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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
Examining Attorney
Law Office 109

September 23, 2013

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I. DESCRIPTION OF THE RECORD

The instant application was filed on August 10, 2010. The description of goods read: *automobile and automobile parts*, in Class 012.

An Office Action was mailed on November 28, 2010. In said Office Action, the Examining Attorney refused registration of Applicant's mark because of a likelihood of confusion with the marks in U.S. Registration Nos. 3,163,329, 2,883,129 and 3,686,113 for the marks CAN-AM EXOTICS, CAN AM and CAN-AM, respectively. The Examining Attorney also stated that the identification of goods was indefinite and required that they be clarified, as the nature of the goods was unclear.

On May 31, 2011, Applicant filed a response to the Office Action in which the description of goods was amended to read: *automobiles and structural parts therefor; automobile chassis; automobile bodies*, in Class 012. Applicant also added the following description of goods to the application: *automobile parts, namely, bellhousing, valve covers, injection systems, intake systems, and engine management systems* in Class 007. In addition to amending the description of goods in Class 012 and adding Class 007 goods to the application, Applicant responded to the Examining Attorney's refusal of registration under 15 U.S.C. § 1052(d), Section 2(d) of the Trademark Act, based upon a likelihood of confusion with Reg. Nos. 3,163,329, 2,883,129 and 3,686,113. At the time of Applicant's response, Reg. No. 2,883,129 for CAN AM had been cancelled and was no longer a bar to registration of Applicant's mark. Therefore, Applicant presented arguments against a likelihood of confusion between its mark and Reg. Nos. 3,163,329 and 3,686,113.

On June 24, 2011, the Examining Attorney issued a Final Office Action. The Examining Attorney accepted Applicant's amended description of its Class 012 goods, but deemed a significant portion of the Class 007 goods unacceptable, as indefinite, and required clarification because the nature of those goods remained unclear. The Examining Attorney then provided proposed amended language that Applicant could use to comply with this partial requirement.

On December 27, 2011, Applicant filed a Request for Reconsideration in response to the June 24, 2011 Final Office Action, in which Applicant amended its Class 007 description of goods to read:

Automobile parts, namely, automobile engine valve covers, engine parts in the nature of electronic fuel injection modules, intake manifolds, and engine management systems in the nature of electronic control modules that utilize input valves calculated from sensor devices to control the fuel mixture, amount of fuel, ignition timing, and idle speed of an internal combustion engine.

Subsequently, on December 28, 2011, the Examining Attorney approved the instant application for publication, finding Applicant's arguments against a likelihood of confusion with all of the cited registrations, including the current cited registration, Reg. No. 3,686,113, to be persuasive. Therefore, the Examining Attorney withdrew the Section 2(d) refusal of registration based on the cited marks.

On January 20, 2012, the Examining Attorney completed the publication/issue review.

Thereafter, on April 17, 2012, nearly four (4) months after approving the instant application for publication, the Examining Attorney issued *another* Final Office Action maintaining the Section 2(d), likelihood of confusion refusal, as to Reg. Nos. 3,163,329 and 3,686,113 for the marks CAN-AM EXOTICS and CAN-AM, respectively. The registration for the third previously cited mark, CAN AM (Reg. No. 2,883,129), was cancelled on April 8, 2011 because of the registrant's failure to file an acceptable Section 8 declaration.

On October 15, 2012, Applicant filed a Request for Reconsideration in response to the April 17, 2012 Final Office Action, in which Applicant submitted additional arguments against the Section 2(d), likelihood of confusion refusal, and in support of the registrability of Applicant's mark. At the same time, Applicant timely filed its Notice of Appeal.

On November 8, 2012, the Examining Attorney suspended examination of the instant application, pending receipt of maintenance documents due to be filed for the CAN-AM EXOTICS registration (Reg. No. 3,163,329).

On May 31, 2013, Reg. No. 3,163,329 was cancelled due to the registrant's failure to file maintenance documents.

On July 16, 2013, the Examining Attorney acknowledged that Reg. No. 3,163,329 was no longer a bar to registration of Applicant's mark because it had been cancelled. Nevertheless, the Examining

Attorney denied Applicant's Request For Reconsideration, due to a Section 2(d) likelihood of confusion refusal, based upon the remaining cited mark, CAN-AM (Reg. No. 3,686,113), causing the instant appeal to be resumed.

II. STATEMENT OF THE ISSUES

Whether Applicant's mark, NUART CAN AM, for use in connection with "Automobile parts, namely, automobile engine valve covers, engine parts in the nature of electronic fuel injection modules, intake manifolds, and engine management systems in the nature of electronic control modules that utilize input valves calculated from sensor devices to control the fuel mixture, amount of fuel, ignition timing, and idle speed of an internal combustion engine" and "automobiles and structural parts therefor; automobile chassis; automobile bodies" creates a likelihood of confusion with the CAN-AM mark of Registration No. 3,686,113.

The cited mark, CAN-AM (Reg. No. 3,686,113), is for use in connection with, among other goods and services, "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 012.[1] The registration is owned by Bombardier Recreational Products Inc., a Canadian corporation.

[1] In addition to goods in Class 012, which are the most relevant with regard to the instant application, Registration No. 3,686,113, for the mark CAN-AM, also identifies goods and services in Classes 009, 028, 035, 037, 039, 040, 041 and 042. Notably, the cited registration does not identify any goods in Class 007.

III. RECITATION OF THE FACTS

A. The Examining Attorney Has Previously Approved The Subject Mark For Publication And Completed The Publication/Issue Review

Previously, on December 28, 2011, the Trademark Office approved for publication the instant intent-to-use application, Serial No. 85/104,423, for the mark NUART CAN AM, for use in connection with "Automobile parts, namely, automobile engine valve covers, engine parts in the nature of electronic fuel injection modules, intake manifolds, and engine management systems in the nature of electronic control modules that utilize input valves calculated from sensor devices to control the fuel mixture, amount of fuel, ignition timing, and idle speed of an internal combustion engine" in Class 007 and "automobiles and structural parts therefor; automobile chassis; automobile bodies" in Class 012. See Exhibit A to Applicant's October 15, 2012 Request for Reconsideration, at p. 1.

Thereafter, on January 20, 2012, the Trademark Office completed its publication/issue review, *id*., at Exhibit B, p. 1, and no activity occurred on the instant application until April 17, 2012, when the Examining Attorney reinstated the Section 2(d) likelihood of confusion refusal, that had previously been withdrawn as to the cited registration and two other registrations. On April 17, 2012, the Examining Attorney issued a subsequent Final Office Action "based on further review and consideration" of the instant application. April 17, 2012 Final Office Action, at p. 1.

The Applicant then filed a Request for Reconsideration on October 15, 2012, in response to the April 17, 2012 Final Office Action, wherein Applicant presented additional persuasive arguments in favor of registration of its mark. However, on July 16, 2013, the Examining Attorney denied Applicant's Request for Reconsideration and the instant appeal was resumed.

B. By Initially Approving The Instant Mark For Publication, The Examining Attorney Clearly Recognized That The Current Cited Registration, And Those Registrations Previously Cited Against Applicant's Mark, Were Only Entitled To A Narrow Scope Of Protection

The Trademark Office has clearly recognized that the current cited registration, and the registrations that were previously cited against Applicant's mark that have since been cancelled, are only

entitled to a narrow scope of protection, as the Examining Attorney in the instant case approved Applicant's mark for publication on December 28, 2011, while both the CAN-AM EXOTICS (Reg. No. 3,163,329) and CAN-AM (Reg. No. 3,686,113) registrations were still active.

Further, upon information and belief, a different Examining Attorney previously registered the currently cited CAN-AM mark (Reg. No. 3,686,113) over the then-existing registrations for CAN AM (Reg. No. 2,883,129) and CAN-AM EXOTICS (Reg. No. 3,163,329), respectively. In fact, in support of obtaining its registration, the Registrant of the currently cited mark, CAN-AM (Reg. No. 3,686,113), specifically distinguished its goods from those of the cited marks, whose goods included "Automobiles and structural parts therefor". See Reg. Nos. 2,883,129 and 3,163,329.

Applicant respectfully requests that the Board take judicial notice of the prosecution history for Reg. No. 3,686,113 for CAN-AM, specifically, the cited Registrant's response to the November 25, 2005 Office Action, which was filed on December 13, 2005.

Even though later, the cited Registrant entered into a consent agreement with the registrant of the CAN AM and CAN-AM EXOTICS marks (who is the same last listed owner of both registrations), upon distinguishing its identified goods from "Automobiles and structural parts therefor", the cited Registrant narrowed the scope of protection for its mark. Therefore, the Trademark Office should not now grant the cited Registrant a greater scope of protection than what it is entitled to.

C. Applicant's And The Cited Registrant's Respective Marks, And The Goods In Connection With Which Such Marks Are Used, Are Dissimilar

Applicant's mark contains a whole word (which is arguably arbitrary and fanciful) that is not present in the cited Registrant's mark. Further, the common portion of the marks, namely, CAN AM, is hyphenated in the cited mark. Therefore, Applicant's mark and the cited mark are clearly different in appearance. Moreover, the difference in appearance also relates to the difference in sound between the marks. The sound of NUART CAN AM is very different from the sound of simply CAN-AM. Therefore, the marks are not only different in appearance, but they are also different in sound.

The marks also differ with regard to their respective connotations because, although it can be reasonably inferred that CAN AM and CAN-AM have similar or identical meanings, NUART, the word that is unique to Applicant's mark, is arguably arbitrary and fanciful in form, but also suggests something new and creative. As such, the different word in Applicant's mark renders the connotation of Applicant's mark different from the cited mark as well.

Finally, Applicant's mark has a different commercial impression than the cited mark due to the unique word at the beginning of Applicant's mark. Since consumers usually view trademarks as a whole, Applicant's NUART CAN AM mark would have a different commercial impression than the cited Registrant's CAN-AM mark. Therefore, Applicant's mark is dissimilar to the cited mark with regard to appearance, sound, connotation and commercial impression.

D. Applicant's Goods Are Targeted To Different Consumers Who Are Sophisticated, And Such Goods Are Very Expensive And Travel Through Different Channels Of Trade Than Those Of The Cited Registrant

Applicant seeks to register the mark NUART CAN AM, for use in connection with "Automobile parts, namely, automobile engine valve covers, engine parts in the nature of electronic fuel injection modules, intake manifolds, and engine management systems in the nature of electronic control modules that utilize input valves calculated from sensor devices to control the fuel mixture, amount of fuel, ignition timing, and idle speed of an internal combustion engine" and "automobiles and structural parts therefor; automobile chassis; automobile bodies".

As previously argued by Applicant, Applicant's goods consist of clean sheet prototype sports cars for racing. See Applicant's October 15, 2012 Request for Reconsideration, at pp. 10, 11. Applicant's products are marketed and sold to race car enthusiasts who are willing to spend top dollar to fulfill their passion. Applicant's automobiles are custom-made and very expensive, costing on the order of nearly $500,000 each, at a minimum. See Exhibits H and I to October 15, 2012 Request For Reconsideration, at pp. 2 and 2, respectively.

On the other hand, Reg. No. 3,686,113 is for the mark CAN-AM, for use in connection with, among other goods and services in many different classes, "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 cited Registrant's goods are marketed to recreational vehicle purchasers, not race car drivers. Further, as highlighted by Applicant, goods bearing the cited Registrant's mark sell for as little as $6,799. Applicant's October 15, 2012 Request for Reconsideration, at p. 15 and Exhibit J, at p. 5.

Therefore, Applicant's goods, which are targeted to different consumers who are sophisticated, are very expensive, and travel in different channels of trade than those of the cited Registrant.

IV. ARGUMENT

Applicant respectfully submits that in maintaining the Section 2(d) refusal, even after initially withdrawing such refusal and approving Applicant's mark for publication, the Examining Attorney has taken an unduly narrow and improper view with respect to the differences in the appearance, sound, connotation and commercial impression of Applicant's and the cited Registrant's respective marks; the dissimilarity in the goods in connection with Applicant's and the cited Registrant's respective marks; and the channels of trade through which Applicant's and the cited Registrant's respective goods travel. Additionally, Applicant respectfully submits that the Examining Attorney has failed to give proper weight to the cost, both relatively speaking and absolute, of the respective goods and the sophistication of their respective consumers.

The test for likelihood of confusion is whether the respective marks create the same overall impression. *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The factors bearing on the existence or non-existence of a likelihood of confusion include: (1) The similarity or dissimilarity of the marks, in their entireties, as to appearance, sound, connotation, and commercial impression; (2) The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in

connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; (5) The fame of the prior mark; (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; (8) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion; (9) The variety of goods on which a mark is or is not used; (10) The market interface between the applicant and the owner of a prior mark; (11) The extent to which applicant has a right to exclude others from use of its mark on its goods; (12) The extent of potential confusion, i.e., whether *de minimis* or substantial; and (13) Any other established fact probative of the effect of use. *In re E.I. du Pont de Nemours & Co*., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973); s*ee also In re Majestic Distilling Co., Inc*., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re The W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007); s*ee also In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Not all of the *du Pont* factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case.' *Dixie Rests., Inc.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533, citing *du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567. Even if the marks are virtually identical in sight and sound (and here, they are not), the lack of relatedness of the goods, customers, and channels of trade, alone, may be sufficiently different to find no likelihood of confusion. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F. 3d 1378, 78 USPQ 2d 1944 (Fed. Cir. 2006) (no likelihood of confusion where identical marks used to brand software products in different channels of trade).

When consumers exercise heightened care in evaluating the relevant products before making purchasing decisions, courts have found confusion unlikely, regardless of the similarity of the marks. Further, where the relevant products are expensive, or the class of buyers consists of sophisticated or

professional purchasers, courts have generally not found Lanham Act violations. *Checkpoint Sys. Inc. v. Check Point Software Tech. Inc*., 269 F. 3d 270, 60 USPQ2d 1609 (3d Cir. 2001) (identical mark for physical asset security products and computer network security products: confusion not likely or *de minimis*). '[I]n a market with extremely sophisticated buyers, the likelihood of consumer confusion cannot be presumed on the basis of the similarity in trade name alone.' *Id*. at 1617, quoting *Perini Corp. v. Perini Constr., Inc.,* 915 F. 2d 121, 128, 16 USPQ2d 1289 (4th Cir. 1990).

Here, not only is Applicant's mark dissimilar to the cited Registrant's mark, but also Applicant's goods are very expensive and highly distinguishable from the cited Registrant's goods, and are sold to sophisticated professional buyers in the sports car racing industry, who are not likely to be confused as to the sources of the goods bearing Applicant's or the cited Registrant's mark. Similarly, the cited Registrant's class of consumers appears to be recreational vehicle enthusiasts and those seeking rugged outdoor experiences. Such a consumer is unlikely to mistake the source of a $7,000 all terrain vehicle with the source of a $500,000 racing car. Each respective purchaser is sophisticated with respect to its own area of interest. In this case, since participation in the racing industry is very expensive as a whole, it attracts not only sophisticated purchasers, but wealthy purchasers and their agents, who likely have specialized training in the area of racing vehicles and do not make such purchasing decisions without conducting considerable research.

Therefore, Applicant respectfully submits that there is no likelihood of confusion between its mark and the cited Registrant's mark in light of the most relevant *du Pont* factors to the instant case, namely, the similarity of the marks, similarity of the goods, channels of trade and sophistication of the purchasers. Further, the relatively common use of the CAN-AM mark in connection with vehicles of all types, in light of the origin of the word, also renders the cited Registrant's mark entitled to a narrow scope of protection.

A. The Cited Registrant's Mark Is Only Entitled To A Narrow Scope Of Protection

During the prosecution of its application to register the CAN-AM mark, the cited Registrant responded to the Examining Attorney's § 2(d) likelihood of confusion refusal by emphasizing the differences between its goods and the goods recited in Reg. No. 2,883,129 (now cancelled, but previously cited against the instant application as well), namely, that "[n]one of the Applicant's [now Registrant's] goods and services is directed to automobiles." Applicant's (now Registrant's) Response to Office Action, at pp. 1-2.

The cited Registrant then proceeded to distinguish its channels of trade and goods from those in connection with the marks cited against its application. Although the cited Registrant eventually entered into a Consent Agreement with the registrant cited against its mark, it is still important to note that the Examining Attorney in the instant matter initially recognized the narrow scope of protection to which that and the other marks were entitled in approving the instant mark for publication.

Therefore, Applicant respectfully submits that the cited Registrant should not now be provided with a greater scope of protection than it deserves. Therefore, given that the cited Registrant distinguished its goods from "Automobiles and structural parts therefor" in its effort to obtain its registration, such distinction should still be applicable with regard to Applicant's identified goods.

B. Applicant's Mark Is Not Confusingly Similar To The Cited Registrant's Mark Because Applicant's Mark Is Dissimilar From The Prior Marks With Regard To Appearance, Sound, Connotation And Commercial Impression

A mark is confusingly similar to another mark if, among other things, there is a similarity in sight, sound, meaning or connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

Here, in the first instance, Applicant's mark contains an arbitrary word that the cited registration does not have, NUART, which was registered by the Trademark Office on July 16, 2013. See U.S. Registration No. 4,368,899. Additionally, with regard to the word that Applicant's mark has in common with the cited registration, Applicant's mark lacks the hyphen between the words CAN and AM contained

in the cited registration. Therefore, there are at least two major differences between the appearance of Applicant's mark and that of the cited registration, in addition to the fact that the additional word in Applicant's mark, NUART, is at the beginning of Applicant's NUART CAN AM mark. Consumers are more likely to view the first part of a mark as being the dominant portion of the mark. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895 (TTAB 1988) (KID-WIPES held confusingly similar to KID STUFF both for baby wipes); *also see Palm Bay Imps., Inc. v. Veuve ClicquotPonsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (VEUVE was found to be a prominent feature of the mark VEUVE CLICQUOT because it is the first word in the mark and the first word to appear on the wine label).

Further, Applicant's mark does not sound like the two cited registration, mainly because of the additional word NUART that is present in Applicant's mark, but is lacking from the cited registration.

Moreover, the additional word in Applicant's mark causes it to have a different connotation or meaning than the cited registration. Finally, Applicant's mark does not have the same commercial impression as the cited registration due to the additional and different word in Applicant's mark, which word has a commercial impression of its own, as evidenced by the Trademark Office's issuance of a Certificate of Registration for the NUART mark.

As such, in light of Applicant's persuasive argument that its applied-for mark is dissimilar to the cited prior registration, with regard to its appearance, sound, connotation and commercial impression, and therefore, does not create a likelihood of confusion for consumers, Applicant respectfully submits that the NUART CAN AM mark is eligible to pass to publication and registration.

1. Applicant's Mark Has A Different Appearance Than The Cited Mark

It is well-established that "[t]he test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services." TMEP § 1207.01(b); *see*

In re Iolo Techs., LLC, 95 U.S.P.Q.2d 1498, 1499 (TTAB 2010). It is also true that a comparison of the marks in question must take into account '[a]ll relevant facts pertaining to appearance, sound, and connotation . . . before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.' TMEP § 1207.01(b); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000). Further, "on the issue of trade-mark infringement words are not to be compared syllable by syllable, vowel by vowel and consonant by consonant. Instead they are to be compared as ordinary purchasers of [the goods] would compare them, that is, on the basis of similarities in their general appearance both in construction and in over-all impression on the eye." *Coca-Cola Co. v. Snow Crest Beverages*, 162 F.2d 280, 283-84, 73 U.S.P.Q. 518 (1st Cir. 1947) (affirming the trial court's decision that the POLAR COLA mark did not infringe the COCA-COLA mark on the basis of likelihood of confusion).

Here, the mere fact that both marks contain the words "CAN AM" does not in and of itself render the marks similar enough to rise to the level of being confusingly similar, especially insofar as there are many marks in existence that contain identical wording to other marks, but were registered nonetheless and co-exist in the marketplace without confusion. There are also many third party uses of CAN AM, given its common nature with regard to motorized vehicles.

Further, the Examining Attorney asserted that Applicant's mark and the cited registration contain identical wording, however Applicant still maintains that the wording that the marks have in common, CAN AM, is not a significant part of its mark. In fact, CAN AM is commonly used in connection with motorized vehicles. See Exhibit L to Applicant's October 15, 2012 Request for Reconsideration.

By way of example, unlike the small difference of one letter (the letter "y" versus the letter "d") between the marks at issue in *In re Digirad Corp.*, "ray" as compared to "rad", here, Applicant's NUART before the words CAN AM, as compared to the cited registrant's CAN-AM mark alone differ greatly from one another visually, as well as with regard to their sound. *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841 (TTAB 1998). There, as is requested here, the Board found that there was no likelihood of confusion, not

only due to the differences in appearance, sound, meaning and commercial impression of the marks at issue, but also because the goods sold by the registrant and the applicant were very different.

Moreover, there is a difference in punctuation between the marks. Applicant's mark does not contain any punctuation, whereas the "identical wording" noted by the Examiner, CAN-AM, does contain punctuation in the cited registration, specifically, a hyphen between CAN and AM. A difference in punctuation amounts to an additional difference between the allegedly common portion of Applicant's mark and the cited mark.

Even more important than the difference in punctuation between the marks is the fact that Applicant's mark contains an entirely different word than the cited mark, NUART, which word is inherently distinctive as evidenced by the Trademark Office's recent issuance of a Certificate of Registration for the NUART mark.

Therefore, Applicant respectfully submits that its NUART CAN AM mark does not look like the cited registration and should not be denied registration on that basis.

2. Applicant's Mark Does Not Sound Like The Cited Mark

For reasons akin to why Applicant's mark does not look like the cited mark, Applicant's mark does not sound like the cited mark either. Although the marks have the wording CAN AM in common (aside from the difference in punctuation referenced above), CAN AM is not a dominant part of Applicant's mark, NUART is.

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. Nevertheless, Applicant respectfully disagrees with the statement that CAN AM is the dominant portion of Applicant's NUART CAN AM mark.

Further, Applicant also respectfully disagrees with the Examining Attorney's statement that "In creating its mark, the applicant has merely added the term 'NUART' to the registrants' respective marks."

April 17, 2012 Final Office Action, at p. 3. Applicant believes that this basic generalization made by the Examining Attorney is simply incorrect.

Marks must be compared in their entireties and in connection with the particular goods or services for which they are used. TMEP § 1207.01(b); *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985). The determination that there is a likelihood of confusion cannot be made based upon the dissection of only part of a mark. *Id*. Instead, the ultimate conclusion that a mark is likely to confuse should rest on the mark in its entirety, although more or less weight can be placed on a particular feature of a mark. *Id*.

Here, the additional word NUART precedes the words CAN AM, which Applicant's mark allegedly has in common with the cited mark. This fact alone further evidences the fact that the marks do not sound the same.

As such, Applicant respectfully submits that its mark does not sound like the cited registration and should not be denied registration on that basis.

3. Applicant's Mark Does Not Have The Same Connotation Or Exude The Same Commercial Impression As The Cited Mark

The connotation of a mark is determined by its relationship to the goods or services in connection with which it is used. TMEP § 1207.01(b)(v). Typically, "[t]he focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks." *Id*. (citations omitted).

There are many examples of marks that are more similar in appearance and sound than Applicant's mark and the cited mark that were not found to be confusingly similar. For example, GREEN LEAF and BLACK LEAF were not found to be confusingly similar although the two marks only had one word difference (a suggestive color word) and the marks were both for plant and garden sprays. *See Smith v. Tobacco By-Products & Chem. Corp.*, 243 F.2d 188, 113 U.S.P.Q. 339 (C.C.P.A. 1957). In that case, it was found that "the word 'Leaf,' as applied to a plant spray is not arbitrary, but is definitely

suggestive of the use to which the product is to be put." *Id*. at 340. Similarly, HEALTHY CHOICE and HEALTH SELECTIONS, both marks for food products bearing only slight differences between the marks, but with the same basic connotation, were also found not to be confusingly similar. *See ConAgra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368, 26 U.S.P.Q.2d 1316 (8th Cir. 1993). The Eighth Circuit has also found no likelihood of confusion where identical words were used for closely related goods and services. *Id*., at 1318, citing *Comidas Exquisitos, Inc. v. O'Malley & McGee's Inc.*, 775 F.2d 260, 227 U.S.P.Q. 811 (8th Cir. 1985) (Carlos McGee's and Carlos McGee's for restaurants not likely to cause public confusion due to their distinct geographic markets and lack of intention to expand into the market of the other respective mark holder)).

In the instant case, the CAN AM portion of the mark at issue, NUART CAN AM, is suggestive of the sport of car racing. To wit, Can-Am was the name of a sports car racing series that existed from 1966 to 1986. See Exhibit F to Applicant's October 15, 2012 Request for Reconsideration. Applicant intends to use the NUART CAN AM mark in connection with automobiles and structural parts therefor; automobile chassis; and automobile bodies, in addition to automobile related goods in Class 12, as stated in its application for registration. A reasonable consumer would perceive the mark NUART CAN AM to mean that the goods and/or services offered under the mark consist of innovative design or creation, and suggests a particular type of race car based upon a clean sheet design or the creation of an automobile product not derived from anything else. This strongly suggestive reference in the mind of an ordinary consumer makes the important difference between a mark that is likely to confuse and one that is not.

Here, Applicant respectfully submits that NUART, the differing portion of its mark from the cited registration, places its mark in condition to be allowed because it enables the ordinary consumer to differentiate its mark from the cited registration.

Therefore, Applicant respectfully disagrees that the addition of NUART to the wording CAN AM does not distinguish it from the cited mark. In fact, NUART is uniquely associated with Applicant's products and services and is the dominant portion of its mark, not CAN AM, thereby exuding a different connotation and a different overall impression than the cited mark.

C. **Applicant's Goods Are Not Related To The Cited Registrant's Goods Nor Do They Originate From The Same Sources**

Applicant's goods and those of the cited registrant are not identical (nor are they related), do not overlap, and are not derived from identical sources. In fact, Applicant's goods are markedly distinguishable from the cited Registrant's goods, making it unlikely that a consumer would be confused by Applicant's use of the NUART CAN AM mark in connection with its goods, namely, race cars and their parts.

Generally, goods or services are seen as related or similar where they are interchangeable for all significant uses. *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 U.S.P.Q. 969 (2d Cir. 1981) (holding BRAVO'S crackers unrelated to BRAVOS tortilla chips). In evaluating the goods in connection with the respective marks, the analysis requires focus on the goods in connection with which the marks are used, and their functions. *Checkpoint*, 269 F.3d at 288. Where, as here, the marks are used in different industries, for different goods (race cars versus all terrain vehicles) and are for different purposes (competitive racing versus recreation), there is no overlap, and consumers are not likely to be confused. *Id*.

Further, Applicant's goods and the goods identified in the cited registration are different and non-competitive, as their application and utility serve different objectives. *Colgate Palmolive Co. v. Carter Wallace Prods., Inc.*, 167 USPQ 529 (CCPA 1970) (toothpaste and deodorant are not sufficiently related). Although the Examining Attorney provided examples from the Internet of outlets selling both traditional automobiles and recreational vehicles, Applicant respectfully submits that its automobiles, namely, race cars, are not sold in traditional dealerships and are in fact custom-made, making confusion with any products sold by the cited Registrant highly unlikely.

Moreover, where the parties serve different markets, confusion is also unlikely. *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944 (Fed. Cir. 2006) (virtually identical M2 marks, use of identical media, but service of different software users, is sufficient to dismiss section

2(d) opposition); *Beneficial Corp. v. Beneficial Capital Corp.*, 213 USPQ 1091, 1095 (S.D.N.Y. 1982) (consumer loans and business loans deemed not related).

Similarly, if the goods provided by each party would "appeal to different customers, are sold in entirely different markets, and exist for distinct purposes", they are not proximate for the purposes of evaluating the likelihood of confusion. *Id.*, at 1095, quoting *Clearinghouse, Inc. v. Find Magazine*, 492 F.Supp. 147, 209 USPQ 936, 940 (S.D.N.Y. 1980); *also see In re The W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007) (marks virtually identical and goods related only because they were for repairing surfaces, albeit different types of surfaces, therefore, section 2(d) refusal to register was reversed).

The same is true in the instant matter. Applicant intends to use the mark in question in connection with clean sheet prototype sports cars for racing series. In contrast, the cited Registrant uses its mark in connection with all-terrain vehicles and motorcycles, which are extremely different from sports cars for racing series. Therefore, not only does the disparity in the types of goods offered in connection with the respective marks make it highly unlikely that consumers would be confused as to their source, but also, Applicant's and the cited Registrant's trade channels are clearly dissimilar due to the marked difference in products, and so are their intended purchasers dissimilar.

Although Applicant acknowledges the Examiner's inclusion of examples of automobile manufacturers that make and sell a variety of vehicles, including passenger automobiles, all-terrain vehicles, motorcycles, etc., Applicant respectfully submits that because its automobiles are highly specialized, very expensive, and custom-made especially for racing, its goods and those of the cited Registrant are not likely to travel through the same trade channels.

Further, the registration of a mark for use in connection with a variety of goods in a particular class of goods is not an indication that all goods in a particular class will be targeted toward the same class of consumers. Therefore, the Examiner's attachments to the April 17, 2012 Final Office Action and the July 16, 2013 Reconsideration Letter respectfully are not probative of the fact that Applicant's use of the NUART CAN AM mark in connection with sports cars for racing series is closely related to the cited Registrant's use of the CAN-AM mark in connection with all-terrain vehicles and motorcycles.

As such, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register Applicant's mark, under Section 2(d), on the basis that Applicant's goods are not related, and are especially not closely related, to the cited Registrant's goods.

D. Applicant's And The Cited Registrant's Respective Purchasers Are Unlikely To Mistakenly Purchase The Wrong Product Because Of The Differences In The Channels Of Trade, High Cost Of The Goods Involved, And The Sophistication Of The Relevant Consumers

As discussed in the preceding sections, the nature of the goods and the potential customers for Applicant's goods and those of the cited Registrant are very different. Applicant's very expensive and high tech race cars will be sought after by and sold to wealthy, knowledgeable and experienced buyers, not everyday customers interested in a low-cost recreational vehicle. Therefore, because of the nature of the respective goods, they would be offered to different classes of purchasers through different channels of trade. As such, it is unlikely that there would be any opportunity for confusion to occur. *See In re The W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007) (Section 2(d) refusal reversed).

Further, even if the argument is made that there is 'marginal customer overlap', which Applicant contends there is not, 'this overlap is inconsequential in view of the complexity and cost of goods and the buyers' sophistication.' *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841, 1842 (TTAB 1998).

Moreover, it is well-established that "there is always less likelihood of confusion where goods are expensive and purchased after careful consideration." *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786, 790 (1st Cir. 1983). A similar finding was made in *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, where the court found no likelihood of confusion due to 'differences in the relevant purchasers and trade channels, the sophistication of the relevant purchasers, and the care with which both parties' goods are purchased.' *In re Digirad Corp.*, 45 U.S.P.Q.2d at 1844, quoting *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (Fed Cir. 1992).

Finally, even if the argument is made that the relevant purchasers of Applicant's intended goods and the cited registrant's goods are the same (which they clearly are not), it is well-settled that the sophistication of those purchasers is often dispositive because "sophisticated consumers may be expected to exercise greater care." *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 21 U.S.P.Q.2d at 1392. Even where the type of goods sold by mark holders is very similar (unlike the instant case), a significant difference in price can be enough to dispel the possibility of consumer confusion. *See* 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:97 (4th ed. 2008), citing *AM Gen. Corp. v. Daimler Chrysler Corp.*, 311 F.3d 796, 65 U.S.P.Q.2d 1001 (7th Cir. 2002) (purchasers of expensive HUMMER sports utility vehicles selling for more than $50,000 were found unlikely to be confused by a grille design similar to that used in plaintiff's JEEP vehicles).

Therefore, Applicant respectfully submits that the relevant purchasers of goods under the Applicant's NUART CAN AM mark are very sophisticated purchasers, who are race car enthusiasts that would spend hundreds of thousands of dollars to buy an automobile bearing Applicant's mark. *See* Applicant's October 15, 2012 Request for Reconsideration, Exhibit H, at p. 2; *also see* Exhibit I, at p. 2. On the other hand, goods in Class 12 bearing the cited Registrant's CAN-AM mark appear to retail starting at under $10,000. *Id.*, at Exhibit J.

Hence, Applicant believes that the marked disparity between the relative purchase prices of Applicant's and the cited Registrant's goods combined with the extremely high cost of goods bearing Applicant's mark, attracting only highly sophisticated purchasers, is great enough to avoid a likelihood of confusion between the respective marks. As such, Applicant requests that the Board reverse the Examiner's refusal to register Applicant's mark.

E. <u>The Number and Nature of Similar Marks In Use On Similar Goods Weighs Against A Likelihood Of Confusion Between Applicant's And The Cited Registrant's Respective Marks</u>

Where it can be established that "the consuming public is exposed to third-party use of similar marks on similar goods, it 'is relevant to show that a mark is relatively weak and entitled to only a narrow

scope of protection.'" TMEP § 1207.01(d)(iii), quoting *Palm Bay Imps., Inc. v. Veuve ClicquotPonsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005).

It holds that where similar marks are used by multiple sources in the same field, the scope of protection afforded to each mark is correspondingly narrowed. *See Data Concepts Inc. v. Digital Consulting Inc.*, 4 U.S.P.Q.2d 1672, 1676 (6th Cir. 1998); *see also Amstar Corp. v. Domino's Pizza, Inc.*, 205 U.S.P.Q. 969, 975 (5th Cir. 1980). Thus, the existence of multiple similar marks where related goods are involved indicates that the consuming public is accustomed to distinguishing between the marks and are capable of doing so, without a likelihood of confusion. *See Gen. Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987).

A Google® search for the terms "CAN AM" and "automobile" returned 3,180,000 results. The first 50 results were attached to Applicant's October 15, 2012 Request for Reconsideration as Exhibit L. Notably, the first result, a YouTube® video featuring a "Rare 1977 Pontiac Lemans Can Am – 6.6V8 Muscle Car", is but one example of the common nature of the words CAN AM for use in connection with automobiles given the history of the words, as the words CAN AM, whether depicted with or without a hyphen, have long been associated with the sport of car racing and the vehicles associated therewith. *Id.*, at Exhibit F.

Therefore, since consumers can reasonably be said to be accustomed to distinguishing between the various uses of CAN-AM when it comes to motorized vehicles, including automobiles, Applicant submits that the cited Registrant's mark is entitled to only a narrow scope of protection and should not bar registration of Applicant's mark.

V. SUMMARY

Applicant seeks to register its mark, NUART CAN AM, for use in connection with, inter alia, automobiles and structural parts therefor, automobile chassis and automobile bodies, that are marketed to sophisticated customers who are race car enthusiasts, owners and drivers. Applicant's automobiles start at a price of $485,000. Applicant's mark has been previously approved for publication.

The cited Registrant's mark is CAN-AM, in connection with all terrain vehicles and motorcycles. The cited Registrant's vehicles cost between $6,799.00 and $30,000.

Notwithstanding the differences in the appearance, sound, meaning and commercial impression of the respective marks, Applicant's and the cited Registrant's goods are markedly distinct from one another and are marketed to entirely different classes of purchasers who are sophisticated and not likely to be confused as to source. Moreover, the expense of Applicant's goods clearly indicates that the consumers of such goods are sophisticated and knowledgeable.

Therefore, Applicant respectfully submits that the Section 2(d) refusal to register Applicant's NUART CAN AM mark should be reversed and the instant application should be allowed.

DATED: September 23, 2013

Respectfully submitted,

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