

From: Stiglitz, Susan

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Subject: U.S. TRADEMARK APPLICATION NO. 85104423 - NUART CAN AM - SWPTC-xxxx - Request for Reconsideration Denied - Return to TTAB - Message 1 of 0

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Attachment Information:

Count: 5

Files: w1-1.jpg, w1-2.jpg, w2.jpg, w3-1.jpg, 85104423.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**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>

**APPLICANT:** Richard Nauert

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

SWPTC-xxxx

**CORRESPONDENT E-MAIL ADDRESS:**

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:**

On November 8, 2012, action on this application was suspended pending disposition of cited **U.S. Registration No. 3163329**, for which maintenance documents were due to be filed. See 37 C.F.R. §2.67; TMEP §716.02(e). USPTO records indicate that the cited registration has been cancelled and is no longer a bar to registration of applicant's mark. Therefore, the instant application is removed from suspension and the Section 2(d) refusal is withdrawn with respect to this particular registration.

With respect to the other cited registration on which the Section 2(d) refusal is based, **U.S. Registration No. 3686113**, please see below:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated April 17, 2012 with respect to this registration is maintained and continues to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

As discussed in the Suspension Notice of November 8, 2012, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Applicant's argument regarding the consent agreement between the owners of the cited registrations is not persuasive and does not support registration of its own mark: applicant was not a party to that consent agreement nor has applicant executed a consent agreement of its own. The consent agreement shows that – but for the consent agreement between the prior registrants, for which consideration was made and in which safeguards by the parties against any likelihood of confusion between their marks were set forth – *the second mark would not have registered*. Such shows the strength of the cited marks, particularly as they are the only ones that have been registered for the goods at issue. As such, contrary to the applicant's assertions, the consent agreement supports the refusal to register, not registration of applicant's mark.

The examining attorney also notes that 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). As such, the inclusion of the term "NUART" in the applicant's mark does not distinguish it from the prior registrant's

mark. The average consumer is likely to believe – mistakenly – that the applicant is the source of the prior registrant’s goods. Such is another compelling reason why the term “NUART” in the applicant’s mark does not obviate this refusal.

A considerable amount of evidence was attached to the final Office action of April 17, 2012. For the applicant’s and the Board’s convenience and as some of this evidence pertains only to the now-cancelled and therefore moot U.S. Registration No. 3163329, the examining attorney highlights the most probative evidence pertaining to the cited registration that remains at issue.

First, a representative sampling of internet evidence features website screen shots from several manufacturers and dealerships of both the applicant’s goods and the registrant’s goods, namely, automobiles, ATVs, motorcycles and scooters:

Beers Auto ATV Cycle, [www.beersautoatvcycle.com](http://www.beersautoatvcycle.com), at pages 31–33

Honda, [www.honda.com](http://www.honda.com), at pages 34–41

Suzuki, [www.suzukiauto.com](http://www.suzukiauto.com) and [www.suzukicycles.com](http://www.suzukicycles.com), at pages 42–50

Second, a representative sampling of third-party trademark registrations includes both the applicant’s goods and the registrant’s goods. Please see the final Office action at pages 51–109. This evidence shows that the goods listed therein, namely automobiles, motorcycles, ATVs, scooters and parts for these goods, 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).

To supplement the record, the examining attorney has attached additional internet evidence showing that the applicant’s and registrant’s goods are marketed in the same trade channels. These representative websites show that the parties’ respective goods are offered via the same dealerships and retailers. This evidence demonstrates that both primary and secondary markets offer both types of goods. The average consumer, therefore, whether buying new or used automobiles, motorcycles, ATVs, scooters and parts for these goods, would be exposed to all of these goods in the same place and, if the average consumer were exposed to both the applicant’s mark and the registrant’s mark in the marketplace, it is likely that he or she would believe erroneously that the goods come from the same source.

The evidence shows that the goods are closely related. As they are identified by such similar marks, a likelihood of confusion exists. Accordingly, the request for reconsideration is denied.

As the applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Susan R. Stiglitz/

Trademark Examining Attorney

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