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Subject: U.S. TRADEMARK APPLICATION NO. 79093026 - IFA - 400-0066 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 5

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79093026

MARK: IFA



CORRESPONDENT ADDRESS:

DAVID C. PURDUE

PURDUE LAW OFFICES, LLC

2735 N. HOLLAND-SYLVANIA RD.; SUITE B-2

TOLEDO, OH 43615

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

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APPLICANT: Warenzeichenverband für Erzeugnisse des ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

400-0066

CORRESPONDENT E-MAIL ADDRESS:

dpurdue@purdue-law.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/7/2015

INTERNATIONAL REGISTRATION NO. 1066418

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B),

715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated July 30, 2014 are maintained and continue to be final: Section 2(d) refusal. See TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action are satisfied: identification of goods. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Registration of the applied-for mark is refused as to International Class 012 because of a likelihood of confusion with the mark in U.S. Registration No. 4359531. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the registration incorporated by reference herein.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The Marks

The applicant has applied to register the mark **IFA** for, in relevant part, as amended, “Torque transmitting components for land vehicles, namely, transmission shafts, drive shafts, prop shafts, Cardan shafts, side shafts, universal joints, Cardan joints, CV joints, flexible disk joints, differentials, transfer cases, and clutches.” The registered mark is **IFA SUPERSTOCK** for “Filters, namely, fuel, oil, and air filters for automobiles and trucks.”

The applicant argues that in comparing the marks, “IFA” is not a recognized word and “superstock” is a recognized word. As such, the applicant asserts that “superstock” may be more likely to remember, and in any case, distinguishes the marks.

The term “superstock” is the combination of two terms with “super” defined as “bigger, better, or more important than others of the same kind,” and “stock” referring to “the supply of goods available for sale in a store.” Please see the attached definitions from Merriam-Webster's Online Dictionary, 11th Edition. The combined terms connote the larger amount of or better quality of goods available for sale. In relation to the preceding term, “IFA”, it describes a bigger or broader product base of the IFA brand. Contrary to the applicant’s assertion, consumers are likely to remember and attach greater significance to the “IFA” term in the registered mark.

Moreover, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In the instant case, the marks share the term “IFA.” Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding

COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

The applicant has attached prior U.S. registrations of single letter marks and single letter marks combined with other wording, all for automotive parts, to demonstrate that “Consumers are accustomed to distinguishing similar marks with the same first word, prefix, or syllable that are used by different companies in connection with automotive parts.”

With respect to the attached prior registrations, the marks are highly stylized and create separate and distinct commercial impressions, unlike the case at hand. Please note that the Trademark Trial and Appeal Board has previously 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, e.g., In re Delbar Prods., Inc.*, 217 USPQ 859, 861 (TTAB 1981) (holding ULTRA for outside mounted vehicle mirrors likely to be confused 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); *In re Red Diamond Battery Co.*, 203 USPQ 472, 472-73 (TTAB 1979) (holding RED DIAMOND for storage batteries likely to be confused with DIAMOND for pneumatic rubber automobile and vehicle tires); *In re Trelleborgs Gummifabriks Aktiebolag*, 189 USPQ 106, 107-08 (TTAB 1975) (holding T and design for, inter alia, hoses, namely rubber hoses and inner tubes for tires and pneumatic, semisolid and solid tires likely to be confused with T and design for, inter alia, motor oil, oil additives and fuel additives); *In re Magic Muffler Serv., Inc.*, 184 USPQ 125, 126 (TTAB 1974) (holding MAGIC for vehicle parts, namely mufflers, likely to be confused with MAGIC for motors for motor vehicles).

The Goods

In the instant case, the parties have highly related, land vehicles parts in the nature of air, fuel and oil filters and torque transmission components such that the goods would be marketed in the same channels of trade.

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

The applicant states that “there are entities that provide, i.e., sell/distribute virtually every part for various land vehicles.” However, the applicant argues that this does “not establish that the same marks are on those products. At best, it might establish that there are channels of trade within the automotive parts industry in which all automotive parts are sold.” The applicant asserts that in the case at hand, the parties “products are not related in any way that would suggest that there might be a likelihood of confusion.”

The attached Internet evidence consists of web pages from the examining attorney’s search in a computerized database. This evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods under the same mark, and that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant’s and registrant’s goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Please note the attached articles 1 – 3 evidencing the goods being sold in the same channels of trade. The attached articles 6-17 evidence the same marks being used on overlapping goods, namely, air, fuel or oil filters and camshafts, universal joints, differentials, drive shafts, or master cylinders.

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

In addition, the trademark examining attorney has attached evidence, and the evidence incorporated by reference herein, from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, fuel, air and oil filters for automobiles and torque and transmission components for land vehicles, namely, transmission shafts, drive shafts, prop shafts, Cardan shafts, side shafts, universal joints, Cardan joints, CV joints, flexible disk joints, differentials, transfer cases, and clutches, are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Lastly, the applicant asserts that consumers of applicant's goods are engineers and professional buyers or sophisticated mechanics "who are much less likely to be confused into thinking that applicant's goods come from the same source as registrant's goods." The applicant further states that the applicant's "torque transmitting components are purchased or purchased and installed by very sophisticated people," and that "consumers who would buy applicant's goods are going to be people who are very sophisticated with respect to the source of goods... Therefore, consumers who are familiar with registrant's IFA Superstock filters are not likely to be confused about the source of applicant's IFA torque transmitting components..."

Please note that when the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014); *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

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. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Accordingly, the request for reconsideration of the final refusal to register the mark as to International Class 012 under Section 2(d) of the Trademark Act is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/AKhan/

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OUR STORES COMPANY INFO PRODUCT CATALOGS TECH CENTER DEALER LOCATOR CONTACT US

PRODUCT CATEGORIES

- Accessories
- Camshafts**
 - AMC
 - Buick
 - Chrysler
 - Ford
 - Oldsmobile
 - Pontiac
 - Lifter Kits
 - Cam Card Locator
- Carburetors
- Chemicals
- Crate Engines
- Cylinder Heads
- Data Acquisition
- EIT
- Fuel Pumps
- Gaskets
- Installation Items
- Intake Manifolds
- Nitrous
- Plumbing
- Power Packages
- Shop Edelbrock
- Superchargers
- Top End Kits
- Valvetrain
- Water Pumps

Performance Camshafts, Lifter Kits & Valvetrain Components



Edelbrock camshafts are matched to **Edelbrock Total Power Package** components for proven performance, taking the guesswork out of camshaft selection. They are compatible with OEM or Edelbrock hydraulic roller tappets which reduce friction, virtually eliminate break-in problems, and permit higher valve velocities for increased performance.

PERFORMER-PLUS CAMSHAFTS

Designed for optimum torque from the low-end to the mid-range. Performer-Plus camshafts match with Performer manifolds for vehicles operating from off-idle to 5500 rpm. They are smooth idling cams for daily drivers, trucks, vans, RVs and 4x4s. You can expect a major improvement in throttle response and torque...



AMC	Buick	Chev 6 Cyl	Chev Small Block
Chev Big Block	Chrysler Small Block	Chrysler Big Block	
Ford Small Block	Ford Big Block	Oldsmobile	Pontiac

PERFORMER RPM CAMSHAFTS

Designed for street high-performance applications, Performer RPM cams