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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. 79147141

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&PT0125WOU

CORRESPONDENT E-MAIL ADDRESS:

dotto@rennerotto.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/22/2015

INTERNATIONAL REGISTRATION NO. 1203492

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 and services in Classes 006 and 007; 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 issues by clarifying the nature of the goods in the application and limiting the scope of goods in Class 007. The identification of goods and services is now acceptable; however, this does not resolve the issue 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 trademark examining attorney is holding the following issue in final status: Refusal to Register Under Section 2(d)—Likelihood of confusion with 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

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant's mark is E SPEED and registrant's mark is ESPEED. The marks are identical in sound and meaning because they both combine the letter E with the term SPEED. In addition, the connotation and commercial impression of the marks do not differ when considered in connection with applicant's and registrant's respective goods.

The background design and colors used in applicant's mark do not distinguish the marks. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Although the applicant has added a background carrier and color to its mark, this does not change the overall commercial impression of the mark. Moreover, registrant's standard character mark may be displayed in any font, style or color including those used by the applicant in its mark.

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 applicant's "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, specifically, engines and engine parts for land vehicles.

The attached Internet evidence consists of third party websites of companies that manufacture both automobile parts 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. & Econ. & 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.

Thus, the final refusal to register the mark is maintained. This refusal is limited to Classes 007 and 012.

/Saima Makhdoom/

Examining Attorney

Law Office 101

U.S. Patent and Trademark Office

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Honda used the occasion of the 2015 Detroit auto show to announce plans to roll out its upcoming family of turbocharged four-cylinder engines by the end of 2015. Honda said it is investing $340 million at its Anna, Ohio, engine plant to accommodate a third assembly line for the engines, among other upgrades to the facility.

Honda still won't say how much power these new mills would make, nor which vehicles will get them first, butwe had a chance to sample one such engine with 2.0 liters of displacement in a Civic Type R prototype—now there's a car we'd like to have in America!—and we were told at the time that the 2.0-liter could pump out a maximum of roughly 300 horsepower. We'll bring you more tantalizing turbo tales as soon as Honda's willing to tell them.

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91551-PNA-003 $ 7.05

BEARING, BALL

90556-SF1-000 $ 6.69

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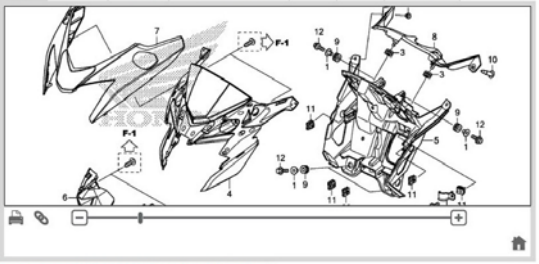

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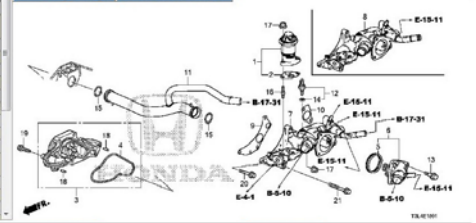

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	001	003	19200-R70-A11	View		WATER PUMP (MAGNA POWERTRAIN)		~~164.97~~	115.81	0.00	
	001	004	19222-R70-A11	View		GASKET, WATER PUMP (MAGNA POWERTRAIN)		~~4.78~~	3.36	0.00	
	001	005	19305-PNA-003	View		SEAL, THERMOSTAT COVER (NIPPON THERMOSTAT)		~~4.42~~	3.10	0.00	
	001	006	19315-5G0-A01	View		COVER ASSY., THERMOSTAT		~~41.08~~	28.84	0.00	
	001	006	19315-5G2-A01	View		COVER ASSY., THERMOSTAT		~~42.10~~	29.55	0.00	
	001	007	19410-5G0-A01	View		PASSAGE, WATER		~~182.70~~	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)		~~5.18~~	3.64	0.00	
	001	010	19412-5G0-A01	View		GASKET, RR. WATER PASSAGE (NIPPON LEAKLESS)		~~2.67~~	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)		~~39.67~~	27.85	0.00	
	003	013	90050-PNA-003	View		BOLT, SPECIAL (6X19) (NIPPON THERMOSTAT)		~~1.60~~	1.12	0.00	
	001	014	91307-RTA-005	View		O-RING (DENSO)		~~2.15~~	1.51	0.00	
	002	015	91314-PH7-003	View		O-RING (31.2X4.1) (NOK)		~~2.47~~	1.73	0.00	
	002	016	92900-08022-0B	View		BOLT, STUD (8X22)		~~1.22~~	0.85	0.00	
	006	017	94050-08080	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 (6X22)		~~1.02~~	0.71	0.00	
	001	020	95701-08025-08	View		BOLT, FLANGE (8X25)		~~0.47~~	0.33	0.00	
	001	021	95701-08075-08	View		BOLT, FLANGE (8X75)		~~1.62~~	1.13	0.00	

Find any Honda Part or Honda Accessory offered by Honda USA:
(1) By Honda VIN# - recommended for greatest accuracy - locates only those Honda auto parts and accessories manufactured for your great vehicle

for your exact vehicle.

Where do I find my Vehicle's VIN#?

(2) By Honda Part# - locates all parts and accessories manufactured by Honda for all of its Cars, Trucks, SUVs, and Vans.

(3) By Accessory Catalog - locates most accessories for late model Honda Cars, Trucks, SUVs, and Vans.

(4) By Honda Model - locates all parts and accessories manufactured by Honda for all of its Cars, Trucks, SUVs, and Vans.

Some models are manufactured for the US in more than one country. Each country may have a few parts that are manufactured to fit only vehicles built in their country.

The **(4) By Model** option is less accurate than the **(1) By VIN#** option in that it displays parts for all countries - with no way for you to select the correct parts for your vehicle.

The **(1) By VIN#** option is accurate in that it will display ONLY those parts that fit your exact vehicle.

Honda Accord parts are available at Bernardi Parts. When you make a purchase from Bernardi, you can rest assured that your order will be fulfilled by an authorized, long-standing seller of genuine Honda Accord parts. Bernardi Parts guarantees the lowest prices you'll find on all Honda parts and accessories. Browse our wide selection of Honda Accord parts for your vehicle. Having trouble finding the Honda Accord part you're looking for? Call one of our Honda parts specialists at 800-924-1884 and we'll help you find exactly what you need.

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Honda Parts Search - 4 Options

RESET all search options

1 By VIN# Search | 2 By Model# Search | 3 By Accessory Catalog: Search

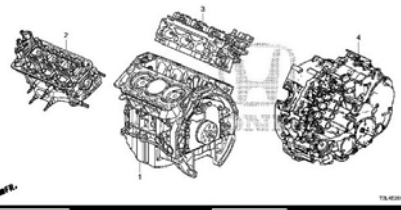
4 By *Model *Year *Doors *Trim Emission Made In Trans Interior Color Help

ACCORD | 2013 | 2 | EX-LV6 | SELECT | (SELECT) | SELECT | (SELECT)

*Section: ENGINE — Search Criteria: ACCORD|2013|2|EX-LV6

Assembly
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)

View Large Image | Scroll Down to Parts



ADD PART(S) TO CART | VIEW CART

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	Illus. No.	Part Number	View Details	Replacement 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		~~2336.11~~	1775.85	0.00	
	001	002	10004-5G0-A00	View		GENERAL ASSY., FR. CYLINDER HEAD		~~1477.54~~	1123.67	0.00	
	001	002	10004-5G2-A00	View		GENERAL ASSY., FR. CYLINDER HEAD		~~1477.54~~	1123.67	0.00	