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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bentley Motors Ltd.

Serial No. 85325994

Brian R. McGinley of SNR Denton US LLP for Bentley Motors Ltd.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Cataldo, Bergsman, and Lykos, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On May 20, 2011, Bentley Motors Ltd. (“applicant”), a United Kingdom corporation, filed an application to register the mark BENTLEY on the Principal Register, in standard character format,¹ for “Perfume, cologne, aftershave, deodorants, cosmetics, hair lotions, soaps, personal hygiene products” in International Class 3 and “Articles of glass, crystal, earthenware and porcelain;

¹ Serial No. 85325994, filed May 20, 2011 pursuant to Section 1(b) of the Trademark Act and a claim of priority pursuant to Section 44(d) based on a European Community foreign application. Said foreign application matured into registration on October 24, 2011; on May 29, 2012, applicant submitted a digitized image of a certified copy of the foreign registration (European Community No. 009984031).

bottles and containers of glass; decanters; perfume bottles” in International Class

21. In the application, applicant claimed ownership of the following U.S. registrations and others:

U.S. Registration No. 2985659 for the mark BENTLEY in stylized format for “automobile financing services, namely, credit consulting and loan services for retail purchase and/or lease of automobiles” in International Class 36;²

U.S. Registration No. 645703 for the mark BENTLEY in stylized format for “internal combustion engines and parts thereof” in International Class 23;³ and

U.S. Registration No. 646403 for the mark BENTLEY in stylized format for “automobile and structural parts thereof” in International Class 19.⁴

The Trademark Examining Attorney refused registration of applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant’s mark so resembles the following registered marks owned by different entities:⁵

BENTLEY (stylized) for “beverage glassware, drinking mugs, ceramic drinking steins and tankards, ceramic drinking cups” in International Class 21;⁶

BENTLEY UNIVERSITY (standard character format) for “beverage glassware, drinking mugs, ceramic drinking steins and tankards, ceramic drinking cups” in International Class 21;⁷

² Section 8 and 15 affidavits accepted and acknowledged.

³ Third renewal.

⁴ Third renewal.

⁵ Registration No. 2994043, owned by Bentley College, for the mark BENTLEY COLLEGE for “beverage glassware, drinking mugs, ceramic drinking steins and tankards, ceramic drinking cups” was cancelled pursuant to Section 8.

⁶ Registration No. 2994045, owned by Bentley University; Section 8 and 15 affidavits accepted and acknowledged.

BENTLEY ORGANIC (standard character format) for “[p]roducts, made substantially in part of organic ingredients, used for personal care, namely, non-medicated soaps, cosmetics, hair lotion, shampoo, non-medicated toiletries, and non-medicated skin care preparations” in International Class 3;⁸

BENTLEY ORGANIC (stylized) for “[s]oaps; perfumery; essential oils; cosmetics; hair lotion; medicated soap; shaving soap; shampoo; bar soap; liquid soap; baby soap; cleaning preparations; non-medicated handwash in the nature of hand soap, body wash, shower gel, bath foam, bath foam for babies, facial cleansers; hair conditioner; baby oil; body lotion; skin creams; face and skin creams; body butter; stretch mark creams; lip balms; nappy creams in the nature of non-medicated diaper rash creams; after-sun lotions; all the aforesaid goods being for personal care use; preparations for cleaning bathrooms; non-antibacterial non-disinfecting bathroom cleaners; preparations for cleaning showers; preparations for use in cleaning showers; non-antibacterial non-disinfecting shower cleaners; preparations for cleaning household glass; cleaning agents for household glass; household glass cleaners; household glass cleaning preparations; preparations for cleaning household surfaces; household surface cleaners; preparations for cleaning household hard surfaces; cleaners for use on toys; baby wipes; baby wipes for cleaning purposes; baby wipes for cleaning purposes impregnated with cosmetic, moisturizing lotions; pre-moistened wipes for cosmetic purposes; pre-moistened wipes impregnated with a cosmetic lotion; pre-moistened wipes impregnated with a moisturizing lotion; pre-moistened cosmetic wipes; pre-moistened wipes for babies, infants and/or children in the nature of baby wipes; pre-moistened cosmetic wipes; paper wipes impregnated with cosmetic preparations; wipes and tissues impregnated with cleaning preparations, including for surfaces; pre-moistened tissues; wipes impregnated with cleaning preparations, cosmetic products, and/or moisturizing lotions; household cleaning products in the nature of cleaning preparations; preparations for cleaning kitchens; preparations for washing crockery; washing-up liquids; preparations for cleaning textiles; powders for cleaning clothes; powder for washing clothes; liquids for cleaning clothes; washing liquid for clothes; fabric softeners; laundry fabric conditioners; all of the aforesaid goods being made in whole or substantial part from organic ingredients” in International Class 3 and “Medicated skin creams, including

⁷ Registration No. 3349002, owned by Bentley University; Section 8 and 15 affidavits accepted and acknowledged.

⁸ Registration No. 3799891, owned by Thos. Bentley & Son Limited; with a disclaimer of “ORGANIC.”

medicated facial skin creams; hand and skin sanitizers; chemical preparations for sanitary purposes, namely, household sanitizers; sanitizing preparations for household use; antibacterial bathroom cleaner; antibacterial shower cleaner; sanitizing preparations and disinfecting cleaners for use on toys; medicated lip balms; medicated nappy cream in the nature of medicated diaper rash cream; sanitary preparations for medical use; medicated pre-moistened wipes; medicated wipes and antiseptic wipes impregnated with chemicals; sanitizing wipes; sanitizing wipes for surfaces; pharmaceutical preparations, namely, vapor-releasing formulations to aid breathing; all of the aforesaid goods being made in whole or substantial part from organic ingredients” in International Class 5.⁹

Following a request for reconsideration which was denied, applicant appealed the examining attorney’s final refusal to register the application. Concurrent with the request for reconsideration, applicant filed a timely amendment to the identification of goods in both international classes to restrict the channels of trade to the following: “**...all the foregoing sold exclusively through authorized vehicle dealers and authorized vehicle service outlets.**” The examining attorney accepted the amendment but adhered to the final refusal to register.¹⁰ We now consider the fully briefed appeal.

I. *Procedural History – Identification of Goods*

Before discussing the merits of the appeal, the Board is compelled to

⁹ Registration No. 4017737, owned by Thos. Bentley & Son Limited; with a disclaimer of “ORGANIC.”

¹⁰ In maintaining the final refusal, the examining attorney submitted additional evidence consisting of third-party registrations purporting to show the relatedness of applicant’s and registrants’ goods. Such materials fell outside the scope of the Board’s remand order and therefore have not been considered. Nonetheless, even if we were to consider this newly submitted evidence, it would not alter our determination insofar as the third-party registrations are not relevant to the critical issue before us -- the similarity or dissimilarity of established, likely to continue trade channels (see discussion below).

comment on the *ex parte* history of the involved application with regard to the identification of goods. If an issue not previously raised is a defect that can easily be corrected by the applicant, the Board may elect to decide the issue on appeal, and include in its decision a recommendation that applicant voluntarily correct the defect if it prevails on the appealed issue. *See* TBMP § 1217 (3d ed. rev. 2 2013) and cases cited therein.

In response to the examining attorney's determination that the identification of goods as originally filed was in part indefinite, on March 9, 2012, applicant proposed the following amendment as set forth below:

Perfume, cologne, aftershave, personal deodorants, cosmetics, hair lotions, soaps in International Class 3; and

Articles of glass, namely, drinking glass, busts of crystal, decorative centerpieces of crystal, desktop statuary made of crystal, earthenware mugs, porcelain mugs, bottles, sold empty, containers for household uses, namely, glass bulbs, **decanter**s, **perfume atomizers**, **sold empty**" in International Class 21 (emphasis added).

The examining attorney found the amended identification of goods to be acceptable and the amendment was entered. *See* Office Action dated July 1, 2012. With its subsequent request for reconsideration, applicant filed a second amendment to its identification of goods which was accepted and entered by the Office as indicated below:

Perfume, cologne, aftershave, personal deodorants, cosmetics, hair lotions, soaps, all of the foregoing sold exclusively through authorized dealers and authorized service outlets in International Class 3, and

Articles of glass, namely, **perfume bottles and perfume decanters**, all of the foregoing sold exclusively through authorized dealers and authorized service outlets in International Class 21 (emphasis added).

As noted above, this identification was modified again on remand to add the qualifying language that the authorized dealers and service outlets pertain to vehicles.

It has now come to the Board's attention that the identification of goods for Class 21 as it currently reads is indefinite and constitutes an impermissible expansion outside the scope of the goods as originally amended because (1) the terminology "sold empty" was deleted, and (2) the term "perfume bottles" is broader in scope than "perfume atomizers." *See* Trademark Rule 2.71(a) ("The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services."). To rectify this, the Board recommends that applicant amend the identification of goods in International Class 21 to the following:

Articles of glass, namely, **perfume atomizers and perfume decanters sold empty**, all of the foregoing sold exclusively through authorized vehicle dealers and authorized vehicle service outlets (emphasis added).

II. *Section 2(d) Refusal*

The Board will now consider the refusal to register. We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

In arguing against the examining attorney's refusal to register, applicant relies heavily on the third and fourth *du Pont* factors, namely the similarity or dissimilarity of established, likely to continue trade channels and the conditions under which, and buyers to whom, sales are made. In particular, applicant contends that the amendment restricting the trade channel for applicant's goods exclusively to authorized vehicle dealers and authorized vehicle service outlets will obviate any likelihood of confusion. As applicant argues in its appeal brief, page 4:

Applicant's registration seeks to cover goods promoted and sold under the BENTLEY mark offered exclusively through authorized dealers and service outlets. Essentially products that will be available through the very tightly-knit Bentley circle. Bentley dealers and service outlets are devoted to the distribution and sale of luxury vehicles such as Rolls Royce® and Bentley® brand automobiles and related parts and accessories, and they cater to a niche, affluent clientele base.

In addition, applicant argues that because its products are sold via Bentley and Rolls Royce authorized dealerships and service outlets, such consumers are well aware that they are purchasing ancillary goods. As such, applicant contends that the sale of its products exclusively in niche portions of the luxury vehicle market results in distinct, non-overlapping trade channels and consumers when compared to those of registrants' products.

The examining attorney disagrees, relying on the proposition that, if an identification describes the goods without any limitation as to trade channels, it is presumed that the goods move in all normal channels of trade for those goods. For each of the involved registrations, this indeed is true. Thus, in accordance with our well established case law, because none of the registrations include any restrictions

regarding channels of trade, we must presume that such goods are sold in the ordinary or normal trade channels. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”). *See also In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958).

There is nothing in the record, however, to suggest that the ordinary trade channels for registrants’ goods include “authorized” vehicle dealers and vehicle service outlets. Put another way, applicant’s goods are marketed solely and exclusively through dealers and service outlets for Bentley and Rolls Royce automobiles. The record does not support the proposition that the goods identified in the cited registrations normally move in these channels of trade, notwithstanding that they do not recite any trade channel limitations. The burden is on the Office to show that the ordinary trade channels for registrants’ goods overlap with applicant’s very limited trade channel. For this reason, we find that the trade channels, as now identified in applicant’s application, are distinct and do not overlap with the ordinary channels of trade for the identified goods.

In a particular case, any of the *du Pont* factors may play a dominant role. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“we know of no reason why, in a particular

case, a single *du Pont* factor may not be dispositive”). In the present case, the lack of evidence showing an overlap in the channels of trade for applicant's and registrants' products is pivotal. *See, e.g., In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010) (“There is nothing in this record to show that a normal channel of trade for dietary and nutritional supplements is that they are sold to the companies that would purchase applicant's identified goods.”). Because we find that the amendment to restrict applicant's channel of trade means “there is virtually no opportunity for confusion to arise” (*Id.* at 1324), we need not consider the other *du Pont* factors discussed by the examining attorney and applicant. *See id.* *See also, Kellogg Co. v. Pack'em Enterprises Inc.*, 921 USPQ2d at 1145 and *In re Sela Prods. LLC*, 107 USPQ2d 1580, 1589 (TTAB 2013). Accordingly, we find that the Office has not satisfied its burden of proving that confusion is likely.

DECISION: The Section 2(d) refusal is reversed. Insofar as applicant has prevailed on the issue on appeal, the file will be forwarded to the examining attorney for further amendment of the identification of goods in accordance with the above discussion.