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Subject: U.S. TRADEMARK APPLICATION NO. 85306954 - CVC - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85306954

MARK: CVC



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: KSM CASTINGS GROUP GMBH

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's refusal to register the trademark CVC (Serial No. 85306954). Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) on the ground that the Applicant's mark, when used on or in connection with the

identified goods, so resembles the mark in U.S. Registration No. 2148579 as likely to cause confusion, to cause mistake, or to deceive.

I. FACTS

On April 28, 2011, Applicant, [KSM Castings Group GMBH](#), filed a Section 1(a) trademark application with a claim of priority based on a Germany application seeking registration on the Principal Register of the mark CVC for goods in International Classes 7, 12, and 40.

In an Office Action mailed August 10, 2011, the undersigned trademark attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that Applicant's mark, when used on or in connection with machine goods in International Classes 7 and automotive goods in International Class 12, respectively, automotive transmission parts, structural parts and other related auto parts, so resembled the marks in U.S. Registration No. 2148579 for the mark CVCC for structural parts and engines for automobiles, and U.S. Registration No. 2770610, for the mark CVC, for rolling machines and motors for such machines as to cause confusion, cause mistake or to deceive. The examiner also required the Applicant to amend the identification of goods in International Classes 7, 12, and 40 and inquired about the significance of the meaning of the acronym CVC.

On February 9, 2012, Applicant filed a response to the Office Action, arguing against the refusal to register, and amending the identification of goods to eliminate the wording "use in rolling mills or as part of rolling mills." Applicant stated that the acronym "CVC" as used by the Applicant means "Continuously Variable Crown."

On March 26, 2012, the Examining Attorney suspended the application pending receipt of Applicant's foreign registration and withdrew the likelihood of confusion refusals. On May 2, 2012, Applicant filed a copy of its foreign registration. Thereafter, the Examining Attorney on July 5, 2012, lifted the suspension and issued an Office Action reinstating the likelihood of confusion refusal with respect to Registration No. 2148579 only. On December 24, 2012, Applicant filed a response to the suspension letter, arguing against the refusal to register and further amending the goods in International Class 12. In a Final Office Action issued on January 25, 2013, the Examining Attorney made final the Section 2(d) refusal limited to Applicant's goods in Class 12.

On July 24, 2013, Applicant filed a Request for Reconsideration. On August 7, 2013, the Examining Attorney denied the Request for Reconsideration and issued an Office Action continuing the likelihood of confusion refusal as to Applicant's goods in International Class 12. On September 11, 2013, Applicant filed an Appeal Brief. On September 12, 2013, the Trademark Trial and Appeal Board forwarded the appeal brief to the Examining Attorney for brief.

II. STATEMENT OF THE ISSUE

The only issue on appeal is whether Applicant's mark, when used on or in connection with the identified goods in International Class 12, so resembles the mark in U.S. Registration No. 2148579 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

III. ARGUMENT

Applicant's mark, when used on or in connection with the identified Class 12 goods, so resembles the mark in U.S. Registration No. 2148579 as to be likely to cause confusion, to cause mistake, or to deceive.

A. The Marks are Confusingly Similar

The Applicant has applied to register CVC (standard characters) for the following identified Class 12 goods, namely, "transmissions for land vehicles;" "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", and related car parts as amended in the Request for Reconsideration filed on July 24, 2013. The Registrant's mark is CVCC (standard characters) (Reg. No. 3954877) for "structural parts and engines for automobiles" in International Class 12.

The marks of the parties are confusingly similar. Applicant's mark is wholly comprised of the letters CVC. Registrant's mark contains an additional "C" in the mark CVCC. The only difference between the marks is that Applicant's mark presents one "C" following the letter "V" (CVC) and the Registrant presents two "C"s following the letter "V" (CVCC). This difference does not obviate the similarities between the marks where the marks remain identical in sound as to the first three letters.

When comparing marks that consist of a series of two or more letters, confusion may be likely even if the letters are not identical or in the same order. It is more difficult to remember a series of arbitrarily arranged letters than to remember words or figures; that is, confusion is more likely between arbitrarily arranged letters than between other types of marks. *See, e.g., Weiss Assoc. v. HRL Assoc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding confusion between TMS and TMM); *Dere v. Inst. for*

Scientific Info., Inc., 420 F.2d 1068, 164 USPQ 347 (C.C.P.A. 1970) (finding confusion between ISI and I.A.I.); *cf. In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001) (finding confusion between Registrant's KING FM and KING-TV and Applicant's KYNG).

This principle was set forth in *Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 506, 25 USPQ 5, 6 (C.C.P.A. 1935), wherein the Court of Customs and Patent Appeals applied the following reasoning in holding Z.B.T. likely to be confused with T.Z.L.B. for talcum powder: "We think it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words or phrases. The difficulty of remembering such lettered marks make confusion between such marks, when similar, more likely." In this case, the Applicant has not even changed the order of the letters. Applicant's mark simply deletes a repeated letter from the end of an already registered mark.

Even lettered marks having only two letters in common, used on identical or closely related goods, have been held likely to cause confusion. *See, e.g., Feed Serv. Corp. v. FS Servs., Inc.*, 432 F.2d 478, 167 USPQ 407 (C.C.P.A. 1970) (finding confusion between FSC and FS); *Cluett, Peabody & Co. v. J.H. Bonck Co.*, 390 F.2d 754, 156 USPQ 401 (C.C.P.A. 1968) (finding confusion between TTM and T.M.T.); *Edison Bros. Stores, Inc. v. Brutting E.B. Sport-Int'l GmbH*, 230 USPQ 530 (TTAB 1986) (finding confusion between EB and EBS); *see also* TMEP §1207.01(b)(ii)-(iii).

Applicant argues that CVC and CVCC are not pronounced the same. However, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Applicant indicates that CVCC is an acronym used by Honda for “Compound Vortex Controlled Combustion,” a specific type of engine designed by Honda to meet 1975 emission standards pursuant to the 1970 Clean Air Act. (Applicant’s Brief at 2). Therefore, Applicant argues that consumers would recognize CVCC as “a specific Honda product used for Honda Civic automobiles” (*Id.*) and not be confused with its proposed CVC mark.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under Applicant’s and Registrant’s marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

B. The Goods are Highly Related

Applicant’s identification of goods includes, 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; 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; and other automotive parts.

As indicated by the above excerpt from Applicant's exhaustive list of automotive goods in the application, most of the Applicant's automotive parts are structural parts, which are identical to the Registrant's goods, namely, structural parts of automobiles. The Registrant broadly defines its goods as "structural parts." Therefore, it encompasses the Applicant's more narrowly defined structural parts, such as its bumper systems, door inner panels, mudguards, bonnets, knuckles, front axles, rear axles, and twist beam axles for motor vehicles. It is uncontested that Applicant and the Registrant both make and/or sell structural parts of automobiles.

The identification set forth in the application and registration have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Moreover, the Trademark Trial and Appeal Board has previously held that marketing by different parties of different types of automotive parts and accessories under the same or similar marks is likely to cause confusion. *See, e.g., In re Magic Muffler Serv., Inc.*, 184 USPQ 125 (TTAB 1984) (holding MAGIC for vehicle parts, namely mufflers, likely to be confused with MAGIC for motors for motor vehicles); *In re Delbar Prods., Inc.*, 217 USPQ 859 (TTAB 1981) (holding ULTRA for outside mounted vehicle mirrors likely to be confused with ULTRA and design for automobile parts, namely pistons and pins, valves, water pumps, oil pumps,

universal joints, gears, axle shafts, hydraulic brake parts, automatic transmission repair kits and parts, engine bearings and jacks); *AP Parts Corp. v. Auto. Prods. Associated*, 156 USPQ 254 (TTAB 1967) (holding AP for clutches, brakes, steering joints, tie-rod joints, and suspension joints for land vehicles, aircraft or watercraft likely to be confused with AP for mufflers for explosive engines); *Monarch Mufflers, Inc. v. Goerlich's, Inc.*, 148 USPQ 20 (TTAB 1965) (holding MONARCH for brake linings for automotive use likely to be confused with MONARCH for exhaust mufflers for motor vehicles).

In addition, the third party registrations attached to the January 2, 2013 Office Action, show registered marks used in connection with the same or similar goods as those of Applicant and Registrant in this case. These registrations have probative value to the extent that they serve to suggest that the goods listed therein, namely automobile structural parts and automobile engines (like those of the Registrant) and automobile transmissions, brakes, knuckles, clutches, wheel axles, drives shafts, chassis', bumpers and various other parts (like those of the Applicant) are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Note for example the following registrations:

1. Reg. No. 4267151 MIDWEST TRUCK & AUTO PARTS, INC. for vehicle structural parts and transmissions and related goods.
2. Reg. No. 4249683 VPR4X4 for automobile bumpers and structural parts therefor
3. Reg. No. 4279490 LOMA for structural parts of automobiles; Bumpers for automobiles and related goods.
4. Reg. No. 4268334 DRAGONSNAKE for automobile engines, automobiles and structural parts, and disc brakes for land vehicles.

With respect to Applicant's and Registrant's goods, the question of likelihood of confusion is determined based on the description of the good stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In this case, it is undisputed that Applicant and Registrant make and/or sell structural parts of automobiles.

Applicant does not argue that its structural parts and Registrant's structural parts are the same. Rather, Applicant singles out "engines" in the registration and argues that its goods are not likely to be confused with Applicant's automobile engines. By adding the words "not as parts of engines" to its structural parts as identified in the application, Applicant argues its structural parts are not likely to be confused with the Registrant's automobile engines. However, the limitation is ineffective, because structural parts of automobiles are different from engine parts. Therefore, adding "not parts of engines" does not eliminate confusion between Applicant's structural parts and Registrant's structural parts, because the focus must be upon the goods as identified in the application and registration. The United States Court of Appeals for the Federal Circuit has held "when reviewing the relatedness of the goods, this court considers "the Applicant's goods as set forth in its application, and the opposer's goods as set forth in its registration"). [*Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 \(Fed. Cir. 2012\)](#).

Even assuming the registration only covered engines, the engines sold under Registrant's mark are still related to the Applicant's goods. For instance, Applicant's transmissions and Registrant's engines are the type of goods that are likely to cause

confusion if sold under similar marks. For example, the excerpts from third party websites attached to the January 25, 2013, Office Action, shows engines for automobiles (Applicant's goods) and automobile transmissions (Registrant's goods) are commonly sold together. Note the following excerpts:

1. "Following more than \$220 million in investments in two Ohio plants over the past two years, Honda on Thursday began mass production of new engines and transmissions for its [upcoming 2013 Accord sedan](#)." Robert Schoenberger, *2013 Honda Accord gets new engines, transmissions built in Ohio*, The Plain Dealer (January 25, 2013, 7:24 AM), http://www.cleveland.com/business/index.ssf/2012/08/2013_honda_accord_gets_new_s_en.html.
2. "Specializing in used engines and transmissions" <http://www.enginesandtransmissionworld.com/index.php>
3. "You can find your used engines or transmissions by calling us direct at the number above or you can fill out a request and one of our agents will call you back or send you a reply email." <http://www.jasperengines.com/index.php>

Where the goods of an Applicant and Registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004); TMEP §1207.01(b).

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that Applicant's mark, when used on or in conjunction with the identified goods, so resembles the mark in U.S. Registration No. 2148579 as to be likely to cause confusion, to cause mistake, or to deceive, should be affirmed.

Respectfully submitted,

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