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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79131797
Applicant	Hyundai Motor Company
Applied for Mark	HYUNDAI AUTRON
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Submission	Applicants Request for Remand and Amendment
Attachments	2015 11 06 Request to Suspend Appeal and Remand HYUNDAI AUTRON App No 79131797.pdf(1328859 bytes)
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Date	11/06/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of:)
Hyundai Motor Company)
Application No. 79131797)
Filed: November 16, 2012)
Mark: )
Law Office: III)
Examining Attorney: Douglas M. Lee)

Request to Suspend Appeal and Remand for Additional Evidence

The Applicant, Hyundai Motor Company, pursuant to TBMP 1207.02 respectfully requests that this appeal be suspended and that the application be remanded for consideration of additional evidence, the attached consent agreements. As stated in TBMP 1207.02:

[B]ecause a consent agreement offered in response to a refusal to register [citation omitted] is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.

On the foregoing, the Applicant respectfully requests that the suspension and remand be granted.

Discussion of Additional Evidence on Remand

The sole issue remaining in examination and raised on appeal concerns Section 2(d) refusals of the Applicant's HYUNDAI AUTRON and Design mark relative to "HYUNDAI" formative marks identified as Registration Nos. 3080115 and 3080116 belonging to Hyundai Corporation (USA), Registration No. 3405683 belonging to Hyundai Heavy Industries Co., Ltd., and Registration No. 3306627 belonging to its subsidiary company, Hyundai Construction Equipment U.S.A., Inc.

The Applicant submits two (2) Consent Declarations, one from the Chairman and Chief Executive Officer of Hyundai Corporation, which owns and controls the subsidiary company Hyundai Corporation (USA), and the other from the Chairman and Chief Executive Officer of Hyundai Heavy Industries Co., Ltd., which owns and controls the subsidiary company Hyundai Construction Equipment U.S.A., Inc.

These Consent Declarations, among other things, explain the lengthy history and relationship among fraternal members of the Hyundai Group, including the Applicant, Hyundai Corporation, Hyundai Heavy Industries Co., Ltd. and subsidiary companies, and explains how the members through agreement and cooperation have over decades avoided confusion in respective uses of “Hyundai” formative marks. Based on these reasonable practices among the Applicant, Hyundai Corporation, Hyundai Heavy Industries Co., Ltd., and subsidiary companies, described in the Consent Declaration, these entities provide consent to the registration of the applied for mark.

The Consent Declarations reflect the experience and expertise of the real parties in interest and are entitled to great weight in determining whether confusion is likely. *In re Four Seasons Hotels Ltd.*, 26 USPQ2d 1071, 1073 (Fed. Cir. 1993) (“[T]hose most familiar with and affected by the marketplace were best able to attest to its effects and determine whether there was likelihood of confusion even in cases where marks were identical and goods closely related.”). See also, *In re E. I. du Pont De Nemours & Co.*, 177 USPQ 563 (C.C.P.A. 1973). TMEP § 1207.01(d)(viii) reflects the guidance of the Federal Circuit in stating:

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. [citing, *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 6 USPQ2d 1305 (Fed. Cir. 1988) and other cases.]

The above guidance gives great weight to the judgment of the marketplace participants and appropriately applies to the circumstances here.

Request for Amendments in International Class 7

On remand, the Applicant respectfully requests an amendment to the following identification in International Class 7:

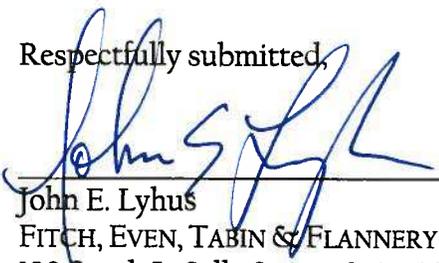
- “air compressors” to “air compressors for vehicles.”

The Applicant notes that this narrower identification appears in Class 7 of the Acceptable Identification of Goods and Services Manual.

On the foregoing, the Applicant respectfully requests that the Consent Declarations be accepted; that the proposed amendment be entered; and, that the trademark application be approved for publication.

November 6, 2015

By:

Respectfully submitted,


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hyundai Motor Company)
Mark: )
Serial No.: 79/131,797)
Filing Date: November 16, 2012)

DECLARATION

Hyundai Corporation (USA) makes this Declaration in support of the above-referenced trademark application belonging to the Applicant, Hyundai Motor Company (“Hyundai Motor”). I have the position of Chairman & C.E.O. and am an officer of Hyundai Corporation of South Korea, which owns and controls the subsidiary company, Hyundai Corporation (USA). Hyundai Corporation (USA) owns Registration Nos. 3080115 and 3080116 for HYUNDAI marks cited in examination. I am authorized to execute this Declaration on behalf of Hyundai Corporation (USA).

Hyundai Motor and Hyundai Corporation were both fraternal members of the same conglomerate group from Korea known as the Hyundai Group, having a common history dating from 1947. Hyundai Motor and Hyundai Corporation (USA) have co-existed in the United States and elsewhere for decades with each having the reciprocal right to use and register their respective marks containing the element “Hyundai.” Based on the long and substantial history of being fraternal member companies of the Hyundai Group, Hyundai Motor and Hyundai Corporation (USA) have over decades through agreement and cooperation used respective marks containing the element “Hyundai” for goods and services without confusion. The respective uses

of marks have not caused confusion and the companies originating from the Hyundai Group share a common business interest in protecting the marks and cooperate fully to avoid confusion.

Hyundai Corporation (USA) consents to Hyundai Motor's use and registration of its mark HYUNDAI AUTRON mark for the goods recited in its above-referenced application, as originally filed and as amended. We are also aware that Hyundai Motor uses its mark in different channels of distribution from Hyundai Corporation (USA) primarily within the automotive and manufacturing field, having a distinguishing trade style that avoids likelihood of confusion among the companies originating from the Hyundai Group. The purchasers of goods from Hyundai Motor have long been accustomed to distinguishing from Hyundai Corporation (USA). Hyundai Motor and Hyundai Corporation (USA) have cooperated and will continue to cooperate to avoid confusion, if any, between the respective marks.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

November 9, 2015

Hyundai Corporation

Signed: _____
Name: _____
Title: _____

HYUNDAI CORPORATION

Mong Hyuck Chung
Chairman & C.E.O.



of marks have not caused confusion and the companies originating from the Hyundai Group share a common business interest in protecting the marks and cooperate fully to avoid confusion.

Hyundai Heavy Industries consents to Hyundai Motor's use and registration of its mark HYUNDAI AUTRON mark for the goods recited in its above-referenced application, as originally filed and as amended. We are also aware that Hyundai Motor uses its mark in different channels of distribution from Hyundai Heavy Industries primarily within the automotive and manufacturing field, having a distinguishing trade style that avoids likelihood of confusion among the companies originating from the Hyundai Group. The purchasers of goods from Hyundai Motor have long been accustomed to distinguishing from Hyundai Heavy Industries. Hyundai Motor and Hyundai Heavy Industries have cooperated and will continue to cooperate to avoid confusion, if any, between the respective marks.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

OCTOBER 7, 2015

Hyundai Heavy Industries Co., Ltd.

Signed: 權五甲 

Name: KWON OH GAP

Title: Chairman & C.E.O