

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79149462
LAW OFFICE ASSIGNED	LAW OFFICE 121
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/79149462/large
LITERAL ELEMENT	WPC WINKELMANN POWERTRAIN COMPONENTS
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
ARGUMENT(S)	
Arguments against LOC refusal	
<p>The examiner has refused registration of the WPC WINKELMANN POWERTRAIN COMPONENTS + Design mark (Application Serial No. 79/149,462) on the basis that it is confusingly similar several W WINKELMANN ELEKTROMOTOREN + Design registration cited by the examiner. Reconsideration is respectfully requested. Applicant incorporates by reference all of the arguments made in its March 8, 2016 response.</p> <p>In addition, Applicant makes the following arguments:</p> <p>A. Goods Travel in Different Channels of Trade</p> <p>Again, Applicant's products are in different channels of trade than the products of the Registrant. As stated previously, Applicant is a supplier for the automotive industry and produces and sells parts for land vehicles. The Registrant's identification of goods specifically excludes land crafts from its identification of goods. In other words, the goods offered by the Registrant are used in industry, agriculture and shipping and not in the field of automotives. These channels of trade are completely removed from each other. It takes a certain level of expertise to build an engine or similar parts for a particular type of application and the concerns and requirements of an engine for an automotive are not the same considerations and requirements of an engine in industrial applications.</p> <p>The examiner includes evidence of a number of extremely large automotive companies that produce engines for uses other than automotive. Many of these companies have long standing use not only in the automotive field but in other applications and industries. However, it is not typical that a manufacturer of automotive parts will expand its product line to include parts used in completely different applications. In other words, the Applicant's application of its products is highly specialized and requires a firm knowledge of how it will be applied in a land vehicle. The same is true for the Registrant's products, except that those items are being applied to industries other than for land vehicles.</p> <p>In other words, consumers looking for the products offered by the Applicant would never come across the products offered by the Registrant. The products of the parties are different, are sold in different channels of trade, and are purchased by different consumers. Thus, there is no likelihood of confusion.</p> <p>B. Marks are Visually, Phonetically and Connotatively Distinguishable</p> <p>Applicant's mark is WPC WINKELMANN POWERTRAIN COMPONENTS + Design while the Registrant's mark is for WINKELMANN ELEKTROMOTOREN + Design. Again, Applicant reiterates that the term WINKELMANN is a surname and therefore entitled to a narrow scope of protection. Consumers seeing the term WINKELMANN will recognize this as a surname and therefore will look to other features of the mark to distinguish the goods of the parties. These additional features include completely different words that do not look anything alike "POWERTRAIN COMPONENTS" versus "ELEKTROMOTOREN." Furthermore, the term ELEKTROMOTOREN is a German word while POWERTRAIN COMPONENTS is an English phrase. ELEKTROMOTOREN does not translate to "powertrain</p>	

components” and the inclusion of a German word versus and English phrase gives an entirely different impression upon the consumer.

Furthermore, as stated previously, the overall look and color scheme of the two marks are completely different. The Registrant’s mark includes a highly specialized symbol in warm colors (red) with a jagged line that gives the impression of an electric bolt or electricity. This makes sense given the nature of Registrant’s products and that its mark contains the term “ELEKTROMOTOREN.” In contrast, the Applicant’s mark uses the cool colors (blue and gray) with a circle around it, which gives the impression of movement, much like a vehicle moving along a road or track.

For this reason, and the reasons previously stated, the marks are distinguishable.

C. Register Should Reflect Actual Use

Despite the unjust harm that will result if Applicant cannot obtain a federal registration, the reality is that Applicant will continue to use its mark. Dilution in the field will preclude serious challenges to Applicant's use. The Examiner should consider the words of the Court of Appeals for the Federal Circuit in *Bongrain International v. Delice de France*, 1 USPQ 2d 1775 (Fed. Cir. 1987):

The primary purpose of the Trademark Act of 1946 is to give Federal procedural augmentation to the common law rights of trademark owners -- which is to say legitimate users of trademarks. One of the policies sought to be implemented by the Act was to encourage the presence on the register of trademarks of as many as possible of the marks in actual use so that they are available for search purposes (emphasis added).

Applicant's mark will be used and should be registered.

In sum, Applicant respectfully requests that the examiner withdraw the likelihood of confusion refusal because Applicant’s mark is visually, phonetically and connotatively distinguishable; and the Register should reflect actual use.

SIGNATURE SECTION

RESPONSE SIGNATURE	/smd/
SIGNATORY'S NAME	Sara M. Dorchak
SIGNATORY'S POSITION	Attorney
SIGNATORY'S PHONE NUMBER	5163659802
DATE SIGNED	10/28/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Oct 28 16:30:20 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XX.XX.XXX-20 161028163020771192-791494 62-5705bfb8beabc8a7febd9f 742102db0405e5d548761fb7a b2cd915e159ae1504044-N/A- N/A-20161028162859919829

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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79149462** WPC WINKELMANN POWERTRAIN COMPONENTS (Stylized and/or with Design, see

al.uspto.gov/resting2/api/img/79149462/large) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Arguments against LOC refusal

The examiner has refused registration of the WPC WINKELMANN POWERTRAIN COMPONENTS + Design mark (Application Serial No. 79/149,462) on the basis that it is confusingly similar several W WINKELMANN ELEKTROMOTOREN + Design registration cited by the examiner. Reconsideration is respectfully requested. Applicant incorporates by reference all of the arguments made in its March 8, 2016 response.

In addition, Applicant makes the following arguments:

A. Goods Travel in Different Channels of Trade

Again, Applicant's products are in different channels of trade than the products of the Registrant. As stated previously, Applicant is a supplier for the automotive industry and produces and sells parts for land vehicles. The Registrant's identification of goods specifically excludes land crafts from its identification of goods. In other words, the goods offered by the Registrant are used in industry, agriculture and shipping and not in the field of automotives. These channels of trade are completely removed from each other. It takes a certain level of expertise to build an engine or similar parts for a particular type of application and the concerns and requirements of an engine for an automotive are not the same considerations and requirements of an engine in industrial applications.

The examiner includes evidence of a number of extremely large automotive companies that produce engines for uses other than automotive. Many of these companies have long standing use not only in the automotive field but in other applications and industries. However, it is not typical that a manufacturer of automotive parts will expand its product line to include parts used in completely different applications. In other words, the Applicant's application of its products is highly specialized and requires a firm knowledge of how it will be applied in a land vehicle. The same is true for the Registrant's products, except that those items are being applied to industries other than for land vehicles.

In other words, consumers looking for the products offered by the Applicant would never come across the products offered by the Registrant. The products of the parties are different, are sold in different channels of trade, and are purchased by different consumers. Thus, there is no likelihood of confusion.

B. Marks are Visually, Phonetically and Connotatively Distinguishable

Applicant's mark is WPC WINKELMANN POWERTRAIN COMPONENTS + Design while the Registrant's mark is for WINKELMANN ELEKTROMOTOREN + Design. Again, Applicant reiterates that the term WINKELMANN is a surname and therefore entitled to a narrow scope of protection. Consumers seeing the term WINKELMANN will recognize this as a surname and therefore will look to other features of the mark to distinguish the goods of the parties. These additional features include completely different words that do not look anything alike "POWERTRAIN COMPONENTS" versus "ELEKTROMOTOREN." Furthermore, the term ELEKTROMOTOREN is a German word while POWERTRAIN COMPONENTS is an English phrase. ELEKTROMOTOREN does not translate to "powertrain components" and the inclusion of a German word versus an English phrase gives an entirely different impression upon the consumer.

Furthermore, as stated previously, the overall look and color scheme of the two marks are completely different. The Registrant's mark includes a highly specialized symbol in warm colors (red) with a jagged line that gives the impression of an electric bolt or electricity. This makes sense given the nature of Registrant's products and that its mark contains the term "ELEKTROMOTOREN." In contrast, the Applicant's mark uses the cool colors (blue and gray) with a circle around it, which gives the impression of movement, much like a vehicle moving along a road or track.

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /smd/ Date: 10/28/2016

Signatory's Name: Sara M. Dorchak

Signatory's Position: Attorney

Signatory's Phone Number: 5163659802

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.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79149462

Internet Transmission Date: Fri Oct 28 16:30:20 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XX.XX.XXX-20161028163020771

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