

From: Galan, Matthew

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Subject: U.S. TRADEMARK APPLICATION NO. 85627251 - SOLO - 139582-00001 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 0

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Attachment Information:

Count: 31

Files: 76132702P001OF003.JPG, 76132702P002OF003.JPG, 76132702P003OF003.JPG, 76399047P001OF002.JPG, 76399047P002OF002.JPG, 76709577P001OF002.JPG, 76709577P002OF002.JPG, 77089149P001OF003.JPG, 77089149P002OF003.JPG, 77089149P003OF003.JPG, 78333466P001OF003.JPG, 78333466P002OF003.JPG, 78333466P003OF003.JPG, 78371161P001OF003.JPG, 78371161P002OF003.JPG, 78371161P003OF003.JPG, 85098201P001OF006.JPG, 85098201P002OF006.JPG, 85098201P003OF006.JPG, 85098201P004OF006.JPG, 85098201P005OF006.JPG, 85098201P006OF006.JPG, 85099439P001OF004.JPG, 85099439P002OF004.JPG, 85099439P003OF004.JPG, 85099439P004OF004.JPG, 85099626P001OF004.JPG, 85099626P002OF004.JPG, 85099626P003OF004.JPG, 85099626P004OF004.JPG, 85627251.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85627251

**MARK:** SOLO



**CORRESPONDENT ADDRESS:**

KIMBERLY A. BERGER

MILLER CANFIELD

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DETROIT, MI 48226-4432

**GENERAL TRADEMARK INFORMATION:**

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

**APPLICANT:** 4162 Doerr Road, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

139582-00001

**CORRESPONDENT E-MAIL ADDRESS:**

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:**

The Office has reassigned this application to the undersigned trademark examining attorney.

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusals made final in the Office action dated March 23, 2013 are maintained. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). This is because applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Most notably, applicant acknowledges that "the marks at issue are nearly identical." However, applicant asserts that the term "SOLO" is a weak because others use this term within their marks. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix). Further, the marks to which applicant refers to support its weakness argument all contain other terms that serve to distinguish source among those marks. In this case, no other term exists between applicant's and registrants' marks to distinguish source. The entire literal element within these marks is the term "SOLO." Thus, applicant's assertion that the term "SOLO" is weak is inapposite and unpersuasive.

Further, applicant asserts that its mark and the marks of both registrants have "peacefully coexisted for over five years." The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

Thus, applicant's argument that there is no evidence of actual confusion is misplaced and unpersuasive.

Turning next to the relationship between the goods in this case, applicant contests that the goods are unrelated and that the goods in Registration Nos. 2927554 and 3579672 would not be marketed in such a way "that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." However, and as stated previously, the identifications set forth in the cited registrations 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. Further, the registrations use broad wording to describe the respective clothing and footwear, and this wording is presumed to encompass all goods of the type described, including those in applicant's more narrow identification which identifies snowmobile, motorcycle and ATV clothing and boots. It must therefore be presumed that applicant and both registrants use the mark for identical goods: snowmobile, motorcycle and ATV pants, shirts, socks, and boots. See Trademark Act Section 7(b), 15 U.S.C. §1057(b); see also *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); TMEP §1207.01(a)(iii).

Ultimately, trademark registrations on the Principal Register, such as Registration Nos. 2927554 and 3579672, are prima facie evidence of the validity of the registrations and the registrants' exclusive right to use the mark in commerce *in connection with the specified goods*. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Applicant's assertion that its clothing and boots "are very different" does not obviate the relationship between registrants' goods, and the goods applicant has identified. Further, the evidence of record actually shows that applicant's "casual clothing" is sold in the same channels of trade and to the same customers as registrants' goods. See the previously attached evidence from Thor MX, O'Neal, Speed and Strength, Harley-Davidson, Ski-Doo, Polaris, Fox Head, and AlpineStars. Further, the examining attorney attaches the following third-party registrations showing that the same entity provides applicant's and registrants' goods under one common mark. See the attached. Thus, the examining attorney has provided relevant evidence to support this refusal.

Accordingly, the request is **DENIED**.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

It is noted that applicant has already filed a timely notice of appeal with the Board. The Board will therefore be notified to resume the appeal. *See* TMEP §715.04(a).

/Matthew G. Galan/

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