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

Proceeding	79147141
Applicant	KTM-Sportmotorcycle AG
Applied for Mark	E SPEED
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Attorney Docket No. SC&PT0125WOUS

In re application of: KTM-Sportmotorcycle AG

Serial No.: 79147141

Filing Date: September 11, 2013

Mark: E SPEED and design

Law Office: 101

Examining Attorney: Saima Makhdoom

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

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I. Introduction

Applicant has appealed to the Trademark Trial and Appeal Board (TTAB) from the final decision dated December 30, 2014 refusing registration of the applied-for mark under Section 2(d) of the Trademark Act, and objection to the highlighted wording in the identification of goods in Classes 6 and 7. Applicant has filed a timely notice of appeal.

II. Identification of Goods and Services

The Examining Attorney objected to the highlighted wording in the identification of goods for Classes 6 and 7 on the ground it is broad and must be clarified because it could include a variety of goods and services in each class. See final Office Action, p. 5.

To comply with this requirement, applicant has contemporaneously filed a Voluntary Amendment (copy attached) clarifying the identification of goods in Classes 6 and 7 along the lines suggested by the Examining Attorney. Accordingly, withdrawal of this objection is respectfully requested.

III. Refusal to Register Under Section 2(d) - Likelihood of Confusion

The Examining Attorney refused registration of the applied-for mark allegedly because of a likelihood of confusion with the mark in US Registration No. 4192491. See final Office Action, p. 2.

IV. Argument

A determination of likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of the facts in evidence that are relevant to the factors bearing on likelihood of confusion. See *In re E. I. DuPont and DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In this case the Examining Attorney considers the following factors to be the most relevant in the likelihood of confusion analysis:

1. Similarity of the marks.
2. Similarity and nature of the goods and/or services.
3. Similarity of the trade channels of the goods and/or services. See final Office Action, p. 3.

Each of these factors is discussed below.

A. Comparison of the Marks

The Examining Attorney considers applicant's E SPEED and design mark to be confusingly similar in sound, meaning and appearance to registrant's mark ESPEED because they contain nearly identical wording. According to the Examining Attorney, the only distinction is that applicant uses a hyphen between the terms E and SPEED which is insignificant and does not change the sound or meaning of the mark. See final Office Action, p. 3.

While both applicant's mark and registrant's mark combine the letter E with the term SPEED, in determining whether or not the marks are similar, they must be considered in their entireties in terms of sound, appearance, meaning and commercial impression. The test is whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 73 USPQ 2d 1689 (Fed. Cir. 2005); *China Healthways, Inc. v. Wang*, 491 F.3d 1337, 1340, 83 USPQ 2d 1123 (Fed. Cir. 2007).

Applicant's mark does not have a hyphen between the terms E and SPEED as alleged by the Examining Attorney. However, there are significant distinctions between applicant's mark and registrant's mark. In particular, the "e" of applicant's mark is of a distinctive orange color and the term SPEED of applicant's mark consists of a highly stylized font in white letters, all on a black background, which, when considered in its entirety, creates an entirely different commercial impression than registrant's mark and thus is not likely to be confused with registrant's mark.

B. Comparison of the Goods and/or Services

According to the Examining Attorney, the evidence of record shows that the applicant builds race-ready motorcycles for competitive and recreational riding and also develops and manufactures engine, frame, swing arm, exhaust system, and chassis components, as well as power parts and power wear products which are offered through a network of dealers. However, it is respectfully submitted that none of the attachments to the final Office Action, including the excerpt from Business Week Magazine (Attachment-13) is evidence of record that applicant manufactures these goods for land vehicles/automobiles.

Moreover, in comparing applicant's goods to registrant's goods, the Examining Attorney limited the comparison of applicant's goods in Classes 7 and 12 to registrant's Class 12 goods. See final Office Action, p. 3, 4. * Accordingly, it is respectfully submitted that applicant's Class 6 goods, which applicant has requested be amended by a Voluntary Amendment filed contemporaneously herewith to overcome the Examining Attorney's objection that the wording "competition plates" is vague and does not clarify the exact nature of the goods, namely, "license plate carriers of metal and

competition number plates of metal, namely, metal racing number plates for two wheeled vehicles for use in Motorcross racing", are not closely related to registrant's goods.

Moreover, it is respectfully submitted that applicant's Class 7 goods (as also amended by a Voluntary Amendment filed contemporaneously herewith to specify the exact nature of "ignition covers"), namely, "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 adapted for use with electronic ignitions", are not closely related to registrant's Class 12 goods, namely, "automotive parts ... for land vehicles, ... engines for automobiles ... units for drive train of automobiles, ... longitudinal shafts ... all for automobiles and parts thereof, ... drive shafts ... for land vehicles, ... automobile transmissions and parts thereof ...".

Likewise, it is respectfully submitted that applicant's Class 12 goods, namely, "electric motor powered two-wheeled vehicles and electrically powered two-wheeled vehicles and parts and accessories therefor, namely motors, tires, wheels, wheel rims, brake linings, brake discs, aero-dynamic fairings, luggage carriers for motorcycles; cases for luggage adapted for use with motorcycles, transport cases adapted for use with motorcycles, saddlebags adapted for use with bicycles and motorcycles, tank bags adopted for use with motorcycles, stands, mudguards, spoilers, after body, rearview mirrors, fuel tank caps, fuel tanks, bicycle chains, motorcycle seats", are not closely related to registrant's Class 12 goods.

C. Similarity of Trade Channels

The Examining Attorney states that the evidence shows that motorcycle parts and automotive parts frequently originate from a single source and are sold in the same channels of trade. See final Office Action, p. 4.

However, it is respectfully submitted that applicant's mark when considered in its entirety is not confusingly similar to registrant's mark and applicant's Class 6, 7 and 12 goods are not closely related to registrant's Class 12 goods for the reasons previously discussed.

V. Conclusion

For the foregoing reasons, applicant respectfully requests that the Examining Attorney's final refusal of applicant's mark for its Class 6, 7 and 12 goods under Section 2(d) of the Trademark Act be reversed and the objection to the Class 6 and 7 identification of goods be withdrawn based on the Voluntary Amendment filed contemporaneously herewith and that applicant's mark be approved for publication for opposition.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

/DonaldLOtto/

Dated: August 21, 2015

By _____

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Don Otto

From: TEAS@uspto.gov
Sent: Friday, August 21, 2015 3:28 PM
To: Don Otto
Subject: SC&PT0125WOU Serial number 79147141: Received Your Voluntary Amendment Form

We have received your Voluntary Amendment Form Filing form below.

To the Commissioner for Trademarks:

Application serial no. **79147141** E SPEED (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/79147141/large>) has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 006 for License plate carriers of metal and competition number plates of metal, namely, metal competition plates for Motocross racing

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~License plate carriers of metal and competition number plates of metal, namely, metal competition plates for Motoecross racing;~~ License plate carriers of metal and competition number plates of metal, namely, metal racing number plates for two-wheeled vehicles for use in Motorcross racing
Class 006 for License plate carriers of metal and competition number plates of metal, namely, metal racing number plates for two-wheeled vehicles for use in Motorcross racing

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 007 for 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

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~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;~~ ignition devices for two-wheeled vehicles in the nature of ignition covers specifically adapted for use with electronic ignitions
Class 007 for 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

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

ADDITIONAL STATEMENTS

Miscellaneous Statement

Applicant hereby requests that the identification of goods in Classes 6 and 7 be amended as set forth above to overcome the Examining Attorney's objections to the highlighted wording on the ground that it is broad and must be clarified because it could include a variety of goods and services in each class. See final Office Action, p. 5.

Voluntary Amendment Signature

Signature: /DonaldLOtto/ Date: 08/21/2015

Signatory's Name: Donald L. Otto

Signatory's Position: Attorney of record, Ohio bar member

Signatory's Phone Number: 216-621-1113

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Thank you,

The TEAS support team

Fri Aug 21 15:28:19 EDT 2015

STAMP: USPTO/PRA-38.67.194.114-20150821152819716362-79147141-

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