

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Volvo Trademark Holding AB
v.
Hebei Aulion Heavy Industries Co., Ltd.

—
Opposition No. 91178281
Opposition No. 91178290
Opposition No. 91178297
Opposition No. 91178410
—

Leigh Ann Lindquist of Sughrue Mion PLLC for Volvo Trademark Holding AB.

Robert A. Becker of Fross Zelnick Lehrman and Zissu PC for Hebei Aulion Heavy Industries Co., Ltd.

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Before Grendel, Adlin and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Hebei Aulion Heavy Industries Co., Ltd. (applicant) filed applications to register the mark LOVOL (in standard character form) and the mark set forth below:

The logo consists of the word "LOVOL" in a bold, sans-serif font, enclosed within a thick, black, rounded rectangular border.

for goods identified as follows:

agricultural machines, namely, harvesters; construction machinery, namely, road rollers; earth moving machines, namely, excavators and loaders; bulldozers; concrete mixers; cranes, grain threshing machines; rice transplanting machines, in International Class 7;¹

and

automobiles; land vehicles for transport for agricultural use; motorcycles; rail vehicles, namely, derrick cars; cycle cars; bicycles; electric land vehicles; engines for land vehicles; fork lift trucks; concrete mixing trucks; tractors, in International Class 12;²

Volvo Trademark Holding AB (“opposer”) opposed registration of each mark under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant’s marks, when applied to applicant’s goods, so resemble opposer’s previously used and registered mark VOLVO as to be likely to cause confusion, mistake or deception. Opposer also alleged that applicant’s marks so resemble opposer’s mark as to dilute the distinctive quality of opposer’s mark. Opposer has not pursued this dilution claim.³

Opposer alleged that it is the owner of 20 U.S. registrations of the mark VOLVO in various forms (including those stylized forms set forth below), and of

¹ Application Serial Nos. 78866045 and 78866068, filed on April 20, 2006 on the basis of applicant’s bona fide intention to use the mark in commerce, under Trademark Act § 1(b), 15 U.S.C. § 1051(b).

² Application Serial Nos. 78866057 and 78866077, filed on April 20, 2006 on the basis of applicant’s bona fide intention to use the mark in commerce, under Trademark Act § 1(b), 15 U.S.C. § 1051(b).

³ In an order of May 20, 2009, the Board found that opposer’s dilution claim was “insufficiently pleaded,” and required that “If opposer intends to pursue dilution claims in these consolidated proceedings, it must seek leave of the Board to amend its notices of opposition to add properly pleaded claims thereof.” Opposer did not do so.

Opposition Nos. 91178281; 91178290; 91178297; and 91178410

common law rights in the trademark and trade name VOLVO, as used in connection with automobiles, other vehicles, and various machines.



Applicant denied the salient allegations of the notices of opposition. The Board, acting *sua sponte*, consolidated these proceedings by order of August 9, 2007. The case has been fully briefed.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application files for the opposed marks. The record also includes the following testimony and evidence:

A. Opposer's Evidence.

1. Testimony deposition upon written questions of Monica Dempe, opposer's managing director and trademark manager, with attached exhibits ("Dempe deposition").
2. Notices of reliance upon the following documents:
 - (a) Title and status copies of twenty-one U.S. registrations for marks that consist of or include the designation VOLVO.⁴

⁴ Opposer made of record title and status copies of 21 registrations, of which 20 had been pleaded. Opposer's notices of opposition did not plead ownership of Reg. No. 3070455; accordingly, we have not considered it. In addition, the title evidence relating to Reg. No. 1182050 (which covers "printed matter – namely automobile owners' manuals") indicates that the registration is owned not by opposer, but by Aktiebolaget Volvo; accordingly, we

- (b) Applicant's responses to three of opposer's interrogatories.

B. Applicant's Evidence.

1. Testimony deposition upon written questions of Li Xiao Gao, applicant's deputy chief brand officer, with attached exhibits ("Li deposition").
2. Notices of reliance upon the following documents:
 - (a) Opposer's responses to seven of applicant's interrogatories and one request for admission, and two agreements produced by opposer in response to applicant's requests for production of documents.⁵
 - (b) Excerpts of results of Google searches for the terms "lovol" and "volvo."
 - (c) TARR web server data relating to five U.S. registrations and one pending application owned by third parties.

Standing

Opposer has properly made of record numerous pleaded registrations of its VOLVO marks and has demonstrated its use of the mark VOLVO. Opposer has thus shown that it is not a mere intermeddler and has established its standing to oppose registration of the involved marks of applicant. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). We note also that applicant, in its brief, has conceded opposer's standing.⁶

have not considered that registration. Had we considered these two registrations, it would not have affected our decision in this matter.

⁵ By stipulation of October 12, 2010, the parties agreed that these documents may be made of record in accordance with TBMP § 704.11(7).

⁶ Applicant's Brief at 11, fn. 5.

Priority

In view of opposer's ownership of valid and subsisting registrations of its VOLVO marks, priority is not in issue with respect to the goods and services identified in those registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, applicant has conceded opposer's priority and its ownership of rights in the VOLVO mark.⁷

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

The Fame of Opposer's Mark.

In this proceeding, opposer maintains that its mark is famous and, as such, "deserves... more legal protection than an obscure or weak mark."⁸ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord a famous mark in terms of the wide latitude

⁷ *Id.*

⁸ Opposer's brief at 25.

Opposition Nos. 91178281; 91178290; 91178297; and 91178410

of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Applicant concedes in its brief that “the VOLVO mark is inherently distinctive and that it may also be strong.” However, applicant does not concede fame, stating, “But not every strong mark is a famous mark.”⁹

Opposer’s demonstration of fame rests primarily on evidence of strong sales of its goods and extensive advertising and marketing expenditures, as to which its managing director/trademark manager, Monica Dempe, testified. As to her testimony on this point, we note that Applicant, in a footnote to its brief, raises the suggestion of a hearsay objection: “The absence of documentary evidence in the record to support Ms. Dempe’s cited testimony... raises a hearsay issue and a concern about the accuracy and reliability of the stated figures.”¹⁰ In our view, this vague suggestion does not adequately state an evidentiary objection. Hearsay is an “oral assertion,” a “written assertion,” or “nonverbal conduct” of a person who has not testified. Fed. R. Evid. 801(c). Applicant does not challenge any particular oral assertion, other than those of the witness who testified. Neither does applicant challenge the admission of any particular document. No cognizable hearsay objection arises from applicant’s suggestion. To the extent that it was intended as an evidentiary objection, it is not well taken and is denied.

⁹ Applicant’s brief at 12.

¹⁰ Applicant’s brief at 13, n. 6.

In her testimony, Ms. Dempe stated in dollar figures the annual amount of sales in the United States of products under the VOLVO mark, excluding cars, for the period 1999 through June 2009. Annual sales for full years ranged between \$5.2 billion and \$2.3 billion. For 1997-1998, the dollar figures given included the sale of cars, as that was the form in which the information was available. With respect to cars under the VOLVO mark, she stated the annual unit sales in the United States between 1996 and June 2009. For full years, the unit totals ranged between approximately 124,000 and 73,000. For construction equipment and trucks, separately, she provided annual U.S. sales figures in dollars between 2005 and 2009. For construction equipment, full year figures ranged between \$1.1 billion and \$865 million; for trucks, full year figures ranged between \$2.4 billion and \$1 billion.¹¹

In testimony designated as confidential, Ms. Dempe stated the annual advertising and marketing expenditures for VOLVO products, excluding cars, in the United States between 2005 and June 2009. Because these figures were designated as confidential, we refer to them only in general terms. Separately, she stated the annual advertising and marketing expenditures for VOLVO cars from 2000 through June 2009. She stated that U.S. car dealers handling VOLVO cars expended “as much” as opposer on advertising in any given year. For VOLVO trucks, she stated the annual U.S. expenditures for print advertising between 2005 and 2009. For construction equipment, she stated annual U.S. advertising and marketing

¹¹ Dempe deposition, pp. 31-33.

expenditures between 2004 and 2009.¹² Ms. Dempe's testimony also described, in general terms, the various media through which opposer's goods are advertised,¹³ and the record contains samples of opposer's advertising materials. Opposer's sales and advertising figures are, objectively, substantial.

Applicant criticizes opposer's effort to demonstrate fame, noting that raw statistics, without some meaningful commercial context, make for an inadequate showing. Applicant notes that there is no evidence of actual consumer recognition of opposer's mark; no evidence of how opposer's sales and marketing expenditures compare to others in its industry; and no evidence of opposer's market share.¹⁴

Opposer's showing of its sales and advertising expenditures relating to goods under the VOLVO mark over a substantial period of time is a valid way of indirectly demonstrating the mark's fame. *Bose*, 63 USPQ2d at 1305-1306 and 1309. It is not ideal, because of the lack of additional context pointed out by applicant. However, for purposes of an analysis of likelihood of confusion, we find opposer's showing sufficient to demonstrate that opposer's mark VOLVO enjoys a very high degree of renown in the fields of automobiles, trucks and construction equipment. We need not determine whether opposer has successfully crossed the threshold of "fame," because "fame" is not a required element of opposer's claim (as it would be for a claim of dilution under 15 U.S.C. § 1125(c)). Rather, we find that the renown of

¹² Dempe deposition at 34-37

¹³ *Id.* at 37-39.

¹⁴ Applicant's brief at 13-14.

Opposition Nos. 91178281; 91178290; 91178297; and 91178410

opposer's mark weighs in favor of a finding of likelihood of confusion and affects our balancing of all of the other *du Pont* factors.

The Goods.

Applicant "concedes for purposes of this case that the parties' goods are similar...."¹⁵ Indeed, several of the goods in the applications are identical to goods covered by opposer's pleaded registrations. In the Class 12 applications, applicant's goods include automobiles, fork lift trucks, concrete mixing trucks and tractors. These goods are legally identical to goods in opposer's Reg. Nos. 1220779 (cars, trucks, tractor units, agricultural tractors, dump trucks); 636128 and 636129 (automobiles, truck tractors); 1815680 (automobiles, over the highway trucks and tractors); and 3207372 (cars, trucks, tractors, truck tractors). In the class 7 applications, applicant's goods include agricultural harvesters, and earth moving machines, namely, excavators and loaders. These goods are legally identical to goods in opposer's Reg. Nos. 3207372 (harvesters, excavators, loaders, dumper bodies); and 2794513 (earth moving machines, namely, wheeled excavators, compact wheel loaders, crawler excavators, compact excavators, wheel loaders). When identical goods are at issue, we bear in mind, as urged by opposer, that the degree of similarity of the marks that is necessary to find likelihood of confusion is not as great as where the goods are disparate. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-*

¹⁵ Applicant's brief at 12.

Opposition Nos. 91178281; 91178290; 91178297; and 91178410

Plough HealthCare Products Inc. v. Ing-Jing Huang, 84 USPQ2d 1323, 1325 (TTAB 2007). Accordingly this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Channels of Trade; Customers.

Because the goods at issue are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Clearly the universe of customers for the parties’ goods is very broad and includes members of the general public. There is no evidence to suggest any special degree of sophistication among purchasers of the parties’ goods.

Degree of Consumer Care.

While the goods at issue are to a significant extent identical, applicant contends that the nature of the goods is a factor that weighs against a finding of likelihood of confusion. In particular, applicant contends that the goods of the parties are costly and accordingly would be selected with care.¹⁶ The prices of opposer’s automobiles range from the low to high five figures; the prices of its trucks range from the high five figures to low six figures; the costs of its construction

¹⁶ Applicant’s brief at 24-25.

machines range from low five figures to high six figures.¹⁷ The prices of applicant's goods are in a comparable range. We agree with applicant that such goods are likely to be purchased with significant care by the vast majority of consumers.

In addition, the sales process as described by the parties evidences that consumers may exercise a high degree of care. Opposer's witness testified, "All Volvo products are sold in the U.S. through dealers and distributors. This includes car dealers and distributors, truck dealers and distributors, bus dealers and distributors and dealers and distributors of construction equipment."¹⁸ Applicant argues, "To buy either party's products, a consumer must go to a dealer or a distributor, must interact with a member of a specialized sales force, and must sign a contract. The consumer does not just go into a store aisle, pick up a product, and bring it to the cash register. The general sales model requires assistance, and this minimizes confusion." Applicant further argues that "consumers understand that car dealers and distributors often sell vehicles from many manufacturers. ... [C]onsumers who go to a dealer or car distributor and see numerous brands are not going to believe, simply because all of the cars are sold by the same dealer, that they come from the same source."¹⁹ Opposer has acknowledged that its U.S. dealers and distributors sell other brands beside the VOLVO brand.²⁰

¹⁷ Opposer's supplemental response to applicant's interrogatory No. 1. The figures discussed were designated as confidential.

¹⁸ Dempe deposition at 30.

¹⁹ Applicant's brief at 27-28.

²⁰ Dempe deposition at 30.

To counter applicant's argument, opposer points to internet advertising by automotive dealers (Dempe deposition Exhibit 27), and argues that "Inventory searches are available online, quotes may be received by email, and a car or truck can be shipped directly to the purchasers."²¹ Accordingly, "Purchasers of cars, trucks and other vehicles never have to visit a dealer's showroom."²² A fair reading of the content of Exhibit 27 does not indicate that internet sales of cars and heavy equipment, unmediated by customer contact with sales personnel, constitute a usual channel of trade for such goods; nor does it suggest that the high degree of care that typically attends purchases of costly equipment would be absent from sales transactions that involve the internet. We agree with applicant that the high cost of the parties' goods and the likelihood of customer interaction with sales personnel in the expected trade channels for the goods weigh against a finding of likelihood of confusion.

Other Marks in the Marketplace.

Applicant has adduced evidence intended to demonstrate that opposer has tolerated the existence of other marks that include the formative VOL- as the initial portion of the mark. This evidence is anecdotal at best, and does not provide a meaningful view of the state of the marketplace and "the number and nature of similar marks in use on similar goods." *Du Pont*, 177 USPQ at 576. While we give little weight to this evidence, it does weigh against a finding of likelihood of confusion, if only weakly.

²¹ Opposer's reply brief at 7.

²² *Id.*

The Similarity or Dissimilarity of the Marks.

The remaining question is whether, in the circumstances indicated by the factors discussed above, the marks at issue are sufficiently similar in terms of appearance, sound, meaning, and overall commercial impression to result in confusion, mistake or deception among likely customers.

As to appearance, the two marks resemble each other to the extent that each is five letters long and is composed of a combination of the letters V, O, and L. Moreover, the formative VOL appears in both marks, albeit positioned differently within the respective marks. Visually, however, the marks also differ in a number of ways. As applicant notes, its mark LOVOL is a palindrome: its letters read the same from left to right as from right to left. This lends applicant's mark a visual symmetry that is absent from opposer's mark VOLVO: the beginning and ending L's of applicant's mark balance each other as do the symmetrically placed O's. Applicant also notes that the first letters of the marks differ, as do the last letters.

With respect to sound, we assume that each mark is susceptible to varying pronunciations. For example, in each mark, the letter O in the syllable VOL- might be pronounced long, as in "vole," or short, to rhyme with "all." In applicant's mark, the letter O in the initial syllable might be pronounced long, as in "stove," or short, as in the word "law"; it might also be pronounced to rhyme with "love." Without question, the fact that the two marks share the common letter string VOL creates the possibility that the two marks will have some phonetic similarity. However,

Opposition Nos. 91178281; 91178290; 91178297; and 91178410

otherwise the marks are apparently phonetically different and there is no objective evidence to indicate that their pronunciations would be similar.

With respect to meaning, we note that LOVOL, in itself, has no meaning.²³ Although the mark was derived obliquely from certain Chinese characters, as explained by applicant,²⁴ there is nothing in the mark to apprise the public of that derivation, so it will have no impact on the public's perception of the meaning of the mark. As for VOLVO, we note that some of opposer's registrations indicate that "the term 'VOLVO' means in Latin 'I am rolling.'"²⁵ As Latin is a not a living language, it is questionable whether a substantial segment of relevant customers would be aware of this meaning. To the extent that opposer's mark is perceived as having a meaning, that meaning would tend to distinguish it in the minds of the public from applicant's mark, which has no meaning. We also note that the formative VOLV is suggestive of common English words such as "revolve," and "evolve," and that this suggestiveness may distinguish opposer's mark from applicant's mark, which lacks such a suggestiveness.

Overall, we find it unlikely that customers of normal perceptual abilities would mistake one mark for the other, even if the marks are used in connection with identical goods. We also see no reason why average customers would perceive a relationship or other connection between the two marks, or between opposer and applicant. We have considered whether opposer's prominence in the relevant

²³ Li deposition at 11.

²⁴ *Id.* at 8-11.

²⁵ *E.g.*, Reg. Nos. 636128; 636129; 1159545; and 1220779.

Opposition Nos. 91178281; 91178290; 91178297; and 91178410

marketplace would increase the likelihood that customers would erroneously assume an association or connection of any kind between opposer and the LOVOL mark, but we find such an error unlikely. While it is possible that applicant's mark might call to mind the well-known VOLVO mark, nothing in this record indicates that customers would be likely to experience confusion, mistake or deception within in the meaning of Section 2(d) of the Trademark Act.

Decision: The consolidated oppositions are dismissed with prejudice.