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Subject: U.S. TRADEMARK APPLICATION NO. 79147140 - E SPEED - SC&PT0124WOU - Request for Reconsideration Denied - Return to TTAB - Message 1 of 2

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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. 79147140

MARK: E SPEED



CORRESPONDENT ADDRESS:

DONALD L OTTO

RENNER OTTO BOISSELLE & SKLAR LLP

1621 EUCLID AVENUE NINETEENTH FLOOR

CLEVELAND, OH 44115

GENERAL TRADEMARK INFORMATION:

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APPLICANT: KTM-Sportmotorcycle AG

CORRESPONDENT'S REFERENCE/DOCKET NO:

SC&PT0124WOU

CORRESPONDENT E-MAIL ADDRESS:

dotto@rennerotto.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/22/2015

INTERNATIONAL REGISTRATION NO. 1203491

Status

The referenced application is currently the subject of an appeal with the Trademark Trial and Appeal Board (Board). However, the Board has suspended action on the appeal and has remanded the application to the trademark examining attorney to consider specific issues pertaining to the application. See 37 C.F.R. §2.142(d), (f); TMEP §1504.05. In this case, the Board has requested that the following issues be considered: (1) Amendment to the identification of goods in Classes 007 and 012; and (2) Refusal To Register the mark under Section 2(d).

The trademark examining attorney has carefully reviewed applicant's most recent response. In the response, applicant addresses the outstanding refusals and requirements by limiting the scope of goods in Class 007. The identification of goods is now acceptable; however, this does not resolve all outstanding issues because the amendment to the identification of goods does not obviate a likelihood of confusion refusal.

Because applicant's response does not resolve all outstanding refusals nor otherwise put the application in condition for publication or registration, the final refusal to register the mark under Trademark Act Section 2(d)—Likelihood of confusion is maintained for the goods in Classes 007 and 012.

The Board has been notified to resume the appeal. See TMEP §715.04(b).

Refusal To Register Under Section 2(d)—Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4192491. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.*

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, 1361, 177 USPQ 563, 567 (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.*

Comparison of the Marks

Applicant's mark E SPEED is similar in sound, meaning and appearance to registrant's mark ESPEED. The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). The only distinction between the marks is the space between the letter E and the term SPEED in applicant's mark. This slight modification in spelling does not change the meaning or overall commercial impression of the marks.

Therefore, the marks are confusingly similar.

Where the marks of the respective parties are identical or virtually identical, the relationship between the relevant goods and/or services need not be as close to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); TMEP §1207.01(a).

II. Comparison of the Goods and/or Services

Applicant has amended the goods in Class 007 to "fans and cylinders for motors for two-wheeled vehicles; silencers for motors and engines for two-wheeled vehicles; exhausts, cylinder heads for engines for two-wheeled vehicles; ignition devices for two-wheeled vehicles in the nature of ignition covers specifically adapted for use with electronic ignitions."

The amendment to the identification of goods does not obviate the likelihood of confusion refusal because “ignition devices for two-wheeled vehicles in the nature of ignition covers specifically adapted for use with electronic ignitions” are closely related to the goods in the cited registration, namely, automobile engines and parts for automobile engines.

The attached Internet evidence consists of third party websites of companies that manufacture both automobile parts including engines and parts for two-wheeled vehicles. This evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods under a single mark. See attached evidence which shows that Honda manufactures dirt bike ignition covers as well as engine parts for land vehicles including transmissions, gaskets, connecting pipes and automobile engines. See also evidence which shows that Suzuki manufactures ignition covers for motorcycles as well as automobile engines and transmissions and related parts.

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).

Evidence obtained from the Internet may be used to support a determination under 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). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat’l Telecomms. & Info. Admin. & Statistics Admin., *Exploring the Digital Nation: America’s Emerging Online Experience* (2013), available at http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

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, 1025 (Fed. Cir. 1988).

The evidence of record demonstrates that potential purchasers are accustomed to seeing the same mark used in connection with ignition covers for two wheeled vehicles and automobile engines, transmissions and related parts similar to those covered in the cited registration.

Therefore, the use of nearly identical marks on applicant's goods and registrant's goods is likely to result in confusion.

Therefore, the final refusal to register the mark under Section 2(d) is maintained. This refusal is limited to Classes 007 and 012.

/Saima Makhdoom/

Examining Attorney

Law Office 101

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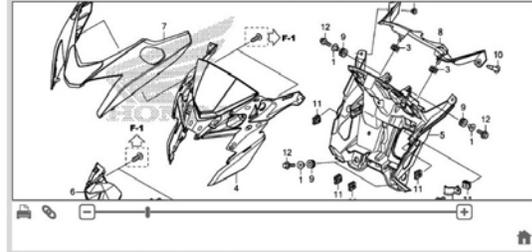
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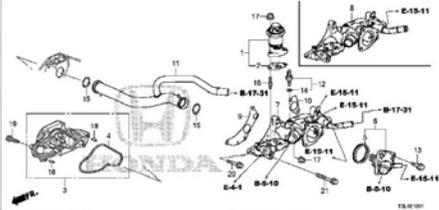
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	001	002	18715-PB2-000	View	GASKET, EGR VALVE (ISHINO GASKET)		7.30	5.12	0.00	
	001	003	19200-R70-A11	View	WATER PUMP (MAGNA POWERTRAIN)		164.92	115.81	0.00	
	001	004	19222-R70-A11	View	GASKET, WATER PUMP (MAGNA POWERTRAIN)		4.20	3.36	0.00	
	001	005	19305-PNA-003	View	SEAL, THERMOSTAT COVER (NIPPON THERMOSTAT)		4.42	3.10	0.00	
	001	006	19315-5G0-A01	View	COVER ASSY., THERMOSTAT		44.08	28.84	0.00	
	001	006	19315-5G2-A01	View	COVER ASSY., THERMOSTAT		42.40	29.55	0.00	
	001	007	19410-5G0-A01	View	PASSAGE, WATER		182.20	128.26	0.00	
	001	008	19410-5G2-A00	View	PASSAGE, WATER		189.93	133.33	0.00	
	001	009	19411-5G0-A02	View	GASKET, FR. WATER PASSAGE (NIPPON LEAKLESS)		6.48	3.64	0.00	
	001	010	19412-5G0-A01	View	GASKET, RR. WATER PASSAGE (NIPPON LEAKLESS)		2.62	1.80	0.00	
	001	011	19505-5G0-A00	View	PIPE, CONNECTING		31.93	22.42	0.00	
	001	012	37870-RTA-005	View	SENSOR ASSY., WATER TEMPERATURE (DENSO)		29.67	27.85	0.00	
	003	013	90050-PNA-003	View	BOLT, SPECIAL (8X19) (NIPPON THERMOSTAT)		1.60	1.12	0.00	
	001	014	91307-RTA-005	View	O-RING (DENSO)		2.45	1.51	0.00	
	002	015	91314-PH7-003	View	O-RING (1.2X4.1) (NOK)		2.42	1.73	0.00	
	002	016	92900-09022-08	View	BOLT, STUD (8X2)		1.22	0.85	0.00	
	006	017	94050-06080	View	NUT, FLANGE (8MM)		0.27	0.19	0.00	
	002	018	94301-06100	View	PIN, DOWEL (6X10)		1.26	0.88	0.00	
	005	019	95701-06022-08	View	BOLT, FLANGE (8X22)		1.02	0.71	0.00	
	001	020	95701-08025-08	View	BOLT, FLANGE (8X25)		0.42	0.33	0.00	
	001	021	95701-08075-08	View	BOLT, FLANGE (8X75)		1.62	1.13	0.00	

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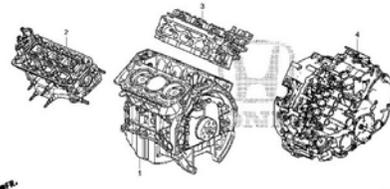
1 By **VIN#** Search | 2 By **Year** Search | 3 By **Accessory Catalog** Search

4 By **Model** *Year *Doors *Trim Emission Made In Trans Interior Color **Make**

ACCORD 2013 2 EX-LV6 SELECT SELECT SELECT

*Section: **ENGINE** Search Criteria: **ACCORD(2013)2(EX-LV6)**

Assembly: [View Large Image](#) | [Scroll Down to Parts](#)



THROTTLE BODY (V6)
 PURGE CONTROL SOLENOID VALVE (V6)
 INTAKE MANIFOLD (V6)
 FUEL INJECTOR (V6)
 ENGINE COVER (V6)
 CONVERTER (V6)
 PLUG HOLE COIL - PLUG (V6)
 AUTO TENSIONER (V6)
 ALTERNATOR (DENSO) (V6)
 ENGINE WIRE HARNESS (V6)
 ENGINE WIRE HARNESS STAY (V6)
 STARTER MOTOR (MITSUBA) (V6) (MT)
 STARTER MOTOR (MITSUBA) (V6) (AT)
 BREATHER TUBE (V6)
 CYLINDER HEAD COVER (V6)

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PARTS LIST
 You did not use the "(1) By VIN# search option. Only a search by VIN# will ensure the ordered part fit your vehicle!

Order Qty	Qty Needed	Wht. No.	Part Number	View Replacement Details Part Number	Description	Color code name	MSRP	Price	Refundable Core Deposit	Shipping
	001	001	10002-5G0-A01	View	GENERAL ASSY., CYLINDER BLOCK		2381.46	1811.10	0.00	
	001	001	10002-5G0-A02	View	GENERAL ASSY., CYLINDER BLOCK		2381.46	1811.10	0.00	
	001	001	10002-5G2-A02	View	GENERAL ASSY., CYLINDER BLOCK		2336.41	1775.85	0.00	
	001	002	10004-5G0-A00	View	GENERAL ASSY., FR CYLINDER HEAD		1422.64	1123.67	0.00	
	001	002	10004-5G2-A00	View	GENERAL ASSY., FR CYLINDER HEAD		1422.64	1123.67	0.00	