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

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Applied for Mark	NUART CAN AM
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of

Applicant : Richard Nauert

Serial No. : 85/104,423

Filing Date : August 10, 2010

Mark : NUART CAN AM

Susan R. Stiglitz
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APPLICANT'S REPLY BRIEF

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I. INTRODUCTION

Applicant acknowledges the Examining Attorney's clarification that registration of Applicant's NUART CAN AM mark in Class 7 is not at issue, and that this Appeal only pertains to Applicant's Class 12 goods.

In her Brief, the Examining Attorney has inexplicably failed to accord any weight to the registration of Applicant's inherently distinctive mark, NU ART (see prosecution history for Applicant's NU ART mark attached to Request for Reconsideration as Exhibit E, showing that Applicant's then-pending application for NU ART was issued a Notice of Allowance by the USPTO), in connection with the very same description of goods at issue in the instant application, which renders Applicant's applied-for NUART CAN AM mark also inherently distinctive and eligible for registration. The Examining Attorney's acknowledgment that the NUART portion of Applicant's NUART CAN AM mark is distinctive (see Ex. Atty. Br., at p. 11), reasonably leads to the conclusion that Applicant's mark is registerable.

Further, when the marks are properly viewed in their entireties rather than in the context of an improper dissection of the marks, Applicant's NUART CAN AM mark is undeniably different from the cited CAN-AM mark with regard to its appearance, sound, connotation and commercial impression.

Moreover, Applicant respectfully submits that the goods in connection with which his mark will be used are distinctly different from the goods identified in the cited registration. In fact, the cited Registrant itself distinguished the applicable goods in the cited registration from the goods of a prior registration, which bears the same description as Applicant's goods. Given that the cited Registrant itself specifically disclaimed automobiles during the prosecution of the application for registration of its mark, the Examining Attorney should not now be allowed to

expand the cited registration to include automobiles when it clearly does not. Furthermore, the acceptance of the consent agreement between the cited registrant and a prior registrant by the USPTO is further evidence that the cited registration does not include automobiles and that there is no likelihood of confusion between the marks that were part of that agreement, which are analogous to the marks at issue in the instant matter.

Finally, the channels of trade of the respective marks is highly dissimilar, with Applicant's goods being custom-made, whereas the cited mark and the examples cited by the Examining Attorney represent goods sold in a traditional retail or online setting. Applicant's goods are not sold via traditional retail or online stores, but are custom-built to the customer's specifications, which customers are highly sophisticated and inclined to spend hundreds of thousands of dollars for a custom-built automobiles bearing Applicant's mark.

Therefore, Applicant respectfully traverses the Examining Attorney's contention that Applicant's mark is confusingly similar to the cited mark and that Applicant's goods and the cited Registrant's goods are related, especially given that the cited Registrant was able to obtain registration of its mark in spite of the existing prior registration, consent agreement or not.

As such, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register Applicant's mark due to an alleged likelihood of confusion with the mark CAN-AM, due to the dissimilarity of the marks, the differences between the goods in connection with which each respective mark is used, and the dissimilarities between the respective channels of trade and target purchaser of goods bearing the respective marks.

II. ARGUMENT

A. Applicant's Mark Is Dissimilar To The Cited Registrant's Mark With Regard To Its Appearance, Sound, Connotation and Commercial Impression.

The Examining Attorney has taken a narrow view of the marks at issue with regard to their respective appearances, sound, connotations and commercial impressions. Instead of viewing the marks in their entirety without dissecting them into parts, the Examining Attorney has engaged in a side-by-side comparison of the elements of each mark, which contravenes prevailing principles in trademark law. To wit, the Examining Attorney states in her brief: "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." Ex. Atty. Br., at p. 6. [emphasis added].

Further, the Examining Attorney's acknowledgement that the NUART portion of Applicant's mark is distinctive, see Ex. Atty. Br., at p. 11, contradicts the argument that there are no elements to distinguish Applicant's and the cited Registrant's respective marks. In fact, Applicant respectfully submits that despite the inaccurate characterization made by the Examining Attorney, Applicant started with its distinctive mark, NUART, and added the term CAN AM, rather than the reverse.

Applicant respectfully submits that the additional word in his mark, which is undeniably distinctive, and the lack of punctuation in the word that the marks have in common, constitute several distinguishing elements between Applicant's NUART CAN AM mark and the cited Registrant's CAN-AM. In *Plough, Inc. v. Kreis Laboratories*, the marks at issue were COPA TAN, COPA TINT and COPA CREAM (Plaintiff's marks) versus COCA TAN and COCA

TINT (Defendant's marks). 314 F.2d 635, 636-37, 136 USPQ 560, 561 (9th Cir. 1963). The court there found that the marks at issue were not confusingly similar, although they had a word in common and the first words differed by only one letter and rhymed. *Id.* There, only a one letter difference was enough to distinguish the marks, as the court found that the marks looked different, were pronounced differently, and created a different overall commercial impression than one another based upon the difference in meaning of the first word of each respective mark, 314 F.2d at 638-39, 136 USPQ at 563.

Similarly, here, the addition of the word NUART and lack of punctuation in Applicant's mark are enough to distinguish the appearance, sound, connotation and commercial impression of Applicant's mark from the cited Registrant's mark.

Moreover, the cited mark is not entirely contained within Applicant's mark. Even if this were true, this would not be dispositive. In the case of *In re Reach Electronics, Inc.*, 175 USPQ 734 (TTAB 1972), the Board reversed the Examining Attorney's refusal of registration even though the registered REAC mark was contained entirely within the applicant's REACH mark. 175 USPQ at 735. In contrast, here, the cited Registrant's mark contains an element that distinguishes it from the Applicant's mark, namely, punctuation between the words CAN and AM that, combined with the additional word in Applicant's mark, sufficiently distinguish and differentiate the two marks.

Furthermore, it is worth noting that this case is distinguishable from *In re White Swan Ltd.*, 8 USPQ2d 1534 (TTAB 1988) because, in that case, the Board reasoned that although there was a difference in punctuation and the applied-for mark contained an additional word, the marks began and ended with the same words, SHAKE and GROW. Here, this is not the case; the cited registration consists entirely of CAN-AM whereas Applicant's mark begins with the

distinct term NUART and ends with AM. Therefore, because Applicant's mark and the cited Registrant's mark do not begin and end with the same words, the Board should come to an opposite conclusion with respect to this case versus the *In re White Swan Ltd.* case.

The instant case is also distinguishable from *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581 (TTAB 2007) where the Board found a likelihood of confusion between the registered mark FIRST USA and the applied-for mark 1st USA and design. 84 USPQ2d at 1587. There, the marks were found to be pronounced the same, despite their difference in spelling and design, among other factors, which led the Board to affirm the Examining Attorney's refusal of registration. *Id.* at 1588.

Here, although the *second half* of Applicant's NUART CAN AM mark is phonetically (although not visually) similar to the registered mark CAN-AM, the distinctive NUART portion of Applicant's mark makes it sufficiently distinguishable from the registered mark, such that consumers are not likely to be confused as to their respective sources. Therefore, the marks at issue are dissimilar with regard to their respective appearances and sound, in contrast to the cited examples.

Applicant's mark and the cited Registrant's mark are also different with regard to their respective connotations and commercial impressions. It follows logically that if marks are different with regard to their appearance and sound, they are likely dissimilar with regard to their connotation and commercial impression.

Finally, Applicant respectfully submits that the Examining Attorney's position is not consistent with the cited test, namely, 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." Ex Atty. Br., at p. 7, citing *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 "anti-dissection rule" warns against focusing on only a part of a mark. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749-750-51 (Fed. Cir. 1985).

Here, consideration of Applicant's NUART CAN AM mark in its entirety necessitates the finding that Applicant's mark, as a whole, is very different from the cited Registrant's CAN-AM mark, so much so that they are unlikely to be confused with one another. Therefore, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal of registration, as Applicant's mark is sufficiently dissimilar to the cited mark to avoid a likelihood of confusion.

B. Applicant's Goods Are Distinctly Different From The Cited Registrant's Goods, Even According To The Cited Registrant.

Applicant respectfully submits that there appears to be a misunderstanding as to the true nature of Applicant's goods. As discussed in Applicant's Main Brief and herein, the goods at issue in Applicant's application are *automobiles and structural parts therefor; automobile chassis; automobile bodies*, in Class 12. In contrast, the cited Registrant's goods, by its own admission, are not automobiles. *See* Exhibit G to Applicant's May 31, 2011 Response to Office Action. In response to a November 25, 2005 Office Action, the cited Registrant distinguished its goods from the description, which covered automobiles and parts therefor, in the application cited against the cited Registrant's then-application. Aside from the fact that the goods identified in Applicant's application are actually different than and do not overlap with the cited

Registrant's goods, the respective goods in connection with which the respective marks are used are highly distinguishable from one another and not likely to be confused.

Unlike the goods at issue in *Midwestern Pet Foods*, where the Applicant and the registrant sold identical goods, the respective marks in the instant matter are not used in connection with identical goods. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d at 1053. This point becomes even more salient upon review of the prosecution history of the cited registration. There, the cited registrant-then applicant *specifically distinguished* its identified goods from automobiles. *See* Exhibit G to Applicant's May 31, 2011 Response to Office Action.

Theoretically, the applicant itself would be in the best position to know the nature of its own products. Further, the applicant has a vested interest in consumers being able to distinguish its goods over those of others. Therefore, it would be highly appropriate to give great weight to the cited registrant's own statement that its goods are different and distinct from automobiles, such that use of similar marks on the cited Registrant's goods and automobiles would not lead to a likelihood of confusion. Moreover, by effectively disclaiming the inclusion of automobiles in the cited Registration's description of goods during the prosecution of the application, the cited Registrant would be precluded from broadening its description in the future, and so should the Examining Attorney be precluded from doing so as well.

Therefore, Applicant respectfully submits that its identified goods are different from the cited Registrant's identified goods, there is no overlap between the respective identifications, and, therefore, the Examining Attorney's refusal of registration should be reversed.

C. The Respective Goods Move Through Different Channels Of Trade Whose Purchasers Are Sophisticated And Very Different From Each Other.

Unlike the goods at issue in *Edom Labs*, the goods at issue here are not purchased by "ordinary consumers who exercise no more than ordinary care in making their purchasing decisions." *Edom Labs., Inc. v. Lichter*, 102 USPQ2d at 1551. In the instant matter, the goods at issue are all expensive, with the cost of Applicant's goods starting at nearly \$500,000. Exhibits H and I of Applicant's October 15, 2012 Request for Reconsideration. Even the cited Registrant's goods, which start at about \$6,799.00, will prompt a consumer to pay attention to the source of the goods given the price tag. Not only the cost of the respective goods, but also the nature of such goods, especially Applicant's goods, necessitates a sophisticated purchaser and one who has very specific interests. To wit, Applicant's mark is for use in connection with race cars, identified in the application as *automobiles and structural parts therefor; automobile chassis; automobile bodies*, whereas the cited Registrant's mark is for use in connection with *land motor vehicles, engines for land vehicles, and motorcycles*; all identified by the cited Registrant as non-automobiles.

Although the channels of trade for the respective goods are not expressly spelled out in the description of goods, certain details in the description nonetheless define the channels of trade. To wit, Applicant's identification of automobiles and their parts by default identifies the channel of trade and target consumers as those interested in purchasing automobiles. In the actual marketplace, Applicant's goods cannot be simply purchased in a physical or online retail store like those of the cited Registrant and in the examples cited by the Examining Attorney. A prospective purchaser of Applicant's goods must contact Applicant and order an automobile

bearing Applicant's mark, rather than shopping online or in a retail store and purchasing a product on the spot.

Further, because the minimum price of an automobile in connection with Applicant's NUART CAN AM mark costs hundreds of thousands of dollars, the decision to purchase such an automobile is not likely to be done on a less than fully informed basis. The evidence of record clearly indicates, even as acknowledged by the Examining Attorney, that a purchaser of Applicant's goods is likely to be a very sophisticated purchaser, not only because of the extremely high cost of the goods, but because of their specialized nature. Applicant's goods are directed toward a specific audience, namely, those with the monetary resources and race car expertise to make an informed decision about their \$500,000 purchase.

On the other hand, the cited Registrant's land terrain vehicles, motorcycles, etc. are directed toward an entirely different segment of consumers. Although the Examining Attorney identified manufacturers and retailers of automobiles, motorcycles and all-terrain vehicles, none of the cited examples mimic the circumstances under which a consumer would purchase Applicant's goods. The channels of trade for Applicant's goods are very unlike those of the cited Registrant and the examples, such as Honda and Suzuki cited by the Examining Attorney.

Accordingly, Applicant respectfully submits that its goods travel through different channels of trade than those of the cited Registrant and that its target consumers are so sophisticated and willing to spend such great sums of money that they are highly unlikely to be confused as to the source of the product they intend to purchase.

D. The Cited Registrant's Goods Are Limited Such That They Are Unlikely To Be Confused With Applicant's Identified Goods.

Applicant respectfully submits that the cited Registrant's description of goods is limited and sets forth different types of vehicles than Applicant's automobiles. See Exhibit G to Applicant's May 31, 2011 Response to Office Action.

Therefore, Applicant respectfully traverses the Examining Attorney's contention that Applicant's and the cited Registrant's goods overlap. In fact, it is important to note that when describing the respective goods at issue in connection with Applicant's mark and the cited Registrant's mark, the Examining Attorney did not identify any goods that actually overlap, i.e., automobiles are missing from the cited Registrant's identification and land terrain and all-terrain vehicles and motorcycles are missing from Applicant's identification.

Therefore, the limitations identified in the cited registration are sufficient to render Applicant's identified goods disparate from those of the cited Registrant, on the face of the application and cited registration, respectively. As such, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal of registration and remand the case to the Examining Attorney for publication.

E. The Consent Agreement Is Further Evidence That The USPTO Agrees That There Is No Likelihood Of Confusion Between The Cited Registrant's Mark And Other Marks In The Same Class Of Goods Bearing CAN AM As Part Of The Mark.

The fact that the USPTO accepted the Consent Agreement between the then-applicant, now cited-Registrant, and the owner of the marks CAN AM, CAN AM EXOTICS and CAN-AM in connection with automobiles and structural parts therefor in Class 12, see Exhibit D to

Applicant's October 15, 2012 Request for Reconsideration, is indicative of the USPTO's belief that there is no likelihood of confusion between the marks at issue. Regardless of agreements between the parties, if the USPTO believed that there was a likelihood of confusion between the marks at issue in that agreement, the USPTO would be obligated not to accept the agreement and continue the refusal of registration of the later-filed application. Because the USPTO did not reject the Consent Agreement between the cited Registrant and the prior registrants to that agreement, so it is also true that there must be no likelihood of confusion between those marks. Applicant respectfully submits that the issue at hand is analogous to the issue there in that Applicant's mark contains a word in addition to the one in the cited registration, and lacks punctuation, and therefore, should be deemed dissimilar. In fact, Applicant merely added a word to its already distinctive NUART mark, rather than the reverse being true, as offered by the Examining Attorney.

Therefore, Applicant respectfully requests that the Board reverse the refusal of registration on the additional grounds that the USPTO has already found that there is no likelihood of confusion between the cited mark and other marks bearing CAN AM in conjunction with another word, and that Applicant's additional word is distinct. Finally, Applicant formed his mark by adding words to its already distinctive NUART mark.

III. CONCLUSION

Applicant respectfully requests that the Examining Attorney's Section 2(d) Refusal be reversed and that the instant application be approved for publication. As discussed in Applicant's Main Brief and herein, the appearance, sound, meaning and commercial impression of Applicant's mark are different from the cited Registrant's mark; the goods in connection with Applicant's mark are highly specialized and very different from those associated with the cited

