining attorney considered the applicant's arguments in favor of registration carefully, but found them

unpersuasive. On November 9, 2006, the examining attorney issued a Final Office Action in accordance with 37 C.F.R. Section 2.64, refusing the mark under Section 2(d).

The following appeal ensued.

The applicant's appeal brief proposed, in essence, four arguments: 1) the applicant's and registrant's goods are not related, 2) the goods are sold in different channels of trade 3) the purchasers of the goods are sophisticated, and 4) there have been no instances of actual confusion.

ARGUMENT

CONTEMPORANEOUS USE OF THE APPLICANT'S MARK AND THE REGISTERED MARK ON THEIR RESPECTIVE GOODS IS LIKELY TO CAUSE CONFUSION AS TO THE SOURCE OF THE GOODS.

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 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 relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.* Any one of the listed DuPont factors may be dominant in any given case, depending upon the evidence of record. In this case, the following factors appear most relevant: similarity of the marks in their entirety, the similarity of the goods, and the channels of trade.

A) The Applicant and Registrant's Marks are Identical.

The applicant's mark is ANVIL and the registrant's mark is also ANVIL with a design of an anvil. The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b). Thus, because the marks are exactly the same in sound, spelling, meaning and connotation, and because the applicant has acknowledged

that the marks are identical,¹ the finding of similarity in each of these factors is sufficient to find the marks similar in their commercial impression.

B) The Goods are Closely Related in a Manner That Would Likely Cause

Confusion

In accordance with the practice established in *In re August Storck KG*, 218 USPQ 823 (TTAB 1983), after examining the marks to determine if they are similar, the next issue to be considered is the similarities between the goods associated with the marks and their marketing. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein; *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(i).

In this case the applicant's goods are "Land vehicles, namely, electric utility cars" in IC 12 and the registrant's goods are "tires." Electric utility cars use tires and there is no evidence in the record that the registrant's tires are not used for "electric utility cars." Furthermore, the Trademark Trial and Appeal Board has consistently found that the use of identical or similar marks on automobiles and on tires is likely to cause confusion. *In*

¹ Applicant's brief page 2, paragraph 2.

re Jeep Corp., 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor confusingly similar to LAREDO for pneumatic tires); *Ford Motor Company v. Hi-Performance Motors, Inc.*, 186 USPQ 64 (TTAB 1975) (representation of a coiled snake for automobile tires likely to cause confusion with COBRA for automobiles and automobile components); *In re McCreary Tire & Rubber Company*, 183 USPQ 256 (TTAB 1974) (THE PARK AVENUE for tires likely to cause confusion with PARK AVENUE for automobiles); *Jetzon Tire & Rubber Corporation v. General Motors Corporation*, 177 USPQ 467 (TTAB 1973) (GEMINI and GMINI for automobiles likely to cause confusion with GEMINI for vehicle tires).

The applicant has attempted to limit the registrant's goods to tires for forklifts², however, the registration is presumed to encompass all types of tires in all trade channels for tires, and the applicant may not restrict the scope of the registrant's goods by extrinsic argument. TMEP 1207.01(a)(iii). The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980). Therefore, it is likely that the registrant's tires are used for the applicant's electric utility cars and are thus closely related.

The applicant's cars are related to the registrant's tires because they are used together and the conditions surrounding their marketing are such that they could be

² Applicant's brief page 2.

encountered by the same purchasers. See the multiple third-party registrations attached to the November 9, 2006 Final Office Action, illustrating that tires and land vehicles often originate from a single source. Specifically see Registration Nos. 1220779, 2464267, 3091881, 2599645, and 3166894. These registrations have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely tires and land vehicles, are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

Thus, based on the evidence establishing that tires and land vehicles are closely related and originate from the same source, the examining attorney has established that the goods are related and that the conditions surrounding their marketing are such that they could be encountered by the same purchasers.

C) The Respective Goods are Used in the Same Channels of Trade

The applicant and registrant's goods are sold in the same channels of trade and encountered by the same consumers because tires are used on the electric utility vehicles and tires are often sold in the same location where vehicles are sold. Likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Since the

identification of the registrant's goods and/or services is very broad, it is presumed that the registration encompasses all goods and/or services of the type described, including those in the applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica International*, 196 USPQ 775 (TTAB 1977); TMEP §1207.01(a)(iii). Therefore based on the relatedness of the goods, it is likely that the registrant and applicant's goods are sold in the same channel of trade to the same purchases who will encounter the goods at the same time.

D) The Sophistication of the Purchasers Does Not Avoid a Likelihood of Confusion

The examining attorney disagrees that the consumers of the registrant's goods are "sophisticated businesses." [Applicant's brief pg. 6] The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). In this case, the examining attorney has established through multiple third party registrations that tires and land vehicles, which include "electric utility cars," often originate from the same source. Thus, even sophisticated consumers are likely to become confused as to the source of the goods.

E. Evidence of Actual Confusion is Unnecessary

The applicant argues that there is no evidence of confusion between the marks, however the applicant claims that the mark has only been in use since March 2006. Based on this claim, the mark had only been in use approximately one month at the date

of the first Office action and only 8 months at the date of the Final refusal. Clearly not long enough to analyze whether consumers had become confused as to the source of the goods.

Furthermore, 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, 1026-27 (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). Therefore without evidence to the contrary, it is *likely* that the applicant's mark will be associated with the registrant and confusion is *likely* to exist.

F. Applicant's Evidence Untimely Submitted

In its appeal brief applicant seeks to introduce evidence for review by the Board, namely, several copies of third party registrations and numerous web articles. The examining attorney objects to the submission of this evidence because it is untimely. The record in the application should be complete prior to the filing of an appeal. 37 CFR §

2.142(d). *See also In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Continental Records Inc*, 62 USPQ2d 1541 (TTAB 2002) (materials from web search engines submitted with appeal brief not considered); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1446 n.2 (TTAB 2000) (although applicant had properly submitted copies of third-party registrations, additional registrations listed in applicant's brief, which were not commented on by examining attorney in her brief, not considered); *In re Polo International Inc.*, 51 USPQ2d 1061,1062 n.2 (TTAB 1999) (typed list of third-party registrations submitted with applicant's brief which were objected to by examining attorney, not considered); *In re North American Free Trade Association*, 43 USPQ2d 1282, 1287 n.9 (TTAB 1997) (letter submitted with applicant's brief was not made of record during prosecution, and therefore not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (copy of unpublished case submitted with applicant's reply brief not considered); and TBMP §§ 1203.02(e) and 1207.01 (Evidence Submitted After Appeal Untimely - General Rule). Applicant did not comply with the established rule. Therefore, the evidence submitted with the applicant's brief should not be considered.

CONCLUSION

The examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). Therefore, in view of the fact that the marks are identical, the goods are closely related, and because the goods are marketed and sold in the same channels of trade, purchasers are therefore likely

to confuse the applicant's mark with the registrant's mark. For these reasons, the examining attorney requests that the Board affirm the refusal to register the applicant's mark ANVIL on the Principal Register, based on Section 2(d) of the Trademark Act.

Respectfully submitted,

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