

This Opinion is Not a
Precedent of the TTAB

Mailed: April 7, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re K2 Motorcars LLC
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Serial No. 90130036
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Jodi-Ann Tillman of Shutts & Bowen LLP,
for K2 Motorcars LLC.

Kim Ray Malyszek, Trademark Examining Attorney, Law Office 122,¹
Kristin Dahling, Acting Managing Attorney.

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Before Cataldo, Lykos and Heasley,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:²

K2 Motorcars LLC (“Applicant”) seeks to register on the Principal Register the
composite mark displayed below (MOTORCARS disclaimed)

¹ During prosecution, the application was assigned to Trademark Examining Attorney C. Scott Strickland.

² Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify documents by title and date. Where noted, citations are to the .pdf format. References to the briefs and other materials in the appeal record refer to the Board’s TTABVUE docket system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).



for “Online dealership services featuring automobiles” in International Class 35.³

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for mark so resembles the composite mark on the Principal Register displayed below



for “On-line wholesale and retail store services featuring auto parts and accessories thereof; wholesale and retail store services featuring auto parts and accessories thereof” in International Class 35, that it is likely to cause confusion or mistake or to deceive.⁴

³ Application Serial No. 90130036, filed August 21, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. The description of the mark is as follows: “The mark consists of the stylized wording ‘K2 MOTORCARS’ wherein the word ‘MOTORCARS’ is underscored.” The application also includes services in International Class 41 which are not subject to the refusal at issue in this appeal.

⁴ Registration No. 4693966, registered March 3, 2015. The description of the mark is as follows: “The mark consists of the wordings ‘K2 MOTOR’ in black font and a shield design, wherein the shield is consists of griffon design in orange and red color, the inside of the shield and the background of the griffon is divided into two halves where the left half is in black color and the right half is in orange color, the outer perimeter of the shield has six rivets made up of the colors white, grey, and black, the upper left hand corner of the perimeter of the shield is in orange color, the upper right perimeter and lower left perimeter of the shield is in grey and black, the lower right perimeter of the shield is in white color, and finally, there is a black skeletal looking design provided on the right half of the shield and next to the

When the refusal was made final, Applicant appealed and requested reconsideration. The Trademark Examining Attorney maintained the refusal to register and denied the request for reconsideration. The appeal was resumed and is now briefed.⁵ For the reasons set forth below, we reverse.

I. Likelihood of Confusion

Our determination under Section 2(d) is based 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) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747

griffon design.” The colors black, white, grey, orange and red is/are claimed as a feature of the mark.

⁵ In her appeal brief, the Examining Attorney withdrew the Section 2(d) refusal based on two other previously cited registrations, Registration Nos. 6138766 and 4135835. Registration No. 4135835 was cancelled on November 18, 2022 for failure to file a renewal under Sections 8 and 9 of the Trademark Act.

(Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). These factors, and the others, are discussed below.

A. Strength of the Cited Mark

We commence by addressing the strength of the cited mark, because this will inform our comparison of the marks.

“[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “The weaker [the cited] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted). In determining the strength of a cited mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined

by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

There is no evidence of third-party uses in the record that would establish any diminished commercial strength of Registrant's mark, the sixth *DuPont* factor. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) ("Evidence of third-party use of similar marks on similar [services] is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). However, we do have evidence pertaining to the inherent or conceptual strength of the cited mark. The Examining Attorney initially cited as a bar to registration under Section 2(d) the following mark, owned by a different registrant, for related goods:⁶

Registration No. 6138766 for the stylized mark K2 displayed below on the Principal Register for "Automobiles; sports cars; vans; trucks; motor buses; electric vehicles, namely, electrically-powered motor vehicles" in International Class 12.⁷

⁶ In its February 28, 2022 Request for Reconsideration, Applicant included search results from TESS for marks comprised of "K2." See February 28, 2022 Request for Reconsideration TSDR 16-17 (.pdf format). The Examining Attorney appropriately objected to the registrations and applications in list format as not making the registrations and applications properly of record. *See In re 1st USA Realty Prof'ls*, 84 USPQ2d 1581, 1583 (TTAB 2007). To make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013). Accordingly, the Board has not considered this evidence in rendering its opinion.

⁷ Registered September 1, 2020.



Third-party registrations alone may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 115 USPQ2d at 1675 (internal quotation marks omitted). *See also Jack Wolfskin*, 116 USPQ2d at 1135-36. Typically more than one registration for similar marks related goods or services is necessary to show significant conceptual weakness. By contrast, in *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record, 115 USPQ2d at 1672 n.1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n.2.

We further observe that the cited mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *Tea Bd. of India*, 80 USPQ2d at 1899. The registration is “prima facie evidence of the validity of the registered mark” See Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). On this record, the cited mark has been not been weakened by third-party registrations or uses of similar marks by competitors in the industry offering the same or similar services. We therefore accord

Registrant's mark "the normal scope of protection to which inherently distinctive marks are entitled," *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

B. The Marks

Having gauged the strength of the cited mark, we now turn to the first *DuPont* factor, the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692 (citing *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x (Fed. Cir. 2019). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

"The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)

(citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

In this case we are comparing composite marks, marks comprised of both literal and design elements. “The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(c)(ii) (July 2022). *See, e.g., Jack Wolfskin*, 116 USPQ2d at 1135-36 (holding that Board’s finding of similarity lacked substantial evidence because it minimized the literal element in a composite mark); *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974) (reversing Board’s holding that SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices, is not likely to cause confusion). As with word marks, “[a]lthough it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion.” TMEP § 1207.01(c)(ii) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) and *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ 390, 395 (Fed. Cir. 1983)). In assessing what constitutes the dominant portion of a composite mark, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. *Viterra*, 101 USPQ2d at 1911; *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Nonetheless,

composite marks, as with any marks, must be considered in their entirety. *See Jack Wolfskin*, 116 USPQ2d at 1134; *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 273-74 (CCPA 1974).

The Examining Attorney discounts the visual distinctions between the marks, focusing instead on the shared common elements K2 and “motor” in each mark. In her view, the “literal and spoken elements of the marks are so nearly identical, as K2 ‘MOTOR’ compared to ‘K2 MOTORCARS’, the marks sound nearly identical.”⁸ On this basis, she argues that the marks are similar in sound, appearance, and overall commercial impression.

The Examining Attorney’s position is based on the principle, noted above, that when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *See, e.g., In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 , 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). This principle is relevant where the literal portions of a composite mark can be clearly discerned by the consumer and form a prominent portion of that mark. However, “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of

⁸ Examining Attorney’s Brief, p. 12; 12 TTABVUE 13.

letters or design dispositive of the issue.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). We instead find *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) to be more pertinent here. The involved mark in that case as depicted below included design features that played a much more prominent role than the wording in the applicant’s mark.



The Board, in finding the design to be the dominant element, reasoned:

Here, Applicant’s design mark includes the very large, prominently displayed letters RR. The bodies of the Rs are filled with a checkerboard pattern resembling a racing flag. To each R an elongated horizontal “leg” of gradually increasing thickness is appended, each of which ends in a heart design. Inside the legs appear the rest of the letters (i.e., the letter strings “edneck” and “acegirl”), in a form in which the initial letters of each string are displayed in relatively tiny typeface and subsequent letters are displayed in increasing thickness. Together, these graphic devices serve not only to draw attention to the RR letters apart from the wording, **but also make the letters that form the “a-c-e” of the word “RACEGIRL” difficult to notice.**

Id. at 1168 (emphasis added).

Similarly, the font of “K2” in the cited mark is not in easy-to-read lettering. Looking at the marks overall, the number “2” in the cited mark is so highly stylized that consumers are less likely to recognize it as such. Rather, it is more likely to be

perceived as a distinctive design element. Because of this ambiguity, consumers encountering the cited mark are more likely to remember the design comprised of the orange and red griffon shield instead of the stylized letters K2. For these reasons, we find that the design in the cited registration is the dominant element.

Hence, the marks, compared in their entireties, are different in appearance, sound, connotation and commercial impression. We find this *DuPont* factor weighs against finding a likelihood of confusion.

C. The Services

Next, we compare the services as they are identified in the involved application and cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). *See also B&B Hardware*, 135 S. Ct. at 1300 (recognizing that an “applicant’s right to register must be made on the basis of the goods [or services] described in the application”).

The services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant services are used together or

used by the same purchasers; advertisements showing that the relevant services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations for both applicant's services and the services listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). Likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any service that comes within the identification of services in that class. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

To demonstrate that Applicant's and Registrant's identified services are related, the Examining Attorney submitted website evidence demonstrating that it is not uncommon for third-party entities to offer both "Online dealership services featuring automobiles" and "On-line wholesale and retail store services featuring auto parts and accessories thereof; wholesale and retail store services featuring auto parts and accessories thereof." Examples in the record include business-to-consumer websites from BMW, Mercedes, Tesla, Rolls-Royce,⁹ Toyota, Hyundai, Kia, Honda, Subaru.¹⁰ This evidence shows that consumers may expect to find Applicant's online automobile dealership services and Registrant's online store services featuring auto parts and

⁹ January 12, 2021, Office Action, TSDR 10-99.

¹⁰ August 31, 2021, Final Office Action, TSDR 2-30.

accessories as emanating from a common source under a single brand name.

We therefore find that the services are related. Accordingly, this *DuPont* factor also supports a finding of a likelihood of confusion.

D. Trade Channels, and Classes of Consumers

We now consider the established, likely-to-continue channels of trade. Because the identifications in the application and cited registration have no restrictions on channels of trade, we must presume that the services travel in all channels of trade appropriate for such goods. *See Viterra*, 101 USPQ2d at 1908. The evidence noted above shows that the same websites may provide online dealerships and retail sale of auto parts and accessories. In addition, both Applicant's and Registrant's services and goods may be encountered by the same prospective class of consumers, namely, members of the general public seeking automobiles and parts and accessories therefor. As such, the *DuPont* factor regarding the similarity or dissimilarity of established, likely to continue trade channels and class of consumers also favors a finding of likelihood of confusion.

E. Conditions of Purchase

The fourth *DuPont* factor examines the conditions under which the services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73

USPQ2d at 1695.

The purchase of an automobile, auto parts, and auto accessories is not typically made on impulse, given the price and the fact that an automobile is a mode of transportation. Auto parts and accessories are specifically designed by auto manufacturers to meet the designs specifications of individual models, meaning that they are not interchangeable between manufacturers or, for that matter, even models made by the same manufacturer. Consumers also seek parts and accessories that are genuine.

- For example, a 2021 Porsche 718 Boxster from Porsche of Arlington has a MSRP of \$77,920.¹¹ Porsche also offers an online retail site for consumers to “quickly and easily find selected genuine parts for your classic car ...”¹²

- A 2021 BMW 228i Gran Coupe ranges in MSRP from BMW’s online retail site from \$38,095 - \$40,195.¹³ At the BMWpartscenter.com, the public can shop for the “OEM BMW parts and accessories made specifically for your model ... for every BMW model dating back to 1984.”¹⁴

- Even Hyundai branded automobiles, which are on the relatively lower end of the price spectrum, have an MSRP ranging from \$18,750 for a 2021 Urban Compact

¹¹ January 12, 2021 Office Action at TSDR 17 (.pdf format) (excerpt from porsche-arlington.com accessed on January 12, 2021).

¹² January 12, 2021 Office Action at TSDR 29 (.pdf format) (excerpt from porsche.com/usa accessed on January 12, 2021).

¹³ January 12, 2021 Office Action at TSDR 36 (.pdf format) (excerpt from bmwusa.com accessed on January 12, 2021).

¹⁴ January 12, 2021 Office Action at TSDR 36 (.pdf format) (excerpt from bmwpartscenter.com accessed on January 12, 2021).

SUV to \$34,000 for the KONA electric, a significant cost.¹⁵ The same website also touts its offering of genuine Hyundai parts “Guaranteed to fit, Guaranteed to perform and Guaranteed genuine” and warns consumers that the automotive parts market is “full of cheap alternatives” that will negatively impact an auto warranty.¹⁶

The *DuPont* factor of the conditions of sale therefore weighs against a finding of likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (“[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.”).

II. Balancing the *DuPont* Factors

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto.

The record evidence shows that the services are related and that the trade channels and classes of consumers overlap. The dissimilarity of the marks in appearance, sound, connotation and commercial impression coupled with the higher level of care purchasers will exercise for costly services is so great as to outweigh these other *DuPont* factors. Weighing these factors, we find confusion unlikely.

Decision: The Section 2(d) refusal is reversed as to the services in International Class 35.

¹⁵ August 31, 2021 Office Action at TSDR 13-14 (.pdf format) (excerpt from hyundaiusa.com accessed on August 31, 2021).

¹⁶ August 31, 2021 Office Action at TSDR 16-17 (.pdf format) (excerpt from hyundaiusa.com accessed on August 31, 2021).