

This Opinion is not a
Precedent of the TTAB

Mailed: January 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Terumi Iwagami and Jason Troy Sanger

Serial No. 79221380

Francis J. Ciaramella of Francis John Ciaramella PLLC,
for Terumi Iwagami and Jason Troy Sanger.

Byron S. Barahona, Trademark Examining Attorney, Law Office 127,
Mark Pilaro, Managing Attorney.

Before Cataldo, Wolfson, and Hudis,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicants, Terumi Iwagami and Jason Troy Sanger, seek registration on the Principal Register of the mark VALLKREE (in standard characters), identifying the following goods:

Electric bikes and bicycles; electric go-karts; Electric tricycles not being toys; Electric quadricycles; Electric motors and engines for bikes, bicycles, go-karts, tricycles, quad bikes, namely, bicycle racks for vehicles, bicycle handlebar grips, bicycle pedals, saddles for bicycles,

bicycle tires, and side car; all of the foregoing not for use with motorcycles and their parts therefore [sic] in International Class 12.¹

The Trademark Examining Attorney refused registration of Applicants' mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the cited registered mark VALKYRIE, in typed or standard characters,² identifying "land motor vehicles, namely, motorcycles and structural parts therefor" in International Class 12.³

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We reverse the refusal to register.

¹ Application Serial No. 79221380 was filed on August 25, 2017, based on Applicant's assertion of an extension of protection of International Registration No. 1376223, issued on August 25, 2017, under Section 66(a) of the Trademark Act. 15 U.S.C. § 1141h(a)(3). In response to the Examining Attorney's requirement, Applicant submitted the following translation statement: The wording "VALLKREE" has no meaning in a foreign language.

The application originally recited additional goods in International Class 25. Applicant deleted these goods in order to obviate a refusal of registration under Section 2(d) based upon Reg. No. 5489910. As the Examining Attorney notes in his brief (6 TTABVUE 3-4) the refusal of registration based upon Reg. No. 5489910 is withdrawn in consequence thereof.

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

² "It is noted that prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) ("until 2003, 'standard character' marks formerly were known as 'typed' marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks").

³ Registration No. 2088198 issued on the Principal Register on August 12, 1997. Second Renewal.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 129 USPQ2d at 1162-63. Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

A. Strength of the Cited Mark / Number and Nature of Similar Marks

First, we evaluate the strength of the registered mark and the scope of protection to which it is entitled. The fifth *DuPont* factor is the “fame” or strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods or services. *DuPont*, 177 USPQ at 567. In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

Turning first to inherent strength, the term “Valkyrie” is defined as “any of the beautiful maidens attendant upon Odin who bring the souls of slain warriors chosen by Odin or Tyr to Valhalla and there wait upon them.”⁴ Thus, we find on this record that VALKYRIE at most evokes beauty, divinity or fortitude and thus mildly suggests a quality of the recited goods or the experience of riding them.

We note, moreover, that cited Reg. No. 2088198 issued on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), and we must accord the cited registration the presumption of validity provided for under Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b). We thus

⁴ Dictionary.com; definition retrieved from Collins English Dictionary – Complete and Unabridged 2012 Digital Version (American English) accessed on January 26, 2020. The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format, *see, e.g., In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018), and we exercise our discretion to do so in this case.

presume that the VALKYRIE mark is inherently distinctive with no need to acquire secondary meaning. We further note that Applicants have not introduced any evidence to support a finding that VALKYRIE lacks inherent distinctiveness in association with the identified goods.

Turning to commercial strength, in their brief, Applicants argue that

there is no evidence that the cited Prior Marks are famous or have acquired secondary meaning within the marketplace or that consumers associate the term VALKYRIE with the Prior Owners.⁵

Applicants have adduced no evidence regarding the mark's commercial or marketplace strength. Further, in an *ex parte* appeal, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). For that reason, "in an *ex parte* analysis of the *du Pont* factors for determining likelihood of confusion ..., the '[commercial strength] of the mark' ... is normally treated as neutral when no evidence as to [marketplace recognition] ... has been provided." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1207.01(d)(ix) (Oct. 2018). Thus, because there is no evidence of record regarding the commercial strength of the cited VALKYRIE mark, this consideration is neutral.

Applicants also introduced into the record copies of approximately twenty pairs of third-party registrations issued on the Principal Register to numerous entities for

⁵ 6 TTABVUE 6. In their reference to "Prior Marks," Applicants are also discussing Reg. No. 5489910, noted above, that no longer serves as a basis for refusal of registration.

marks identifying motorcycles on the one hand and bicycles on the other, along with related goods.⁶ The marks in these pairs of third-party registrations are unlike the mark in the cited registration. Simply put, none of them consist in whole or in part of the term VALKYRIE or a variation thereof. To the extent the registrations were submitted to show the cited mark is weak, evidence of the Trademark Office's registration of pairs of marks unrelated to the marks at issue is not probative of the relative strength of the cited mark. *Cf. In re I.AM.Symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (third-party registrations for identical marks reciting unrelated goods not probative of weakness of mark). In addition, we are not privy to the prosecution histories of these pairs of third-party registrations or any agreements or consents to register between the owners thereof. It further is established that the Board is not bound by the prior decisions of examining attorneys, and each case must be decided on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Based upon the totality of the record evidence, we find that the registered mark is arbitrary or, at worst, mildly suggestive, and thus inherently distinctive as applied to the identified goods. “[E]xtensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir.

⁶ Applicants' September 10, 2019 Response to Office action at 42-49; 293-403; May 12, 2020 Request for Reconsideration at 14-20; 23-133.

2015) (citing *Juice Generation, Inc. v. GS Enters LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015)). In this case, there is no evidence of third-party use or third-party registrations of identical or similar marks for related products. We therefore find that the registered VALKYRIE mark is entitled to the normal scope of protection to which inherently distinctive marks are entitled. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

B. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicants' VALLKREE mark and the registered VALKYRIE mark in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "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); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted)." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d at 1468.

In comparing Applicants’ VALLKREE mark and the registered VALKYRIE mark, the obvious points of similarity are that both consist of eight letters with six letters in common, and in the same sequence. Thus, the marks are visually similar. Furthermore, the two letters the marks do not share in common are similar in sound and also are similarly placed in the respective marks. While there is no correct pronunciation of trademarks, phonetically VALLKREE and VALKYRIE are highly similar and it stands to reason that the two marks will be verbalized in a very similar manner by consumers. *Cf. In re Teradata Corp.*, 223 USPQ 361, 362 (TTAB 1984) (“as we have said many times, there is no ‘correct’ pronunciation of a trademark”). As noted above, the registered VALKYRIE mark connotes a beautiful celestial maiden from Norse mythology. Applicants have indicated that their VALLKREE mark has no meaning in a foreign language. Nor is it a readily recognized term in English.

Thus, VALLKREE could well be perceived by consumers as a novel spelling or otherwise a play on the term VALKYRIE for which there is a known meaning.

For these reasons, we find that the marks are similar in appearance, sound and connotation and, overall, convey highly similar commercial impressions. The first *DuPont* factor thus weighs in favor of finding a likelihood of confusion.

C. Conditions of Purchase

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Applicants argue without evidence that the consumers of their goods and those offered under the cited registered mark are “well educated, and not likely to make such purchases on impulse.”⁷

Applicants have presented no evidence that the relevant consumers are sophisticated or careful. Applicants’ argument is predicated on their attorney’s assertion, which is not evidence. *Cai v. Diamond Hong*, 127 USPQ2d at 1799 cited in *Performance Open Wheel Racing, Inc. v. U.S. Auto Club Inc.*, 2019 USPQ2d 20891, *8 n. 62 (TTAB 2019). While the nature of the goods themselves suggests that they are expensive, that does not necessarily imply that their purchasers are particularly sophisticated or careful. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1739 (TTAB 2018). In fact, the standard of care is that of the least sophisticated potential purchaser. *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163 cited in *In re FCA US LLC*,

⁷ Applicant’s brief, 6 TTABVUE 6.

126 USPQ2d 1214, 1222 (TTAB 2018) (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”).

All in all, we have no basis to find that ordinary consumers would exercise more than an ordinary degree of care. The fourth *DuPont* factor is neutral.

D. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of Applicants’ and Registrant’s subject marks. *DuPont*, 177 USPQ at 567. Applicants argue that “there has been no documented evidence that shows that any consumers have confused the respective marks in commerce.”⁸

As the Examining Attorney observes, however, the standard is likelihood of confusion, not actual confusion.⁹ See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018). “[U]ncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1163 (Fed. Cir. 2019) (quoting *Majestic Distilling*, 65 USPQ2d at 1205). This especially holds true in an ex parte context, where there is no chance for a registrant to show what opportunity for confusion there has been based on a registrant’s use and advertising of its mark. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198,

⁸ 6 TTABVUE 7.

⁹ Examining Attorney’s brief; 8 TTABVUE 10-11.

1204-05 (TTAB 2009). Moreover, Applicants made of record little, if any, evidence of their actual use of the VALLKREE mark, so we cannot gauge the opportunity for actual confusion to have occurred in the US marketplace. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039-40 (TTAB 2016).

Applicants' assertion of lack of actual confusion thus carries little probative value. The seventh and eighth *DuPont* factors are neutral.

E. The Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration," *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In comparing the goods, "[t]he issue to be determined . . . is not whether the goods . . . are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source." *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). Applicants' goods are various electric bicycles, tricycles, quadricycles, go-karts, and electric motors and parts therefor, and the goods in the cited registration are motorcycles and parts therefor.

The Examining Attorney argues that the involved goods are related “because the same entities frequently provide both applicants’ and registrant’s goods and market the goods in the same channels of trade. As the evidence of record shows, it is common for entities to offer both applicant[’s] and registrant’s goods.”¹⁰ The Examining Attorney’s supporting evidence establishes that two third parties, namely, Honda and BMW, offer certain of the goods identified in both the involved application and cited registration.¹¹ The Examining Attorney correctly notes: (citations omitted)

The Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney’s action.¹²

Nonetheless, the Examining Attorney has provided a mere two examples of third parties offering both Applicants’ goods and Registrant’s goods. Further, the evidence does not show that any third parties have registered marks identifying the goods recited in the involved application and cited registration. Simply put, this very sparse record is insufficient to establish that the goods identified in the cited registration are related to Applicants’ goods.¹³ As a result, the evidence of record fails to support

¹⁰ 8 TTABVUE 8.

¹¹ December 6, 2017 first Office Action at 13-19; July 13, 2020 Denial of Request for Reconsideration at 12-23.

¹² 8 TTABVUE 8.

¹³ We further note Applicant’s submission of twenty pairs of registrations, discussed above, for similar or identical marks issued to different third parties. These third-party registrations have some probative value to show that the Office has allowed the same marks to register to different entities for bicycles on the one hand and motorcycles on the other.

a finding that consumers are likely to believe Applicants' goods emanate from the same sources as those identified in the cited registration.

This factor favors a finding that confusion is not likely.

The third *DuPont* factor concerns "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161 (quoting *DuPont*, 177 USPQ at 567).

As discussed above, there is insufficient evidence that Applicants' identified goods are related to the goods identified in the cited registration, and the identifications themselves do not indicate that the goods are facially related. As a result, there is no presumption that these goods travel in common trade channels or are marketed to the same consumers. Further, there is very little evidence that these goods are available in the same channels of trade to the same consumers. While we recognize that two third parties offer these goods on their websites, there is insufficient evidence in the record that consumers would expect these goods to travel in the same channels of trade or be available to the same classes of purchasers under the same mark or similar marks.

This *DuPont* factor is neutral.

F. Conclusion

Having considered all of the evidence and argument of record, we find that while the marks are highly similar, Applicants' goods are not related to those identified in the cited registration. The rest of the *DuPont* factors we find to be neutral on this record. As result, we find that confusion is not likely.

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Decision: The refusal to register the VALLKREE mark under Trademark Act § 2(d) is reversed.