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Subject: U.S. TRADEMARK APPLICATION NO. 79147141 - E SPEED - SC&PT0125WOU - Request for Reconsideration Denied - Return to TTAB - Message 1 of 7

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Files: 76483672P001OF003.JPG, 76483672P002OF003.JPG, 76483672P003OF003.JPG, 77939429P001OF020.JPG, 77939429P002OF020.JPG, 77939429P003OF020.JPG, 77939429P004OF020.JPG, 77939429P005OF020.JPG, 77939429P006OF020.JPG, 77939429P007OF020.JPG, 77939429P008OF020.JPG, 77939429P009OF020.JPG, 77939429P010OF020.JPG, 77939429P011OF020.JPG, 77939429P012OF020.JPG, 77939429P013OF020.JPG, 77939429P014OF020.JPG, 77939429P015OF020.JPG, 77939429P016OF020.JPG, 77939429P017OF020.JPG, 77939429P018OF020.JPG, 77939429P019OF020.JPG, 77939429P020OF020.JPG, 78364217P001OF003.JPG, 78364217P002OF003.JPG, 78364217P003OF003.JPG, 85535394P001OF004.JPG, 85535394P002OF004.JPG, 85535394P003OF004.JPG, 85535394P004OF004.JPG, 86118468P001OF004.JPG, 86118468P002OF004.JPG, 86118468P003OF004.JPG, 86118468P004OF004.JPG, -01.jpg, 79147141.doc

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:

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

VIEW YOUR APPLICATION FILE

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: 9/30/2015

INTERNATIONAL REGISTRATION NO. 1203492

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated December 30, 2014 are maintained and continue to be final: Refusal To Register the mark under Section

2(d). *See* TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirements made final in the Office action are satisfied: Identification of goods and services. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

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 confusingly similar to registrant's mark ESPEED. The marks are similar in sound, meaning and appearance because they combine the term E with the word SPEED.

Although applicant's mark appears in stylized font with colors, this is not sufficient to 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)).

Moreover, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g.*, *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

Although applicant's mark appears in stylized font, the mark is confusingly similar to registrant's standard character mark.

II. Comparison of the Goods and/or Services

Applicant's goods, 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 specifically adapted for use with electronic ignitions, 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 adapted for use with motorcycles, stands, mudguards, spoilers, after body, rearview mirrors, fuel tank caps, fuel tanks, bicycle chains, motorcycle seats* are closely related to registrant's goods, namely, *nuts, locking nuts, safety nuts, special nuts, in particular for the drive train as well as for engine and chassis applications, wheel nuts, axle control nuts, wheel central locking elements in the nature of nuts, quick clamping parts in the nature of nuts and automotive parts, in particular pumps, namely, air pumps, hybrid drives, namely, engines for land vehicles, engine parts, namely, engine parts for land vehicles, and units for the drive train made therefrom, namely, wheel hubs, wheel bearings, wheel bearing units, namely, wheel bearings, and parts thereof, namely, drive shafts and gear wheels and units assembled thereof, namely, gear wheel units, speed-increasing gears, namely, gear wheels, speed-reducing gears, namely, gear wheels, shifting claws, namely, gear shifts, differential gears, namely, gear wheels, lightweight gears, namely, gear wheels, low-cost gears, namely, gear wheels; connecting rods for land vehicles, except for engine parts, in particular from steel and ceramics, in particular one-piece and composite connecting rods; engines for automobiles, in particular lightweight internal combustion engines; units for drive train of automobiles, namely, wheel hubs, wheel bearings, wheel bearing units, namely, wheel bearings, constant velocity and length adjustment units, namely, wheel bearings; longitudinal shafts, namely, drive shafts; side shafts, namely, drive shafts; torsion shafts, namely, drive shafts, all for automobiles and parts thereof, included in this class, in particular drive shafts, hubs, namely, wheel hubs, connections for longitudinal shafts, namely, drive shafts for land vehicles, side shafts, namely, drive shafts for land vehicles, and torsion shafts, namely, drive shafts for land vehicles; automobile transmissions and parts thereof, in particular shafts, namely, drive shafts for land vehicles and gear wheels and units assembled thereof, namely, gear wheels, speed-increasing gears, namely, gear wheels, and speed-reducing gears, namely, gear wheels, synchromesh transmissions, shifting claws, namely, gear wheels, transmissions for electric drives*.

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods

can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i). The respective goods and/or services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

With respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the registration uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in applicant's more narrow identification.

Specifically, the registrant's "metallic fasteners, in particular nuts, locking nuts, safety nuts, special nuts, in particular for the drive train as well as for engine and chassis applications, wheel nuts, axle control nuts, wheel central locking elements in the nature of nuts, quick clamping parts in the nature of nuts" are not limited to any type of vehicle and these goods can be used in connection with two-wheeled vehicles.

Moreover, the evidence of record shows that registrant's automotive parts in Class 012 are closely related to applicant's parts for two-wheeled vehicles because these goods typically originate from a

single source and are marketed in the same channels of trade. See attached evidence from Honda, Suzuki and BMW which shows that two-wheel vehicle parts and automobile parts frequently originate from a single source. Potential purchasers are accustomed to seeing the same goods being used in connection with the marks. Thus, the use of identical marks in connection with these goods is likely to result in confusion.

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely automobile parts and parts , are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

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).

This refusal is limited to Classes 007 and 012. The final refusal is continued and maintained.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Saima Makhdoom/

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Top Tips When Buying Honda Saddlebags

December 26th, 2014 | Author: *Ania Todua*

There are many different types of Honda Saddle bags, with different styles and features. They can be studded or plain, buckle or with no buckle. The locking system also varies and it could either be a QDS (Quick Disconnect System), Hard mount kit, or Throw over kit.

There are also many other consideration that will arise naturally, as a result of the lifestyle you live or your personal tastes. Here are some of the things that will help you make the right decision.

Personal Style

This is mostly a matter of taste, and the decision will likely be in line with why you bought the motorcycle. If aesthetics influenced your decision when you bought it, you have no choice but to match the bike's style otherwise you'll be disappointed. The style