

From: Stiglitz, Susan

Sent: 11/29/2013 8:00:05 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85104423 - NUART CAN AM - SWPTC-xxxx - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 85104423.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 85104423

**MARK:** NUART CAN AM



**CORRESPONDENT ADDRESS:**

KENYA L WILLIAMS

FULWIDER PATTON LLP

6060 CENTER DRIVE TENTH FLOOR

LOS ANGELES, CA 90045

**GENERAL TRADEMARK INFORMATION:**

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

**TTAB INFORMATION:**

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

**APPLICANT:** Richard Nauert

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

SWPTC-xxxx

**CORRESPONDENT E-MAIL ADDRESS:**

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the examining attorney's final refusal to register **NUART CAN AM** in standard characters for "Automobiles and structural parts therefor; automobile chassis; automobile bodies," in Class 12. Registration was refused on the ground that there is a likelihood of confusion with

the mark in U.S. Registration No. 3686113 for **CAN-AM** in standard characters for “Land motor vehicles, namely, all terrain vehicles, motorcycles, three-wheeled motorized vehicles, scooters and structural parts therefor; engines for land vehicles, namely, all terrain vehicle engines, motorcycle engines, three-wheeled vehicle engines, scooter engines and structural parts therefor; Motorcycles and parts therefor,” in Class 12, among other goods and services, within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d). ***Please note that this refusal does not pertain to the Applicant’s goods in Class 7.***

#### **STATEMENT OF FACTS**

On August 10, 2010, the applicant, Mr. Richard Nauert, applied to register the mark NUART CAN AM in standard characters on the Principal Register under Section 1(b) of the Trademark Act. In the first Office action, issued on November 28, 2010, the Examining Attorney refused registration under Section 2(d) of the Trademark Act based on three registrations: U.S. Registration Nos. 2883129 and 3163329 (owned by the same registrant) for CAN AM (typed) and CAN-AM EXOTICS (typed with “EXOTICS” disclaimed), both for “automobiles and structural parts therefore,”<sup>i</sup> and U.S. Registration No. 3686113 for CAN-AM (standard characters) for “Land motor vehicles, namely, all terrain vehicles, motorcycles, three-wheeled motorized vehicles, scooters and structural parts therefor; engines for land vehicles, namely, all terrain vehicle engines, motorcycle engines, three-wheeled vehicle engines, scooter engines and structural parts therefor; Motorcycles and parts therefor,” in Class 12, among other goods and services. A procedural issue regarding the identification of goods was also raised. In response, the

Applicant presented arguments in favor of registration and amended the identification of goods. On April 8, 2011, one of the cited registrations, U.S. Registration No. 2883129, was cancelled due to a failure to file trademark registration maintenance documents. On June 24, 2011, the Examining Attorney issued a final refusal pertaining only to the identification of goods, and withdrew the refusal under Section 2(d) of the Trademark Act.

On December 27, 2011, the Applicant filed a request for reconsideration pertaining to the identification of goods issue. On December 28, 2011, the Examining Attorney approved the mark for publication; however, it was subsequently learned that this approval for publication was mistakenly made. As a result, on February 3, 2012, the approval for publication of the mark was withdrawn and returned to the Examining Attorney to reinstate the refusal under Section 2(d). The mark was never published for opposition. On April 17, 2012, the Examining Attorney issued a supplemental final Office action reinstating the refusals under Section 2(d) of the Trademark Act. Applicant then filed the instant appeal and request for reconsideration on October 15, 2012. Due to maintenance documents becoming due on one of the cited registrations, namely, U.S. Registration No. 3163329, the application was suspended on November 8, 2012. On July 16, 2013, once it had been determined that U.S. Registration No. 3163329 had been cancelled due to a failure to file trademark registration maintenance documents, and no longer presented a bar to registration, the application was removed from suspension and examination was resumed. As U.S. Registration No. 3686113 remained valid and in full force, a denial of the Applicant's request for reconsideration was issued on July 16, 2013, and the application was returned to the Board for resumption of the appeal.

No other issues remain.

**ARGUMENT**

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 any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning*

*LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

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).

## Similarity of the Marks

The Applicant's mark is confusingly similar to the Registrant's mark because it contains a term that is very similar to the Registrant's entire mark in sound, appearance and meaning. In creating its mark, the Applicant has added the term "NUART" to the Registrant's mark. It is well settled that the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii). Such is particularly true when the shared term comprises the entirety of the registered mark, as here, and there are no other elements to distinguish it from the Applicant's mark.

By presenting its mark in this manner, the Applicant heightens the opportunities for confusion because the average and sophisticated consumer is likely to believe – erroneously – that the Applicant's mark is a new or updated version of the Registrant's mark and, therefore, is likely to believe that the Registrant's goods originate from the Applicant. The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods and/or services, but it also protects against "reverse confusion," that is, the junior user is the source of the senior user's goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Fisons*

*Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994);  
*Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490-91, 6 USPQ2d 1187, 1190-91 (2d Cir. 1988).

The wording that is common to both marks is very similar, indeed nearly identical. The only difference between them is a hyphen in the cited mark and a space in the Applicant's mark. This difference is insignificant. First, these terms are phonetic equivalents and thus sound similar. 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); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). Second, they are otherwise spelled the same and have a very similar appearance. Both begin with the identical term "CAN" and end with the identical term "AM". The space in the Applicant's mark functions in a similar manner as the hyphen in the Registrant's mark in that both serve to provide a short pause between "CAN" and "AM". As such, the terms sound the same and have a similar commercial impression. It must be remembered that, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). The small difference of a space versus a hyphen separating otherwise identical terms is easily and likely glossed over by the consumer, especially since this difference does not result in a different sound or signal a different meaning. The evidence of record shows that the term is used both ways. The inclusion of a hyphen or space in the middle carries little significance, and does not distinguish the marks sufficiently to avoid a likelihood of confusion.

Another reason the marks are similar and likely to be confused is that the Registrant's mark is strong: it is the only "CAN AM" mark on the Trademark Register for the goods at issue. The only other "CAN AM" marks in existence on the Register have since been cancelled. Even if the previously-cited and now-cancelled registrations were still valid and in full force, the evidence of record shows that a consent agreement was executed between the owner of those registrations and the owner of the cited registration (see pp. 2-3 of the April 17, 2012 final Office action). Such shows that the cited mark was permitted to register due to the consent agreement, and not because the term "CAN AM" had become weak or diluted, as asserted by Applicant. It is well settled that examining attorneys must give "substantial weight" to proper consent agreements when such are filed in response to a likelihood of confusion refusal. TMEP Section 1207.01(d)(viii). The procedural history shows that the cited mark was approved for registration shortly after the filing of the consent agreement. Such is compelling evidence that the cited mark was permitted to register because this consent agreement was executed between the instant registrant and the owner of the now-cancelled registrations. Applicant argues that this consent agreement supports registration of its own mark; however, Applicant was not a party to the consent agreement nor has Applicant submitted its own consent agreement. Moreover, market conditions at the time the consent agreement was executed are different from current market conditions, and the only question now at issue is whether the current applied-for mark is confusingly similar to the current cited registered mark.

For these reasons, the marks create a very similar overall commercial impression.

In support of registration, Applicant argues that the marks are not confusingly similar because the Registrant is entitled only to a narrow scope of protection due to the Registrant's arguments in its own application for registration. This argument is not persuasive. Applicant places too much significance on arguments made by the then-Applicant/now-Registrant in attempting to register its own

mark. Argument is not the same as evidence, and it is the evidence of record that must be considered. As will be discussed in more detail below, the evidence of record in this case shows that the marks are very similar in sound, appearance and meaning and that the goods are closely related. Arguments the cited Registrant made in a different case nearly ten years ago have little, if any, probative value in the instant case.

Applicant next argues that the term "CAN AM" is weak and diluted because similar marks were previously registered and because third party uses of the term exist in the marketplace. This argument is not persuasive. Regarding the first part of the argument pertaining to prior registrations, it has already been discussed that those registrations coexisted with the cited mark because of a consent agreement executed between the owners of those registrations and the owner of the cited registration. Second, the evidence of third party usage referred to by the Applicant has little probative value. This evidence appears in Exhibit L of the Applicant's request for reconsideration and consists of Google® search results, not the actual web pages. A search results summary from an Internet search engine has limited probative value because such a list does not show the context in which the term or phrase is used on the listed web pages and may not include sufficient surrounding text to show the context within which the term or phrase is used. TBMP §1208.03; *see In re Bayer AG*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006); TMEP §710.01(b). Moreover, many of the search result summaries concern the cited Registrant, thereby demonstrating the strength of the cited mark.

The other evidence submitted by the Applicant of third party usage is also not sufficient to overcome the refusal because it consists of internet evidence that is not relevant. A number of the examples submitted by the Applicant discuss different goods and services from those at issue, particularly, aerospace products, bicycles, and association services. The goods at issue in this case are

motor vehicles and parts therefor. Evidence of use with different goods and services is not relevant and does not demonstrate that the mark is diluted. In addition, the evidence regarding the 1977 Pontiac Le Mans Can AM Sport Coupe carries little weight as it is from more than thirty years ago and does not demonstrate current use and market conditions.

It also bears noting that the Applicant has not argued and the evidence does not show that the term common to both marks is geographically descriptive or merely descriptive. The Applicant provided evidence that the term derives from a sports car racing series known as the Canadian-American Challenge Cup or Can-Am; however, a reference to a well-known racing series does not make the term suggestive, descriptive or geographically descriptive. Nor does the Applicant seem to be making such an argument. Moreover, as previously discussed, the Registrant's mark is the sole registered CAN AM mark for the goods at issue. It is therefore not diluted on the Trademark Register, and there is insufficient evidence that it is diluted in the marketplace.

Even if the evidence did show that the term "CAN AM" is weak or diluted, such does not support registration. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

As an apparent corollary to its argument above regarding the Registrant's mark being weak, the Applicant states in his brief that "The Examining Attorney argued that CAN-AM is the dominant portion

of the mark CAN-AM because CAN-AM makes up the entirety of the cited Registrant's mark."

Applicant's brief at p. 13. This statement is not accurate and mischaracterizes the Examining Attorney's arguments and position in this case. It is not disputed by the Applicant that CAN-AM is the only term comprising the Registrant's mark, and such is clearly shown from the face of the registration. CAN-AM therefore necessarily forms the entirety of the cited mark. Such does not make the term dominant in the mark, as such would require that other elements exist in the mark. Rather, the point made by CAN-AM being the entirety of the mark is that the cited mark contains no other elements by which its mark can be distinguished from the Registrant's mark. The Applicant may have been referring to the Examining Attorney's argument in an early Office action that one of the previously-cited and now-cancelled marks, "CAN AM EXOTICS," had "CAN AM" as a dominant term because "EXOTICS" is highly descriptive, if not generic. That argument has no relevance here, as this mark has since been cancelled.

Applicant next cites several cases for the proposition that other marks have registered and coexisted that are more similar than those at issue in this case. This argument is not persuasive and the cases cited by the Applicant are inapposite. These cases include marks that each include several elements, which, as noted above, is different from the marks in this case.

In summary, the marks at issue are confusingly similar because they share a very similar term, one that is the sole mark on the Register for the goods at issue and one that comprises the entirety of the cited mark. While the Applicant's mark does contain the distinctive term "NUART," such does not lessen the likelihood of confusion because the marks nonetheless sound very similar, look very similar, and have a similar meaning. It is therefore likely that consumers will be confused into believing that the Applicant is the source of the Registrant's goods, or vice versa. Applicant cannot obtain trademark rights in a mark, however distinctive a part of it may be, by including the registered mark of another entity.

### **Close Relationship of the Goods**

The Applicant's goods and the Registrant's goods are closely related because the evidence shows that they originate from the same sources and are marketed in the same trade channels. The cited registration contains multiple classes of goods and services. At issue primarily in this case are the Registrant's goods in Class 12: "Land motor vehicles, namely, all terrain vehicles, motorcycles, three-wheeled motorized vehicles, scooters and structural parts therefor; engines for land vehicles, namely, all terrain vehicle engines, motorcycle engines, three-wheeled vehicle engines, scooter engines and structural parts therefor; Motorcycles and parts therefor."

The Applicant's relevant goods are automobiles and structural parts therefor in Class 12. While Applicant argues that the parties' respective goods are not closely related because they consist of different types of land motor vehicles, the evidence of record shows that they are closely related despite this difference. The evidence includes website screen shots from manufacturers who produce both types of goods in this case, namely, automobiles and motorcycles, ATVs and scooters. The evidence also includes website screen shots from retailers and dealerships who offer both parties' goods. For example:

1. Honda® manufactures both automobiles and motorcycles – please see pp. 34-41 of the April 17, 2012 final Office action.
2. Suzuki® manufactures both automobiles and motorcycles/ATVs – please see pp. 42-50 of the April 17, 2012 final Office action.
3. Beers Auto ATV Cycle is a retailer offering automobiles, motorcycles and ATVs – please see pp. 31-33 of the April 17, 2012 final Office action.

4. Tri State Vehicles is a retailer describing its services as follows: “Tri State Vehicles and ATV offers the widest selection of quality preowned **cars**, trucks, vans, SUVs, **ATVs**, **and UTVs** in the area” (emphasis added). Please see pp. 2-3 of the July 16, 2013 Denial of the Request for Reconsideration.
5. South Pacific is a retailer of both automobiles and motorcycles. Two pages from their website show that they sell both automobiles and recreational powersports vehicles such as the Registrant’s goods. The evidence includes screen shots from their website, which reads in pertinent part: “We sell used dirt bikes, sport bikes, ATVs, cars, trucks, SUVs and more.” See page 12 of the July 16, 2013 Denial of the Request for Reconsideration.
6. Additional web pages from South Pacific read: “South Pacific Motorcycles Sales is the newest department of South Pacific Auto Sales....It is the Motorcycle Department’s goal to satisfy all of your power sports needs by giving you wide selection of quality motorcycles and ATVs to choose from.” Please see pp. 12-13 of the July 16, 2013 Denial of the Request for Reconsideration.
7. Powerhouse Motor Sports is a retailer of new and used inventory consisting of automobiles, ATVs, UTVs, scooters and dirt bikes, as well as used parts. Please see pp. 5-8 of the July 16, 2013 Denial of the Request for Reconsideration.
8. John Gibson Auto Sales is a retailer offering both automobiles as well as motorcycles and ATVs. Please see pp. 9-11 of the July 16, 2013 Denial of the Request for Reconsideration.

Material obtained from the Internet is generally accepted as competent evidence. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); *In re Joint-*

*Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

In addition to this marketplace evidence, a number of third-party trademark registrations were made of record from the USPTO's X-Search database that cover both parties' goods under the same marks (pp. 51-109 of the April 17, 2012 final Office action). This evidence shows that the goods listed therein, namely automobiles as well as motorcycles, ATVs and scooters, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). For example, set forth below are several highlighted registrations:

**U.S. Registration No. 3461213** (pp. 51-53 of the April 17, 2012 final Office action) for the mark "CITYCOM" covering the following goods, in pertinent part: "Vehicles, namely, automobiles, motorcycles....sports motorcycles, electric scooters...all-terrain vehicles, and parts and fitting thereof...."

**U.S. Registration No. 3247274** (pp. 71-73 of the April 17, 2012 final Office action) for the mark "GAMAX" covering the following relevant goods: "All-terrain vehicles; motorized scooters; non-motorized scooters; motorcycles and structural parts therefor; motorcycle engines; four-wheel motorcycles; cars; automobile engines...."

**U.S. Registration No. 4040759** (pp. 95-97 of the April 17, 2012 final Office action) for the mark “BELLAVITA” covering “Automobiles, electric automobiles, motorcycles, electric motorcycles, all terrain vehicles....”

**U.S. Registration No. 3723502** (pp. 62-64 of the April 17, 2012 final Office action) for the mark “EON” covering “Sports vehicles in the nature of all-terrain vehicles...cars...”

**U.S. Registration No. 3159972** (pp. 65-67 of the April 17, 2012 final Office action) for the mark “UNILLI” covering the following relevant goods: “Motorized vehicles, namely...automobiles, motorcycles, all-terrain vehicles...”

As the evidence of record shows, both types of goods originate from the same manufacturers and are offered by the same retailers. The websites of these entities display both types of goods side by side, and market them alongside one another. Were the average -- and sophisticated -- consumer to encounter both the Applicant’s mark and the Registrant’s mark in the marketplace, it is likely that he or she would believe mistakenly that the goods originate from the same source.

Another reason why the goods are closely related is that neither the Applicant’s goods nor the Registrant’s goods are limited. Both are identified broadly and cover a sufficient type and number of goods as to overlap. With respect to an applicant’s and registrant’s goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*,

671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (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 and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in both 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. It must also be remembered that the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii). Therefore, based on the faces of the registration and application, the relevant scope of both the Applicant's and the Registrant's goods is broad and covers all types of the respective goods identified.

Such is significant because the Applicant asserts that its goods are limited in scope and restricted in nature. Specifically, the Applicant argues that its goods are custom-made racing cars and are thus different from the Registrant's goods. This argument is not persuasive because the Applicant's identifications of goods is not limited to race cars or to custom-made vehicles, nor are the Registrant's goods limited to passenger, recreational or mass-produced vehicles. Rather, both identifications of goods are broader and encompass all types of the vehicles they set forth. Consequently, the Applicant's

goods include all types of automobiles, such as conventional passenger cars, recreational cars and race cars; likewise, the Registrant's goods are not limited to a specific type or use of its vehicles. They, too, are identified broadly enough to include conventional motorcycles used for commuting and every-day transportation as well as racing and recreation.

Even if the Applicant's goods were limited to race cars, this distinction would not distinguish the goods because the evidence shows that all of the goods at issue, the Applicant's cars as well as the Registrant's various vehicles, are identified broadly enough to include vehicles used for racing. In his brief, the Applicant states that his goods are "race cars and their parts." See Applicant's Brief at p. 16. The evidence shows that the Registrant's goods are also used for racing. For example, screen shots from the websites of Honda® and Suzuki® attached to the April 17, 2012 Office action show that ATVs and motorcycles are used for racing (please see pp. 38, 40 and 45 of the April 17, 2012 final Office action). Also the screen shot from Powerhouse Motor Sports' website shows that motorcycles are used for racing (p. 5 of the July 16, 2013 request for reconsideration denial). Although the Applicant's and Registrant's goods would typically not be raced against one another or be presented at the same races, they nonetheless would be marketed to individuals and groups interested in vehicular racing, whether as spectators or participants. Racing venues as well as marketing and promotion for such venues and events are therefore another opportunity where consumers encountering both marks would likely be confused into believing that the goods emanate from the same source. Applicant's argument is not persuasive.

The Applicant next argues that its goods are very expensive and specialized, made especially for racing, and are therefore not related to the Registrant's goods because the latter are recreational vehicles sold at a lower price point. While the evidence does show that the Applicant's goods are more expensive than the Registrant's goods, such does not negate or diminish the Registrant's trademark

protection of its registered mark. An applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence, for example, as to the quality or price of the goods. *See, e.g., In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764–65 (TTAB 1986). Based on the identification of goods in the application, the applicant’s goods cover all types of automobiles, not only expensive racing cars. Similarly, based on the face of the cited registration, the registrant’s goods cover all types of motorcycles, ATVs and scooters, including those used for racing. Moreover, a consumer wealthy enough to purchase the Applicant’s goods might also be interested in the Registrant’s motorcycles and other sports vehicles. One can imagine such a consumer walking through a showroom or perusing the parties’ respective web pages and encountering both types of goods. If this consumer encountered both marks on such goods, it is likely that he or she would believe that the goods originated from the same source -- that the Applicant’s NUART CAN AM automobiles are a new or expanded product line of the Registrant or that the Applicant had acquired the Registrant’s CAN-AM mark.

Lastly, the Applicant argues that its consumers are sophisticated and knowledgeable about cars and therefore will not be confused as to the source of the goods. However sophisticated or knowledgeable the Applicant’s consumers may be, the evidence of record outweighs any sophistication or knowledge they may have about cars, and the fact that they are sophisticated and knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Sophistication of the Applicant’s consumers does not outweigh the real world evidence of the close relationship of the goods in this case. Applicant’s arguments are not persuasive, and they do not overcome the likelihood of confusion.

## **CONCLUSION**

The marks share a term that is identical in sound and meaning, and is very similar in appearance. This shared term forms the entirety of the cited Registrant's mark, which is the sole mark on the Trademark Register for the relevant goods. In creating its mark, the Applicant has merely added a term to the Registrant's mark and, no matter how distinctive a term may be, it does not obviate the likelihood of confusion, particularly when the added term has a connotation of being new. Such creates the impression that the junior user is adopting the senior user's mark or that the senior user is expanding its business into a related territory. Either way, a likelihood of confusion exists in this case because of this strong similarity the marks share combined with the evidence demonstrating that the goods originate from the same manufacturers and are offered by the same retailers and dealers. Accordingly, the refusal to register pursuant to Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

/Susan R. Stiglitz/

Trademark Examining Attorney

USPTO

Law Office 109

571-272-9285

susan.stiglitz@uspto.gov

Dan Vavonese

Managing Attorney

Law Office 109

---

<sup>i</sup> U.S. Registration Nos. 2883129 and 3163329, owned by the same registrant, were initially cited in this case. The former registration was cancelled on April 8, 2011, and the latter was cancelled on May 31, 2013, both due to a failure to file trademark registration maintenance documents.