

CERTIFICATE OF MAILING

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to:

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

on June 10, 2015


Jeanne Murphy

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket SC&PT0126WOUS

In re trademark application of

KTM-Sportmotorcycle AG

Serial No. 79147426

Filed September 11, 2013

Mark: E SPEED (Stylized)

NOTICE OF APPEAL

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

Commissioner:

Applicant, KTM-Sportmotorcycle AG, by and through its attorneys, hereby appeals the Examining Attorney's final refusal in the Office Action sent December 15, 2014 of all of the goods in International Classes 7 and 12. See first paragraph on page 5 of the Office Action submitted herewith in which the Examining Attorney states that this is a final Office Action.

The appeal fee of \$200 is submitted herewith. In the event any additional fees are due in connection with the filing of this appeal notice, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Docket No. SC&PT0126WOUS.



Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By 
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To: KTM-Sportmotorcycle AG (dotto@rennerotto.com)
Subject: U.S. TRADEMARK APPLICATION NO. 79147426 - E SPEED - N/A
Sent: 12/15/2014 12:19:40 PM
Sent As: ECOM103@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

<p>U.S. APPLICATION SERIAL NO. 79147426</p> <p>MARK: E SPEED</p>	<p align="center">*79147426*</p>
<p>CORRESPONDENT ADDRESS: Donald L. Otto Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland OH 44115</p>	<p align="center">CLICK HERE TO RESPOND TO THIS LETTER http://www.uspto.gov/trademarks/teas/response</p> <p align="center">VIEW YOUR APPLICATION FILE</p>
<p>APPLICANT: KTM-Sportmotorcycle AG</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO : N/A CORRESPONDENT E-MAIL ADDRESS: dotto@rennerotto.com</p>	

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/15/2014

INTERNATIONAL REGISTRATION NO. 1204325

This Office action is in response to applicant's communication filed on December 2, 2014.

The following requirement has been satisfied: Identification of Goods. TMEP §§713.02, 714.04.

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now continued with respect to International Classes 7 and 12. The refusal with respect to International Class 6 is withdrawn.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION LIMITED TO CLASSES 7 AND 12.

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, 177 USPQ 563 (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.*

SUMMARY OF MARKS

In this case the word ESPEED in marks is identical. The applicant uses color and a stylized font, while the registrant's mark is in standard character.

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”).

RELATEDNESS OF THE GOODS/SERVICES

The applicant's goods and the registrant's good overlap.

Applicant's amended goods are:

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 in International Class 7.

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 in International Class 12.

Registrant's goods are:

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 in International Class 6.

Machine parts, namely, cam shafts, cam shaft parts in the nature of cam covers for vehicles and cam shaft modules made therefrom in the nature of cam covers for vehicles, variable camshaft adjustment parts in the nature of cam covers for vehicles, connecting rods, in particular from steel or ceramics, one-piece and composite connecting rods, crank shafts for use in connection with motor vehicles, composite and assembled crankshafts for use in connection with motor vehicles, pistons for use in connection with motor vehicles, compressors, namely, electronic compressors, and components for variable compression, namely, cam shafts, engines not for motor vehicles, and engine parts, namely, cam shafts, pumps, namely, pumps as parts of machines, and hybrid drives, namely, variable speed drives for machines, joints and shock absorbers, namely, shock absorbers for machines; transmissions for machines, air-conditioning compressors in International Class 7.

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 in International Class 12.

The Trademark Trial and Appeal Board has previously held that marketing by different parties of different types of automotive parts and accessories under the same or similar marks is likely to cause confusion. See, e.g., *In re Delbar Prods., Inc.*, 217 USPQ 859, 861 (TTAB 1981) (holding ULTRA for outside mounted vehicle mirrors likely to be confused with ULTRA and design for automobile parts, namely pistons and pins, valves, water pumps, oil pumps, universal joints, gears, axle shafts, hydraulic brake parts, automatic transmission repair kits and parts, engine bearings and jacks); *In re Red Diamond Battery Co.*, 203 USPQ 472, 472-73 (TTAB 1979) (holding RED DIAMOND for storage batteries likely to be confused with DIAMOND for pneumatic rubber automobile and vehicle tires); *In re Trelleborgs Gummifabriks Aktiebolag*, 189 USPQ 106, 107-08 (TTAB 1975) (holding T and design for, inter alia, hoses, namely rubber hoses and inner tubes for tires and pneumatic, semisolid and solid tires likely to be confused with T and design for, inter alia, motor oil, oil additives and fuel additives); *In re Magic Muffler Serv., Inc.*, 184 USPQ 125, 126 (TTAB 1974) (holding MAGIC for vehicle parts, namely mufflers, likely to be confused with MAGIC for motors for motor vehicles).

As indicated by the attached excerpt from a third party website, applicant is well known for its engine manufacturing as well as for other vehicle parts. For example, note the following excerpt:

Exhibit 4 (attached)

KTM-Sportmotorcycle AG builds race-ready motorcycles for competitive and recreational riding. It also develops and manufactures engine, frame, swing arm, exhaust system, and chassis components, as well as power parts and power wear products. KTM-Sportmotorcycle AG offers its products through a network of dealers.

<http://pseps.com/company/KTM-Sportmotorcycle-AG>

In addition the attached excerpt from Business Week magazine shows that the applicant manufactures many parts for land vehicles, including engines and exhaust systems for vehicles, which is identical to the registrant's engines for land vehicles. For example, note the following:

KTM Sportmotorcycle GmbH manufactures race-ready motorcycles for competitive and recreational riding. It also develops and manufactures engine, frame, swing arm, exhaust system, and chassis components, as well as power parts and power wear products. KTM Sportmotorcycle GmbH offers its products through a network of dealers. The company was founded in 1934 and is based in Mattighofen, Austria. As of December 2004, KTM Sportmotorcycle GmbH operates as a subsidiary of KTM AG.

<http://investing.businessweek.com/research/stocks/private/snapshot.asp?privcapId=143390>

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, 1026 (Fed. Cir. 1988).

For the foregoing reasons, the applied-for mark is refused registration under Section 2(d) of the Trademark Act.

RESPONSE TO FINAL ACTION

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

(1) A response that fully satisfies all outstanding requirements and/or resolves all outstanding refusals.

(2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Gina Hayes/
Trademark Examining Attorney
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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