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

Proceeding	79132965
Applicant	Hyundai Motor Company
Applied for Mark	HYUNDAI AUTRON
Correspondence Address	JOHN E LYHUS FIRCH EVEN TABIN & FLANNERY LLP 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603 UNITED STATES trademark@fitcheven.com
Submission	Applicants Request for Remand and Amendment
Attachments	HYUNDAI AUTRON App No 79132965 Request to Suspend and Remand for Additional Evidence.pdf(930083 bytes)
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Signature	/John E. Lyhus/
Date	01/12/2016

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

In re application of:		)
Hyundai Motor Company		)
		)
Application No.	79132965	)
Filed:	November 16, 2012	)
Mark:	HYUNDAI AUTRON	)
Law Office:	115	)
Examining Attorney:	April K. Roach	)

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 agreement. 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 primary issue remaining in examination and raised on appeal concerns a Section 2(d) refusal of the Applicant's HYUNDAI AUTRON and Design mark relative to Registration Nos. 1432737, 1815765 and 3399983 for HYUNDAI marks belonging to Hyundai Corporation. The Applicant acknowledges that cited Registration No. 3540456 is cancelled and, further, the Applicant agrees to remove parentheses in the specification of goods as requested.

The Applicant submits a Consent Declaration from the Chairman and Chief Executive Officer of Hyundai Corporation, which among other things, explains the lengthy history and

relationship among fraternal members of the Hyundai Group, including the Applicant and Hyundai Corporation, 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 between the Applicant and Hyundai Corporation described in the Consent Declaration, Hyundai Corporation provides its consent to the registration of the applied for mark.

The Consent Declaration reflects the experience and expertise of the real parties in interest and is 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.

<u>Request for Amendments in International Class 9</u>

On remand, the Applicant respectfully requests the following amendments to certain identifications in International Class 9, with added wording **<u>underscored</u>** and deleted wording ~~stricken~~:

> Cameras <u>for vehicles</u>; adding machines; mechanisms for counter-operated apparatus, namely, coin or currency counting and sorting machines; mathematical instruments, namely, calculators <u>for vehicles</u>; time recording apparatus; electric calculators <u>for</u>

vehicles; totalizators, namely, adding machines; chronographs for use as specialized time recording apparatus; time recorders; electric relays; electrical relays and transformers; high-frequency switching power supplies; power controllers; reactors, namely, electrical reactors, laboratory chemical reactors; electrical connection boxes; switchboards for vehicles; indicating lamps for switchboards for vehicles; electrical distribution consoles; electrical distributing boards; electrical distribution boxes; electrical branch boxes, namely, junction boxes; electrical cell switches for vehicles; solenoid valves being electromagnetic switches for vehicles; voltage regulators for vehicles; step-up transformers; round plug connectors; electrical inductors; automatic time switches for vehicles; electrical reducers, namely, electric power convertors; electrical terminal blocks; electrical power distribution blocks; electrical transformers; electric switches for vehicles; electric light dimmers being regulators for vehicles; electric regulating apparatus; electrical adapters; electrical inverters; electrical control panels; electrical armatures; electric resistances; electric converters; electric connections; electric contacts; electric control panels; electric connectors; electric capacitors; electric coils; holders for electric coils; fuses for telecommunication apparatus; electrical fuses; current converters; electric current switches for vehicles; electric current control devices; current limiters; splices for electrical transmission lines; connections for electric lines; connectors for electric lines; electrical wire connectors; voltage surge protectors; voltage monitor modules; voltage stabilizing power supply; voltage stabilizers; voltage regulators; power switches for vehicles; electromagnetic coils; blinkers being signaling lights, namely, flashing safety lights for vehicles; current rectifiers; rectifier modules; electric apparatus for communication, namely, telecommunications and data networking hardware, namely, devices for transporting and aggregating voice, data and video communications across multiple network infrastructures and communications protocols; commutators; phase modifier, namely, power controllers; power transformers for amplification; circuit breakers; differential switches for vehicles; choking coils for use in controlling impedance in electrical apparatus; condensers being capacitors; rechargers for electric accumulators for vehicles; battery charge devices for vehicles; fuses; fuse wire; plug connectors; wires for metal alloys, namely, fuse wire; anti-interference devices for insulating electrical transmission, namely, insulators and filters for suppressing electrical interference; electrical circuit closers; rotary converters; electric power distribution machines and apparatus; electrical controllers; electrical controlling devices; vehicle radios for vehicles; stereos, namely, stereo amplifiers for vehicles, stereo receivers for vehicles, stereo tuners for vehicles; audiovisual receivers for vehicles; audio and video receivers for vehicles; receivers for satellites for vehicles; apparatus for voice recording and replaying for vehicles; apparatus for transmitting and reproducing sound or images for vehicles; sound and video recording and playback machines for vehicles; radio receivers and monitors for the reproduction of sound and signals for vehicles; apparatus for the recording/transmission or reproduction of sound and images for vehicles; recording and playing devices for sound and image carriers for vehicles; sound transmitting apparatus for vehicles; sound reproduction apparatus for vehicles; acoustic couplers for vehicles; portable media players for vehicles; car broadcasting tuners for vehicles; car televisions for vehicles; electro-acoustic transducers for vehicles; electric phonographs for vehicles; amplifiers for vehicles; loudspeakers with built-in amplifiers for vehicles; diaphragms used in acoustics, namely, electroacoustic transducers for vehicles; electricity limiters for vehicles; car video recorders for vehicles; car cassette players for vehicles; cassette recorders for vehicles; cassette

players for vehicles; tape and videotape players for vehicles; television monitors for vehicles; television receivers being tv sets for vehicles; television decoders for vehicles; television apparatus for vehicles; power amplifiers for vehicles; loud speaking apparatus and instruments, namely, loudspeaker systems comprised of speakers, amplifiers and speaker housings for vehicles; cabinets for loudspeakers for vehicles; public address systems for vehicles; CD players for vehicles; DVD players for vehicles; radiotelephony sets for vehicles; terminals for radiotelephones for vehicles; video phones for vehicles; devices for hands-free use of mobile phones for vehicles; intercoms for vehicles; interphones, namely, telephone intercoms for vehicles; telephone sets for vehicles; telephone connectors for vehicles; hands free kits for phones for vehicles; telephone answering apparatus for vehicles; answering machines for vehicles; telephone apparatus for vehicles; portable telephones for vehicles; electronic frequency converters for high velocity electro-motors; fixed multichannel communication apparatus, namely, multi-channel radio communication machines and apparatus for fixed stations for vehicles; fixed single channel communication apparatus, namely, single-channel radio communication machines and apparatus for fixed stations for vehicles; single-channel radio communication machines and apparatus for fixed stations for vehicles; apparatus for transmitting radio programmes and radio relay messages for vehicles; radar apparatus for vehicles; microphones for vehicles; modems for vehicles; devices for wireless radio transmission for vehicles; masts for wireless aerials for vehicles; radiotelegraphy sets for vehicles; antennas for wireless communications apparatus for vehicles; carrier frequency repeaters for vehicles; video multiplexers for vehicles; video transmission apparatus for vehicles; intercommunication apparatus, namely, interoperable communication system designed to provide radio, streaming video, wireless internet, and VOIP phone for vehicles; manual switching apparatus ~~(~~for telecommunication~~)~~ for vehicles; telegraph apparatus for vehicles; navigation apparatus for vehicles in the nature of on-board computers for vehicles; electro-dynamic apparatus for the remote control of signals; frequency converter for actuators; electric igniting apparatus, namely, electronic motor vehicle ignition control units that electronically monitor engine performance and deliver re-calculated sensor values to regulate engine performance; remote control apparatus, namely, remote control transmitter for radio-controlled devices, remote control starters and remote operation of vehicle functions; remote control telemetering machines and apparatus; global positioning systems being GPS for vehicles; satellite aerials for vehicles; satellite navigational apparatus for vehicles; voice frequency transmission machines and apparatus for vehicles; apparatus for wireless transmission of acoustic information for vehicles; satellite navigation equipment for vehicles; automatic answering machines for vehicles; automatic telegraph apparatus for vehicles; automatic telephone exchanges for vehicles; navigation apparatus and instruments for vehicles; car aerials; telecommunication machines and implements, namely, telephone apparatus for vehicles; transmitters for telecommunication; transmitting sets for telecommunication, namely, telecommunications transmitters; telegraphs apparatus; frequency converters; electrical transit switches for vehicles; radar receivers with amplifiers; car antennas for vehicles; communications apparatus for vehicles, namely, apparatus for transmission of communication for vehicles; electro-dynamic apparatus for the remote control of railway points, namely, a train control system used in the railway industry for detecting and controlling trains, ground faults, broken rails, power failures, track switches and lights for vehicles; cable transmission machines and apparatus, namely, cable broadcast

transmission machines and apparatus; television transmitters for vehicles; teleprompters for televisions for vehicles; teletypewriters for vehicles; teleprinters for vehicles; electric resistors for telecommunication apparatus; electric capacitors for telecommunication apparatus; telecommunication exchanges; telecommunications transmitters; apparatus for transmission of sound; converters; portable communications apparatus, namely, portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files for vehicles; computer programs being downloadable software for use in remote control of vehicles and devices, for use in monitoring vehicle performance and maintenance, for use in transmitting vehicle performance and maintenance data to others, for use in accessing information about vehicle system control, performance, maintenance and operation from networks, for use in updating electronic control unit operating systems, for use in providing technical support to software developers in vehicle field, for use in receiving entertainment content, navigational and location information for vehicles, and radio signals, for use in testing vehicle control systems, for use in transmitting vehicle telemetry and operation information, for use in monitoring and maintaining electronic interfaces to mechanical vehicle systems; computer programs for document management; operating system programs; computer application software for mobile phones and smart phones, namely, software for electronic control of vehicles, software for obtaining information based on geographic location and proximity, software for obtaining parking information, vehicle use and repair information; computer game programs for vehicles; computer software for operating vehicle electronic controls and control units; data processing apparatus; microprocessors; vehicle drive training simulators; electronic circuit machines, namely, computer hardware and educational software for learning about circuit board layout, function, and diagnostics for vehicles; computers for vehicles; communications computers for vehicles; geiger counters; phototubes, namely, photoelectric tubes; laser measuring systems; light-emitting electronic pointers; luminous pointers; video monitors; electric discharge tubes other than for lighting; cyclotrons; electronic tags for goods; thermionic valves; electronic cards for processing images; magnetic encoders; electronic notice boards for vehicles; electrical monitoring apparatus, namely, electronic monitors and monitor modules for monitoring electric current and electrical signals for vehicles; secure terminals for electronic transactions; electrical sockets for vehicles; safety contact plugs; anodes; cathodes; cathodic anti-corrosion apparatus, namely, cathodes for eliminating corrosion; magnets; magnetic cores; decorative magnets; covers for electric outlets; electric sockets for vehicles; electric plugs for vehicles; electromagnets; electric collectors, namely, electric accumulators; plugs, namely, electrical plugs; plug adaptors; plugs, sockets for vehicles and other contacts, namely, electric connections; power strips with moveable sockets for vehicles; electronic notice boards for vehicles; electron tubes; electronic theft prevention installations, namely, access control and alarm monitoring systems, alarm installations and alarms for vehicles; cards incorporating electronic devices, namely, electronic key cards, blank smart cards, encoded identity cards for vehicles; electronic coding units for vehicles; electronic indicator panels for vehicles; transmitters of electronic signals for vehicles; electronic payment terminals for vehicles; electronic indicator boards for vehicles; rectifier tubes; alarm central units; cards with integrated circuits for vehicles; couplers being data processing equipment for vehicles; monitors being computer hardware for vehicles; electric control panels for checking electric cables; encoded magnetic cards for use as gift cards, debit cards, credit cards, key cards,

identity cards; card readers for credit cards; automatic solar tracking sensors; closed loop circuit boards; holograms, namely, electronic image files containing holograms, namely, downloadable image files and image files recorded on electronic storage media; IC cards, namely, integrated circuit cards; LCD large-screen displays **for vehicles**; LCD panels **for vehicles**; diodes; semi-conductors; semi-conductor memories; semiconductor elements, namely, semiconductor power elements; semi-conductor wafers; semiconductor power elements; light emitting diodes being LEDs; silicon wafers in the form of silicon slices; electronic circuit boards; connectors for electronic circuits; integrated circuits; circuit boards provided with integrated circuits; integrated circuit modules; chips being integrated circuits; thermistors; multi-outlet socket blocks **for vehicles**; anticathodes; transistors; circuit boards; erasing magnets.

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.

Respectfully submitted,

January 12, 2016

By: _____

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Attorneys for Applicant

8491-131125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hyundai Motor Company	)
		)
Mark:	HYUNDAI AUTRON	)
		)
Serial No.:	79/132,965	)
		)
Filing Date:	November 16, 2012	)
		)

DECLARATION

Hyundai Corporation 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. I am authorized to execute this Declaration on behalf of Hyundai Corporation.

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 have co-existed in Korea, 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 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 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 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. Hyundai Motor and Hyundai Corporation 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.

January 7, 2016, 2015

Hyundai Corporation

Signed: _____

HYUNDAI CORPORATION

Name: Mong Hyuck Chung

Mong Hyuck Chung

Title: Chairman & C.E.O.