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

Proceeding	85325994
Applicant	Bentley Motors Limited
Applied for Mark	BENTLEY
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Date	07/01/2013

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

<i>In re</i> U.S. Application of Bentley Motors Limited	)	
	)	
Serial No.: 85/325,994	)	Charles L Jenkins, Jr., Esq.
	)	Examining Attorney
Filed: May 20, 2011	)	Law Office 105
	)	
Mark: BENTLEY	)	
	)	
Int. Classes 003, 021	)	

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**APPLICANT’S REPLY BRIEF**

Applicant, Bentley Motors Limited (“Applicant” or “Bentley”) through its undersigned counsel replies to the Examiner’s Appeal Brief filed June 13, 2013, in the *ex parte* appeal of the refusal to register Serial No. 85/325,994 for the mark BENTLEY (“Applicant’s Mark”). Applicant respectfully objects to the Examiner’s failure to consider important restrictions entered for the application on January 3, 2013, relating to the channels of trade in which Applicant’s goods will travel, and otherwise replies to the Examiner’s Appeal Brief as follows:

## ARGUMENT

### **I. Introduction**

Applicant seeks registration of BENTLEY for the following goods:

Perfume, cologne, aftershave, personal deodorants, cosmetics, hair lotions, soaps, all of the foregoing sold exclusively through authorized dealers and authorized service outlets, IC 003.

Articles of glass, namely, perfume bottles and perfume decanters, all of the foregoing sold exclusively through authorized dealers and authorized service outlets, IC 021.

The Examiner has issued a final refusal based on an alleged likelihood of confusion with the following marks which are owned by various third parties (collectively the “Cited Marks”):

- US Reg. No. 4,017,737 for BENTLEY ORGANIC in IC 003 and IC 005.
- US Reg. No. 3,799,891 for BENTLEY ORGANIC, in IC 003.
- US Reg. No. 2,994,045 for BENTLEY, in IC 021
- US Reg. No. 3,349,002 for BENTLEY UNIVERSITY, in IC 021.
- US Reg. No. 2,994,043 for BENTLEY COLLEGE, in IC 021.

Applicant filed its Appeal Brief in support of Applicant’s Mark on April 15, 2013, and the Examiner’s Brief was filed on June 13, 2013.

### **II. Applicant’s Mark**

Initially, Applicant seeks to clarify its purpose in citing to prior rights in its Appeal Brief. Applicant’s arguments regarding the importance of Applicant’s established BENTLEY brand are

not, as the Examiner characterized them, a “collateral attack” on the Cited Marks. (*See* Examiner’s Brief, p. 10) Instead, Applicant seeks to inform the Board regarding the narrow, highly-regulated and very specialized environment in which Applicant’s customers will be viewing Applicant’s Mark.

For more than fifty years, Applicant has spent an immense amount of effort and money to build a BENTLEY brand around the marketing and sale of luxury automobiles. Applicant’s now-famous BENTLEY brand has a strong hold on consumers, even giving rise to popular phrases that seek to highlight the high quality of unrelated goods and services, for example “it is the Bentley of \_\_\_\_\_” is often used to describe an unrelated good or service as top of the line. Consumers are exceedingly knowledgeable about the brand and Applicant’s goods and services, and exhibit very discerning shopping behavior. Applicant’s authorized dealers and service outlets grow out from Applicant’s famous brand, and customers that visit those stores are well aware of the relationship between the stores, Applicant, the BENTLEY brand, and the luxury automobile industry. These stores do not sell competing brands. They focus first on the sale and servicing of luxury automobiles, and second on the sale of ancillary products.

In short, Applicant’s dealers and service outlets were built around Applicant’s famous BENTLEY mark in the automobile industry, and consumers visiting these establishments expect goods and services that originate with Applicant to be sold there. Such consumers are not likely to be confused by goods sold under the Cited Marks in other channels of trade. In addition to the other reasons Applicant believes there is no likelihood of confusion between the Cited Mark and Applicant’s Mark (as set forth in more detail in Applicant’s Brief), the strength of presence of the BENTLEY brand in Applicant’s highly-regulated and niche trade channels further dispels any such concerns.

### III. Channels of Trade are Distinguishable

Further, Applicant believes the Examiner may have erroneously ignored important amendments made to the goods description for Applicant's Mark. On January 3, 2013, Applicant's amendments were entered to limit the channels of trade for its goods to its "authorized dealers and authorized service outlets." As discussed throughout this Reply, these amendments significantly impact the likelihood of confusion analysis for each of the Cited Marks, but the Examiner's analysis appears to ignore them. (*See Examiner's Brief*, p. 6) ("In this case, the identification set forth in the application and registration(s) has 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.").

Where an applicant sells expensive goods under its mark to a distinct and discriminating group of people through a separate trade channel, this fact strongly weighs against a likelihood of confusion. *See Alpha Industries, Inc. v. Alpha Steel Tube & Shapes*, 616 F.2d 440, 444-45 (9th Cir. 1980) (ALPHA not confusingly similar to ALPHA STEEL, despite fact that "steel" was descriptive and the goods were related, "where the purchasers [were] two distinct groups and both knowledgeable, where the items [were] expensive (implying greater buyer care)"); *see also Electronic Design & Sales v. Electronic Data Systems Corporation*, 954 F.2d 713, 714 (Fed. Cir. 1992) (Court held "that the Board failed to assess properly the differences in purchasers, channels of trade, and what each company sold, and overlooked the sophistication of the purchasers...").

The upscale and premium nature of Bentley's goods and its well-heeled customer base, coupled with Bentley's exclusive, limited channels of trade, truly vitiates any likelihood of confusion. 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. The goods for which Applicant seeks registration thus move through very discrete trade channels based on important factors such as their selling price, their target consumers and the image and appeal that they convey to the consuming public. In other words, Bentley's products will be targeted at and sold to a relatively confined class of consumers in tightly controlled trade channels. Further, absolutely none of the goods sold under the Cited Marks would ever be sold in Bentley's exclusive outlets.

#### **IV. Conclusion.**

Because the Applicant's Mark and the Cited Marks differ in fundamental, significant ways, and the goods for which Applicant seeks registration are limited to high-end and tightly-controlled trade channels relating to the automotive industry, Applicant respectfully submits no likelihood of confusion exists and asks that the Board reverse the Examiner's Final Refusal and allow Applicant's Mark to proceed to publication. In the alternative, if the Board determines that further narrowing revision to the description of one or both classes of Applicant's goods could place its application in condition for publication, Applicant respectfully requests an opportunity to make such revision(s).

Respectfully submitted,

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July 1, 2013

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