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

Proceeding	79147426
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&PT0126WOUS

In re application of: KTM-Sportmotorcycle AG

Serial No.: 79147426

Filing Date: September 11, 2013

Mark: E SPEED and design

Law Office: 103

Examining Attorney: Gina Hayes

Commissioner for Trademarks
Trademark Trial and Appeal Board
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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 mailed December 15, 2014 refusing registration of the applied-for mark under Section 2(d) of the Trademark Act with respect to International Classes 7 and 12. The refusal with respect to International Class 6 has been withdrawn. Applicant has filed a timely notice of appeal.

II. Section 2(d) Refusal - Likelihood of Confusion

In the final refusal mailed December 15, 2014, the Examining Attorney continued refusal of the applied-for mark with respect to International Classes 7 and 12 in the prior Office Action mailed June 2, 2014 as being confusingly similar to the mark ESPEED of US Registration No. 4192491. See prior Office Action dated June 2, 2014, p. 2, and final Office Action, p. 2.

III. 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. 2.

Each of these factors is discussed below:

A. Similarity of Marks

The Examining Attorney considers the word E SPEED in both applicant's mark and registrant's mark to be identical. See final Office Action, p. 2.

Both applicant's mark and registrant's mark combine the letter E with the term SPEED. However, 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).

Moreover, it is respectfully submitted that applicant's E SPEED mark when considered in its entirety is not likely to be confused with registrant's mark because 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 which create a completely different commercial impression than registrant's mark.

B. Relatedness of the Goods/Services

According to the Examining Attorney, applicant's Class 7 and 12 goods overlap. See final Office Action, pp. 2, 3.

However, it is respectfully submitted that applicant's Class 7 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", do

not overlap with registrant's "metallic fasteners, in particular nuts ..." of various types in Class 6 or registrant's "machine parts ... for vehicles, ... motor vehicles, ... machines, ... air-conditioning compressors" in Class 7.

Likewise, it is respectfully submitted that applicant's Class 12 goods, namely, "electric motor powered two-wheeled vehicles and electrically powered two-wheeled vehicles as well as parts and accessories therefor, namely, motors, tires, wheels, 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", do not overlap with registrant's Class 6 or 7 goods or registrant's "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 ..." in Class 12.

The Examining Attorney quotes excerpts from applicant's website and a Business Week Magazine article attached to the final Office Action which, according to the Examining Attorney, indicate that applicant is well known for its engine manufacturing as well as for other vehicle parts. See final Office Action, p. 4.

However, it is respectfully submitted that the statement in these excerpts that applicant "also develops and manufactures engine, frame, swing arm, exhaust system, and chassis components, as well as power parts and power wear products" is not

evidence of record that applicant manufactures these goods for land vehicles/ automobiles.

C. Similarity of Trade Channels

The Examining Attorney cites a number of decisions in which the TTAB 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 final Office Action, p. 4. However, it is respectfully submitted that applicant's mark is not the same or similar to registrant's mark and applicant's Class 7 and 12 goods are not closely related to registrant's goods for the reasons previously discussed.

IV. Conclusion

For the foregoing reasons, applicant respectfully requests that the Examining Attorney's final refusal of applicant's Class 7 and 12 goods under Section 2(d) of the Trademark Act be reversed and the applied-for mark be approved for publication for opposition.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

/DonaldLOtto/

Dated: August 14, 2015

By _____

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