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

Proceeding	85306954
Applicant	KSM Castings Group GMBH
Applied for Mark	CVC
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In re Application of: )

KSM CASTINGS GROUP GMBH )

Serial No.: 85/306954 )

Filed: April 28, 2011 )

Trademark: CVC )

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Law Office 103

Trademark Attorney:

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**Applicant's Appeal Brief**

*Introduction*

Pursuant to a Notice of Appeal filed on July 24, 2013, Applicant has appealed the examiner's final refusal of the mark CVC in class 12 only (other classes have been allowed) on the basis that there is a likelihood of confusion with Registration Number 2148579 for the mark CVCC, which is owned by Honda Motor Company, Ltd.

*Relevant Facts*

Applicant's latest identification of goods in class 12 reads as follows:

Transmission parts for land vehicles, namely, disk carriers; transmission housings for land vehicles; body parts for land vehicles, namely, connecting elements, nodes of die-cast aluminium, and cast comers; wheel-guiding components for vehicles, namely, hub carriers and transverse links, auxiliary frames for connecting body and chassis, steering housings, die-cast components, namely, vacuum die cast components for vehicle parts; die cast components, namely, vacuum die cast components of light metal in combination with steel, rubber and plastic, namely, vehicle chassis and parts thereof; die cast components, namely, vacuum die cast components of light metal in combination with steel, rubber and plastic as machine housings for land vehicles; housings for machines; vehicle brakes; housings for parts of land vehicles, except engines; transmissions for land vehicles; clutches for land vehicles; knuckles for land vehicles; land vehicle brakes; chassis for motor vehicle; torque converters and parts thereof for land vehicles; shifting clutches and parts thereof for land vehicles; driving mechanism and parts thereof for land vehicles; clutches and parts thereof for land vehicles; connecting rods for land vehicles except engine parts; wheel axles; drive shafts for land vehicles; wheel suspension systems comprised of axles, axle mountings and individual parts thereof; shaft mountings for vehicles and parts therefor; rubber metal parts, namely, shock absorbers as vehicle parts

for insulation of mechanical vibration; joints and individual parts thereof, namely, ball joints for vehicles; universal joints and individual parts thereof for vehicles; cardan joints and individual parts thereof for vehicles. steering wheels and individual parts thereof for vehicles; steering columns and individual parts thereof for vehicles, cardan shafts for vehicles; steering gears and individual parts thereof for vehicles; oil containers as parts of motor vehicles and individual parts thereof; airbag housings for vehicles and individual parts thereof; safety belts and individual parts thereof; hub carriers, brake disks, pedals, and fuel containers for vehicles; apparatus for force transmission for motor vehicles; parts for motor vehicle, namely, connecting struts, suspension links, trailing arms, transverse links, semi-tailing links, wishbones, four-point links, multiple links, supporting links, guide links, spring links, trapezoidal links, track rods and stabilizers; *body and structural parts for vehicles, namely, pillars, door impact supports, floor groups, tunnels, sills, roof frames, instrument panel supports and deformable steering protection tubes, not as parts of engines*; cross and longitudinal members as parts of the vehicle body, namely, for the reinforcement thereof and protection from impact and rollover; body parts, namely, door inner panels, mudguards, bonnets, knuckles, front axles, rear axles, twist beam axles for motor vehicles; bumper systems for motor vehicles comprising bumper cross members, crashboxes and flange plates and parts thereof; bumpers for motor vehicles; chassis and wheel suspensions for vehicles and parts thereof, namely rear axle carriers, front axle carriers, auxiliary frames and cross members, in particular integral die-cast carriers; axle carriers and engine bearers, axle mounts, knuckles and pivot bearings for vehicles; slider housings as a transmission part for vehicles. bearing frames for machines and bearing frames for engines, not as parts of engines; and foot-lever bearing mounts for use as part of pedal systems for vehicles; all such above-mentioned goods not for use in rolling mills or as part of rolling mills

(Note: The language above in *italics* was focused on by the examiner when issuing a final refusal, while the underlined language was added in Applicant's Request for Reconsideration, a submission upon which the examiner has not ruled.)

The goods in the cited registration for the mark CVCC read as follows:

structural parts and engines for automobiles

The record consists of copies of print-outs related to Honda Motor Company's products which are attached to various Responses and Requests for Reconsideration filed by Applicant on February 9, 2012, December 24, 2012, and July 24, 2013.

#### *Applicant's argument*

Applicant respectfully disagrees with the examiner's refusal to register for the following reasons:

- 1) The marks are distinguishable.
- 2) The goods are distinguishable.

3) Due to differences in the marks and goods, Applicant will continue to use its mark, and the federal register should reflect that use.

#### 1) The Marks Are Distinguishable

The examiner argues that the marks CVCC and CVC are almost identical because Registrant's mark only contains an extra "C" at the end. However, this analysis ignores the different pronunciations, appearances and connotations of each mark.

Initially, the trademark CVCC would be pronounced /si:/ - /vi:/ - /si:/ - /si:/, while Applicant's trade mark would be pronounced /si:/ - /vi:/ - /si:/. This is a noticeable difference in pronunciation. Similarly, the marks also have different visual appearances, with the Registrant's mark having four letters compared to three letters in Applicant's mark (meaning that Registrant's mark is 33% longer than Applicant's mark). If this Board was comparing word marks, then the addition of one letter or different word lengths might not be as significant (for example, there is little difference in a trademark sense between the hypothetical mark CAT and CATS). However, where marks consist entirely of letters, and there is no immediate verbal impression created, then the overall look and sound of marks take on greater significance. See B.V.D. Licensing Corp. v. Body Action Design, 6 USPQ2d 1719 Fed. Cir. 1988), where no likelihood of confusion was found between the marks B.V.D. and B.A.D., even though B.V.D. was considered a well-known mark entitled to a broad scope of protection (which Honda's mark CVC is not), and the letter "V" resembled the basic shape of the "A" turned upside down. The reasoning in that case was that consumers scrutinize and readily discern differences in letters.

In addition, the connotation created by CVCC must be analyzed in relation to the goods upon which the mark is used. The CVCC mark (Registration Number 2,148,579) is for use on "structural parts and engines for automobiles." The registration is owned by Honda, and as shown by evidence submitted during examination of this application, as well as in specimens of use Honda has submitted to the PTO over the years, the engines are for use in Honda automobiles, specifically the Honda Civic. As Applicant argued to the examiner, "CVCC" is an acronym used by Honda for "Compound Vortex Controlled Combustion." The "C" (Compound) represents the engine mechanism with two combustion chambers: main and auxiliary. The "V" (Vortex) represents the vortex, or swirl, generated in the main chamber. The vortex, caused by a jet of flame from the pre-chamber injected via a nozzle, has the effect of increasing the speed of engine combustion. The "CC" (Controlled Combustion) represents the engine's ability to properly control the speed of combustion.

The CVCC is a specific type of engine designed by Honda in 1974/1975 in its Honda Civic in response to the 1970 U.S. Clean Air Act. Most automobile manufacturers believed at the time that it would not be possible to meet the standards of the act. However, Honda was able to develop the CVCC engine which met the 1975 emissions standards.

The significance of this evidence is that relevant consumers would recognize CVCC as an acronym for a specific Honda product used for Honda Civic automobiles. CVCC has a very specialized meaning in relation to these specific goods. There is no evidence that CVC would

create a similar impression among consumers. On the contrary, CVC specifically is not used in connection with “engines” (see Applicant’s exclusions throughout its identification of goods, including the latest amendment to that description which specifically restricts its “structural and body parts for vehicles” with the language “not as parts for engines.”)

There are many cases where slight variations in marks have created different meanings, and no likelihood of confusion was found to exist. In Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641 (CCPA 1982), the Court held that a one letter difference between "BOSTON SEA PARTY" and "BOSTON TEA PARTY" was enough to negate confusion because the marks had distinct meanings. The same is true with CVCC vs. CVC: the marks create different connotations.

In a decision by this Board, no likelihood of confusion was found between "PAYOT" and "PEYOTE" because despite a difference in only two letters, and a similarity in appearance and sound, the word had different meanings. One was an English word, the other a surname. One was familiar, the other was unfamiliar. Payot v. Southwestern Classics, 3 USPQ2d 1601 (TTAB 1987). Also see In re Champion Oil Co., 1 USPQ2d 1920 (TTAB 1986) ("TOP FORMULA 16" V. "FORMULA 1"). In this case, the CVCC mark is a recognized acronym whereas Applicant’s mark has no such meaning or significance.

Finally, there is much case law involving marks that were almost identical in a literal sense, but because of a difference in overall images conjured up by the marks, no likelihood of confusion was found. See In re Best Products Company, Inc., 231 USPQ 988 (TTAB 1986) ("JEWELERS' BEST" v. "BEST JEWELRY"); Bank of America National Trust and Savings Association v. American National Bank of St. Joseph, 201 1 USPQ 942 (TTAB 1978) ("BANKAMERICA" v. "AMERIBANC"); and Carlisle Chemical Works, Inc. v. Hardman and Holden Ltd., 434 F.2d 1403, 168 USPQ 110 (CCPA 1970) ("COZIRC" v. "ZIRCO").

In short, the marks CVC and the CVCC are visually, phonetically and connotatively distinguishable. Moreover, consumers would be likely to notice these differences because purchases of auto parts and engines are sophisticated in their fields, and would take care in making purchases. These types of consumers would not easily confuse CVCC and CVC.

## 2.. Goods Are Distinguishable

The examiner argues that the goods of the parties are related since the Registrant’s goods are “structural parts and engines for automobiles” and Applicant provides “body and structural parts for vehicles.” Applicant disagrees for several reasons:

a) As mentioned above, the description of Applicant’s “body and structural parts for vehicles” now expressly excludes “engines.”

b) Based on the evidence submitted during examination and discussed above, which is confirmed by specimens submitted by Registrant in obtaining and maintaining its registration, the

mark CVCC only is used in connection with a CVCC engine which has a specific function and purpose in Honda Vehicles (again, CVCC is an acronym used by Honda Motor Company for an engine with reduced automotive emissions, and stands for “Compound Vortex Controlled Combustion.”)

c) Purchasers of Applicant’s products and Honda’s engines are not the same. Applicant only provides individual *components* or complete assemblies of *parts* to manufacturers. Therefore, Applicant is part of a supply chain, *and* specifically does not sell engines. Contrasted against that type of product is Honda’s CVCC engine used specifically in the Honda Civic. There is no evidence that sellers of the Honda engine are likely to sell components or parts under its CVCC mark. Therefore, no consumer is likely to be confused.

In short, the goods should not be considered “commercially related” just because they relate to “vehicles” in general. Instead, the Examiner must explain in more detail why relevant consumers of these products are likely to be confused. Merely having something superficial to do with the same subject matter (*e.g.*, vehicles) is not a sufficient basis for an Examiner to refuse registration. This is particularly true when relevant consumers are sophisticated in their field. Examples abound in many areas:

1) No likelihood of confusion was found between the marks PURITAN for laundry and dry cleaning services and PURITAN for commercial dry cleaning machine filters. In re Shipp, 4 USPQ2d 1174 (TTAB 1987). The following reasons were given by the TTAB:

1. The services were offered to the general public, while the goods were used by owners or operators of the business establishments.
2. The goods were not ordinarily sold to the general public.
3. It was unlikely that customers of the cleaning business would come in contact with the goods used by those businesses.
4. The only class of purchaser who would encounter both the services and the goods were dry cleaning professionals who were aware of practices in the trade.

2) In the case In re American Olean Tile Co., Inc., 1 USPQ2d 1823 (TTAB 1986), the Trademark Trial and Appeal Board found that there was no likelihood of confusion between ceramic tile and wood doors for exterior and interior use. Despite the fact that both these materials could be used during construction of a building, they were products that were so dissimilar that they were not considered commercially related.

3) In the case In re W.W. Henry Co., 82 USPQ2d 1213 (TTAB 2007), the Trademark Trial and Appeal Board held that Applicant’s PATCH & GO mark used in connection with a cement-based product used in repairing or smoothing wall and floor surfaces is not likely to cause confusion with the Registrant’s PATCH ‘N GO mark used in connection with chemical filler preparations used in cosmetic repair of polyolefin surfaces. Even though the marks are

virtually identical, Applicant's product is of a type offered to do-it-yourselfers and contractors through home improvement hardware stores, and the Registrant's products are purchased by plastics manufacturers.

4) No likelihood of confusion was found between the marks DIAMOND ESSENCE for jewelry and ESSENCE for a magazine advertising jewelry. Essence Communications, Inc. v. Singh Industries, Inc., 10 USPQ2d 1036 (S.D.N.Y. 1988).

5) In Glen Raven Cotton Mills, Inc. v. Jayvee Brand, Inc., 165 USPQ 791 (TTAB 1970), a distinction was drawn between products that seemed at first glance to be commercially related. The mark CANDEE CANE was used in connection with infant's garments. The mark CANDY CANE was used for a variety of fabrics sold in the piece for fabrication into upholstery fabrics, awnings, draperies, wearing apparel and various accessories. Although cases have held that fabrics and clothing items are related, in this case, the TTAB found no likelihood of confusion because the fabrics were not the type used in the manufacture of infant's garments.

6) No likelihood of confusion was found between the marks ONE FAB FIT for use on women's undergarments and ONE TRUE FIT for use on clothing including jeans, pants, shirts and skirts. H.D. Lee Co. v. Maidenform Inc., 87 USPQ2d 1715 (TTAB 2008). The Board determined that the fact that the parties' products are sold in different sections of department stores underscores their differences, even though the goods were sold to the same consumers.

7) No likelihood of confusion was found between the ASTRA mark for use on pharmaceutical preparations and syringes and the ASTRA mark for use on blood analysis machines. Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 220 USPQ 786 (1<sup>st</sup> Cir. 1983). Specifically, the Court noted that "[t]he 'hospital community' is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties' respective products." Astra Pharmaceutical Products, Inc., 220 USPQ at 791. This decision was later cited in Hewlett-Packard Co. v. Human Performance Measurement Inc. in which the Board determined that "the fact that both parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely." Hewlett-Packard Co. v. Human Performance Measurement Inc., 23 USPQ2d 1390, 1395 (TTAB 1991)(holding that there was no likelihood of confusion between HPM + Design for medical instruments for clinical measurement of human performance functions and HP + Design for use on a wide variety of medical and computer equipment).

9) No likelihood of confusion was found between the M2 mark for use on CD-ROMS for healthcare and the M2 COMMUNICATIONS mark for use on CD-ROMS for film and music. M2 Software Inc. v. M2 Communications, Inc., 78 USPQ2d 1944 (CAFC 2006). Again, even though both products were used in connection with identical goods (CD-ROMS), the Court of Appeals for the Federal Circuit focused on distinctions between the specific fields of use, and found no likelihood of confusion.

10) There is no per se rule that all food-related products are related. See Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 USPQ2d 1477 (TTAB 1987) (ice cream not related to restaurants featuring hot dogs); Jacobs v. International Multifoods, Corp., 212 USPQ 641, 642 (CCPA 1982) (restaurant services unrelated to tea); The Nestle Company, Inc., v. Nash-Finch Co., 4 USPQ2d 1085 (TTAB 1987) (delicatessen not related to chocolate milk powders); Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 USPQ 1169 (TTAB 1987) (fruit juices not related to beef snack food).

The essence of all these cases is that merely having something to do with food does not establish that products or services are commercially related. The Examiner must provide more proof.

11) In the case In re White Rock Distilleries Inc., 92 USPQ2d 1282 (TTAB 2009), the Board held that there was no likelihood of confusion between VOLTA for use on vodka infused with caffeine and TERZA VOLTA + Design for use on wine. Even though the goods in question travel in the same channels of trade to the same class of purchasers, the Board determined that the marks were dissimilar and vodka and wine are not related goods. The Board specifically noted that "there is no per se rule that holds that all alcoholic beverages are related." Id. at 1285.

12) See Andy Warhol v. Time, 9 USPQ2d 1455 (S.D.N.Y. 1988) (no likelihood of confusion between two magazines with the title INTERVIEW); American Cyanamid Corp. v. Connaught Laboratories, Inc., 800 F.2d 306, 231 USPQ2d 128 (2d Cir. 1986), (no likelihood of confusion between HIBBVAX and HIBIMUNE); Lang v. Retirement Living Publishing Co., 21 USPQ2d 1041 (2d Cir. 1991) (no likelihood of confusion between NEW CHOICES FOR THE BEST YEARS and NEW CHOICES PRESS, both used for magazines, because the intended markets of each magazine was different).

In short, there is insufficient evidence of record to establish that automobile engines and components/parts of vehicles (specifically not engines) are commercially related.

### 3. Register Should Reflect Actual Use

The reality is that due to differences between the marks and products of each party, Applicant will continue to use its mark. For that reason, the Examiner should consider the words of the Court of Appeals for the Federal Circuit in Bongrain International v. Delice de France, 1 USPQ 2d 1775 (Fed. Cir. 1987):

The primary purpose of the Trademark Act of 1946 is to give Federal procedural augmentation to the common law rights of trademark owners -- which is to say legitimate users of trademarks. One of the policies sought to be implemented by the Act was to encourage the presence on the register of trademarks of as many as possible of the marks in actual use so that they are available for search purposes (emphasis added).

Applicant's mark will be used and should be registered

Conclusion

Based on differences between the marks and goods, as well as the reality that Applicant will continue to use its mark and the federal register should reflect that use, Applicant respectfully requests that the examiner's refusal to register be withdrawn, and Applicant's CVC mark passed to publication.

Respectfully submitted,

/sjb/

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