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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79147426

MARK: E SPEED



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: KTM-Sportmotorcycle AG

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1204325

INTRODUCTION

The applicant, KTM-Sportmotorcycle AG, appeals the refusal to register the trademark E SPEED, in stylized font with color, for goods comprising various vehicle parts in International Classes 6, 7, and

12. Registration is refused only for the goods in Classes 7 and 12 under Section 2(d) of the Trademark Act, based on a likelihood of confusion with Registration No. 4192491, for the mark ESPEED, in standard characters, also for various vehicle parts.

STATEMENT OF FACTS

On May 29, 2014, the Trademark Office received the applicant's Section 66(a) request for extension of trademark protection. The previously-assigned examining attorney refused registration under Section 2(d).¹ Following applicant's response, the examining attorney issued a final Office action on December 15, 2014, maintaining in part the refusal under Section 2(d).

Applicant initially appealed the refusal on June 15, 2015; however, the previous examining attorney requested and was granted a remand to supplement the record with evidence referenced in the May 30, 2014, initial Office action, but inadvertently omitted due to a technical issue. Following the examining attorney's action dated October 9, 2015, to address the omitted evidence, this appeal has resumed.

ISSUE

The sole issue on appeal is whether, under Trademark Act Section 2(d), there is a likelihood of confusion between the applicant's mark, E-SPEED, in stylized font with color, for vehicle parts in

¹ The Office has reassigned this application to the undersigned examining attorney.

International Classes 7 and 12 and Registration No. 4192491, ESPEED, in standard characters, also for vehicle parts in International Classes 6, 7, and 12.

ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *See In re E. I. du Pont*, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

A. THE MARKS ARE CONFUSINGLY SIMILAR

The marks are confusingly similar because they are virtually identical. In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, connotation, and commercial impression. *In re E. I. du Pont*, 177 USPQ at 567; TMEP §1207.01(b). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

In this case, the marks are substantially identical in sound, appearance, meaning and overall commercial impression for the following reasons:

First, the marks are nearly identical in appearance because they contain the nearly identical terms, E SPEED and ESPEED. The only distinctions between these marks are the presence of a space between the terms E and SPEED and minor stylization of the applied-for mark.

Applicant argues that the marks are different because its mark is in a stylized font and includes a distinctive orange color. *Applicant's Brief at 4*. However, a mark in typed or standard characters—such as the registrant's—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 Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); 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 Viterro Inc.*, 101 USPQ2d at 1909. Here, the registered mark is in typed characters and therefore could be displayed with similar stylization and design elements as the applied-for mark. Therefore, the stylization of applicant's mark does not obviate this refusal.

Moreover, the word portion of a composite mark containing both words and a design may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. *In re*

Viterra Inc., 101 USPQ2d at 1911. Here, the word portion, E SPEED, is the dominant feature of applicant's mark, in that it will be used by consumers when referring to the applicant's goods.

Second, the terms, E SPEED and ESPEED, are phonetic equivalents and sound the same.

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); TMEP §1207.01(b)(iv).

Finally, the marks appear to have the same meaning. When applied to vehicle parts, both marks suggest the same quality frequently desired in vehicles: speed.

In sum, the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks in the same commercial contexts for related goods would likely confuse the source of the goods sold under the marks or mistakenly assume a connection between the parties.

B. THE GOODS ARE EITHER IDENTICAL OR HIGHLY RELATED

In this case, the parties' goods are identical in part, highly related, overlap or are otherwise complementary.

The applicant's goods, as amended, are:

Class 07: 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

Class 12: 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

The registrant's goods are:

Class 06: 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

Class 07: 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

Class 12: 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

1. Applicant's goods are identical to or otherwise overlap with registrant's goods

A number of the vehicle parts offered by the applicant under its E SPEED mark are identical or substantially identical to those the registrant offers under its ESPEED mark. For example, the registration broadly covers “automotive parts,² in particular pumps, namely, air pumps, hybrid drives, namely, engines for land vehicles, engine parts, namely, engine parts for land vehicles” in Class 12. Registrant also offers other engine parts in Class 7, including “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.” The application identifies “electrically powered two-wheeled

² The examining attorney respectfully requests that the Board take judicial notice that the term “automotive” relates to or concerns “self-propelled vehicles or machines.” See Merriam-Webster dictionary definition at <http://www.merriam-webster.com/dictionary/automotive>. The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; see *In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 n.18 (TTAB 2015) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); TMEP §710.01(c); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

[vehicle] parts ..., namely motors” (i.e., engines for land vehicles)³, as well as other engine parts in Class 07, including “fans and cylinders for motors for two-wheeled vehicles; silencers for motors and engines for two-wheeled vehicles [and] exhausts, cylinder heads for engines for two-wheeled vehicles.”

To the extent that these goods are not identical on their face or legally equivalent, as with “motors” and “engines”, the wording in the application and registration is broad enough such that goods in one encompass goods in the other. For example, registrant’s “engine parts for land vehicles” encompass applicant’s “fans and cylinders,” “cylinder heads,” and “silencers.” Conversely, applicant’s wheels encompass registrant’s “gear wheels.”

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). 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.*, 101 USPQ2d at 1908 (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 Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

³ The examining attorney respectfully requests that the Board take judicial notice that the term “motor” in this context refers to a type of an engine. *See* Merriam-Webster dictionary defining the term “motor” as “internal combustion engine.” www.merriam-webster.com/dictionary/motor.

In this case, a number of identifications set forth in the application and registration have 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.

That the Applicant's goods are for two-wheeled vehicles, such as motorcycles, does not distinguish its goods from those of the registrant. Both parties' goods are for land vehicles. The registration does not restrict all the goods it covers to four-wheeled vehicles. Furthermore, a number of registrant's goods are especially made for motor vehicles, such as applicant's "motor-powered two-wheeled vehicles." So both parties manufacture identical or nearly identical goods for the same or similar vehicles.

2. Applicant's goods are complementary to registrant's goods

To the extent the parties' goods are not identical or encompass each other, they are complementary. For example, applicant's "fans and cylinders," "silencers," "exhausts [and] cylinder heads" are identified as being "for motors [and/or] engines". So these could very well be used with the "engines for land vehicles" registrant offers under its ESPEED mark. Indeed, they are all "engine parts for land vehicles" that the registration covers. Consumers shopping for "silencers ... for engines for two-wheeled vehicles" under the E SPEED mark, for example, are likely to be confused as the source of these products given that the registrant also makes various "engine parts for land vehicles" under its ESPEED mark.

Where evidence shows that the goods at issue have complementary uses, and thus are often used together or otherwise purchased by the same purchasers for the same or related purposes, such

goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (holding bread and cheese to be related because they are often used in combination and noting that “[s]uch complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion”); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (holding medical MRI diagnostic apparatus and medical ultrasound devices to be related, based in part on the fact that such goods have complementary purposes because they may be used by the same medical personnel on the same patients to treat the same disease). In this case, the applicant’s identification of goods indicates that its goods are intended to be used with goods like those of the registrant.

In any case, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i).

Here, both parties offer vehicle parts. The following evidence of record demonstrates that the goods are related and are commonly offered by the same parties under the same marks to the same consumers and through the same trade channels:

a) *Applicant’s Own Practices*

Applicant itself sells land vehicles, including motorcycles and cars, and parts therefor. Evidence consisting of the Applicant's website, supported by third party websites, indicates that Applicant makes motorcycles and cars. *10/9/2015 Office Action, pp. 120-133*. This evidence, as well as that from the Final Office Action issued December 15, 2014, consisting of web page printouts from third party websites, also indicates that applicant sells engines and various other vehicle parts for its vehicles under the same mark. *12/15/2014 Office Action, pp. 2-6*. So Applicant's parts are marketed under the same name and through the same channels. And these parts may very well be identical or similar to the registrant's engines and other vehicle parts, and could be used for identical or similar vehicles. The applicant does not refute this evidence. *Applicant's Brief at 4-6*.

b) Other Parties' Practices

Additionally, the October 9, 2015, Office Action included screenshots from third party websites, including those of other vehicle manufacturers, demonstrating that vehicle parts like those of the applicant and registrant are commonly offered under the same mark and through the same trade channels. For example, Honda, BMW, and Suzuki all manufacture motorcycles, cars, and parts for both types of land vehicles, under the same marks, and market them through the same trade channels. *10/9/2015 Office Action, pp. 2-3, 19-29, 44, 49-69, 7-18, 32-36, 37-43*. Similarly parts manufacturers, such as Remus, make and sell car and motorcycle parts. *10/9/2015 Office Action, pp. 70-72*.

c) Third Party Registrations

The record also contains a number of third party registrations showing that it is common for manufacturers to make these types of vehicle parts under the same trademark. For example, the October 9, 2015 Office Action includes the following:

- U.S. Registration No. 4667771 for HONDA (*pp. 101-102*) for “motor vehicles, namely, automobiles, sports utility vehicles, trucks, motorcycles, all-terrain vehicles, and scooters”
- U.S. Registration No. 3392300 for VESRAH (*pp. 82-84*) for “components and accessories of automobiles, namely, clutches; components and accessories of two-wheeled vehicles and motor scooters, namely, clutches and brakes; ... mechanical elements for land vehicles, namely, shock absorbers, brakes and transmissions”
- U.S. Registration No. 4494375 for KENTECH (*pp. 85-87*) for “automobiles; automotive structural parts, namely, self-sealing tanks for fuel storage, coolant storage, oil storage, and/or water storage; cars; electric cars; motor cycles; motorcycles; shock absorbers for automobiles; sports utility vehicles; vehicle hoods; wheel hubs”
- U.S. Registration No. 4752996 for YAMALUBE (*pp. 88-90*) for “motorcycles ...; engines and motors for motorcycles ...; engines and motors for land vehicles”
- U.S. Registration No. 4823322 for PHYRON (*pp. 91-93*) for “casings for pneumatic tires; inner tubes; pneumatic tyres and inner tubes for motorcycles; tires; tires for vehicle wheels; ... transmission belts for land vehicles; treads for retreading tyres; tyres for vehicle wheels”
- U.S. Registration No. 4770233 for GSX-S (*pp. 94-95*) for “automobiles, motorcycles, all terrain vehicles, and structural parts thereof”
- U.S. Registration No. 4819372 for a design mark (*pp. 99-100*) for “electric motorcycles; motors for land vehicles; structural parts for motorcycles”

Altogether, the evidence demonstrates that numerous manufacturers produce parts for two-wheeled and four-wheeled vehicles under the same marks, and that consumers can expect to encounter these vehicle parts sold under the same mark and through the same channels.

Where the marks of the respective parties are identical or virtually identical, the relationship between the relevant goods 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); TMEP §1207.01(a). Here, the marks of the parties are virtually identical, and the goods are either substantially identical, overlap and/or are complementary. Given the foregoing, it must be concluded that the parties' goods are sufficiently related for confusion to be likely if they are represented by virtually identical marks.

CONCLUSION

Because the respective marks E SPEED and ESPEED are virtually identical and are used in connection with identical or highly related goods, the use of the applied-for mark on the applicant's goods is likely to cause confusion or mistake, or to deceive. Accordingly, registration of applicant's mark is properly refused under Trademark Act Section 2(d). The examining attorney respectfully requests that the Board affirm the refusal of registration.

Respectfully submitted,

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