

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 28, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sean Stevens

v.

Valino Tires USA LLC

Cancellation No. 92073974

Kenneth Avila of Making Innovation Count PLLC, for Petitioner
Sean Stevens.

John C. Cain of Munck Wilson Mandala, LLP, for Respondent
Valino Tires USA LLC.

Before Bergsman, Adlin, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Valino Tires USA LLC (“Respondent”) is the owner of record of the registered mark shown below (“VALINO & Design Mark” or “Respondent’s Mark”), issued on the Principal Register for “tires; tires for land vehicles; tires for vehicle wheels; automobile tires,” in International Class 12.¹

¹ Registration No. 5777202 was issued on June 11, 2019, from an underlying application filed on May 15, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C § 1051(b). The registration contains the following description of the mark: “The mark consists of three vertically stacked chevrons representing a tire tread to the left of the stylized word ‘VALINO.’ Color is not claimed as a feature of the mark.”



In his Petition for Cancellation,² Sean Stevens (“Petitioner”) seeks cancellation of Respondent’s registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Respondent’s Mark, as applied to the goods identified in the Registration, so resembles Petitioner’s mark VELLANO FORGED WHEELS³ (“Petitioner’s Mark”), previously used in connection with wheel rims, wheel rims for motor cars, wheel rims for motorcycles, wheels, caps for wheel rims, rims for vehicle wheels, steering wheels, and land vehicle parts, namely, wheels, as to be likely to cause confusion, mistake, or to deceive. Petitioner’s application to register his mark was initially refused registration and suspended based on a likelihood of confusion with Respondent’s Mark.⁴

In its Amended Answer,⁵ Respondent denied the salient allegations of the Petition for Cancellation.

Page references to application records are to the United States Patent and Trademark Office’s (“USPTO” or “Office”) Trademark Status & Document Retrieval (TSDR) system. Citations to the appeal record or briefs are to the publicly available documents in

² Petition for Cancellation, 1 TTABVUE.

³ Petitioner subsequently filed an application to register the standard character mark VELLANO FORGED WHEELS with the U.S. Patent and Trademark Office (USPTO), Serial No. 88543679, filed on July 28, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Petitioner’s claim of first use anywhere and first use in commerce since at least as early as January 1, 2003.

⁴ See Oct. 22, 2019 Nonfinal Office Action, TSDR 1-2.

⁵ 9 TTABVUE.

TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable.

Petitioner bears the burden of proving his Section 2(d) claim for cancellation by a preponderance of the evidence. *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997); *West Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994). Having considered the evidentiary record, the parties' arguments, and applicable authorities, we find that Petitioner has carried this burden. For the reasons set forth below, we grant the Petition.

I. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's involved registration.⁶ Additional evidence introduced into the record is listed below.

A. Petitioner's Evidence

Petitioner submitted an Amended Notice of Reliance,⁷ introducing into the record:

1. A copy of his application Serial No. 88543679 for the mark VELANO FORGED WHEELS and design for "Wheel rims; Wheel rims; Wheel rims for motor cars; Wheel rims for motorcycles; Wheels; Caps for wheel rims; Land vehicle parts, namely, wheels; Rims for vehicle wheels; Vehicle wheel rims; Vehicle wheel rims

⁶ Therefore, neither Petitioner nor Respondent needed to introduce a copy of the involved registration. *See* Petitioner's Amended Notice of Reliance ("Petitioner's Amended NoR"), 19 TTABVUE 14-15; Registrant's Notice of Reliance ("Registrant's NoR"), 21 TTABVUE 15-39.

⁷ 19 TTABVUE. Petitioner's Amended NoR supersedes Petitioner's NoR that was filed on April 6, 2021, located at 13 TTABVUE.

and structural parts therefor; Vehicle wheels; Vehicle parts, namely, steering wheels,” in International Class 12, printed from the USPTO TSDR database (19 TTABVUE 5-7).

- Vellano**
2. A copy of his unpleaded Registration No. 3035094 for the mark (the Vellano Stylized Mark”) (now canceled) for “wheels for automobiles,” in International Class 12, printed from the USPTO TSDR database (19 TTABVUE 9- 10); and
 3. A copy of Respondent’s application Serial No. 87891677 for the mark VALINO TIRES (standard characters) (now abandoned) for “tires; tires for land vehicles; tires for vehicle wheels; automobile tires,” in International Class 12, printed from the USPTO TSDR database (19 TTABVUE 12-13).

In addition, Petitioner submitted the Amended Declaration of Sean Stevens, with exhibits attached.⁸

Petitioner submitted a rebuttal notice of reliance, introducing into the record a copy of Registration No. 4567340, owned by Pioneer Industries Inc., for the mark VELLANO (standard characters) (now canceled), for “faucets,” in International Class 11, printed from the USPTO TSDR database (22 TTABVUE 5-6).⁹

⁸ 20 TTABVUE (“Amended Stevens Decl.”). The Amended Stevens Decl. supersedes the Declaration of Sean Stevens (“Stevens Decl.”), filed on April 6, 2021 and located at 14 TTABVUE, as well as the declaration with redacted exhibits (“Redacted Stevens Decl.”), filed on April 6, 2021 and located at 15 TTABVUE.

⁹ 22 TTABVUE (“Petitioner’s Rebuttal NoR”).

B. Respondent's Evidence

Respondent submitted a Notice of Reliance,¹⁰ introducing into the record:

1. The Declaration of Grace Jennings ("Jennings Decl."), Respondent's Trademark Administrator (21 TTABVUE 7-10);
2. The Declaration of Michael Jiang ("Jiang Decl."), Respondent's Chief Executive Officer (21 TTABVUE 12-13);
3. A copy of the prosecution history for Petitioner's pleaded application printed from the TSDR database (21 TTABVUE 41-75);
4. A copy of the prosecution history for Registration Number 3035094, owned by SPW Industries Inc., for the VELLANO Stylized Mark, printed from the TSDR database (21 TTABVUE 77-95);
5. A copy of the prosecution history for Respondent's Serial No. 87891677 for the mark VALINO TIRES (standard characters) (now abandoned), printed from the TSDR database (21 TTABVUE 97-112);
6. A copy of the prosecution history for Serial No. 77412971, owned by Precision Transducer Systems, Inc., for the mark VELLANO (standard characters) (now abandoned), printed from the TSDR database (21 TTABVUE 114-50);
7. A copy of the webpage "Frequently Occurring Surnames from the 2010 Census," from https://www.census.gov/topics/population/genealogy/data/2010_surnames.html (21 TTABVUE 153);

¹⁰ 21 TTABVUE ("Registrant's NoR").

8. A copy of the webpage “File B: Surnames Occurring 100 or more times,” from https://www.census.gov/topics/population/genealogy/data/2010_surnames.html (21 TTABVUE 155-56);
9. A copy of an excerpt from Whitepages.com search results for “Valino in California” (21 TTABVUE 158-61);
10. Merriam-Webster Dictionary (merriam-webster.com) search results for “valino” (21 TTABVUE 163-64);
11. A copy of the webpage Whitepages.com search results for “Vellano in New York” (21 TTABVUE 166-70);
12. Merriam-Webster Dictionary (merriam-webster.com) search results for “vellano” (21 TTABVUE 172- 73);
13. Printed pages, as of June 15, 2021, from the following websites: American Racing LLC (21 TTABVUE 175-78); Enkei International, Inc. (21 TTABVUE 180- 81); Superior Industries International, Inc. (21 TTABVUE 183- 88); Goodyear Tire & Rubber Company (21 TTABVUE 189-91); Michelin North America, Inc. (21 TTABVUE 193-95); and Firestone. (21 TTABVUE 197); and
14. Declaration of Sean Stevens with exhibits 3, 4, 5, and 8 (declaration superseded) (21 TTABVUE 199-236).

II. The Parties and their Marks

A. Petitioner

Petitioner Sean Stevens is the president of Vellano Forged Wheels (20 TTABVUE 2 ¶ 1; 1 TTABVUE 4). On September 21, 2018, Mr. Stevens, as buyer, executed a “Fixed Assets Purchase Agreement” with seller SPW, Inc., doing business as “Vellano Forged Wheels,”

as the seller (20 TTABVUE 104-09; a copy of two pages of the agreement is below). The agreement purported to sell all of the assets of the entire ongoing business of “Vellano Forged Wheels,” including the “Vellano Forged Wheels name and all associated branding,” to Mr. Stevens (20 TTABVUE 104).

B. Respondent

Respondent Valino Tires USA LLC was formed by Valino Tires International, a Japanese manufacturer of competition tires for “drift racing” (Registrant’s Brief on the Merits (“Respondent’s Brief”) (26 TTABVUE 6)). “Drift racing” or “drifting” is a style of performance automobile racing in which the driver puts a car into “controlled slides, maintaining speed and angle of attack through the curves.”¹¹ Drifting originated in Japan, but the technique has grown explosively in the United States.¹² In response to drift racing enthusiasts in the United States and the growing demand for competition tires, for at least the past three years, Valino Tires USA has offered “high-performance tires directed at the racing and high-performance enthusiast market in the United States” (26 TTABVUE 6).

III. Entitlement to a Statutory Cause of Action¹³

Entitlement to a statutory cause of action is a requirement in every inter partes case.

¹¹ Chris Dixon, *DRIVING; Drifting: The Fast Art of the Controlled Slide*, N.Y. TIMES (May 7, 2004), <https://www.nytimes.com/2004/05/07/travel/driving-drifting-the-fast-art-of-the-controlled-slide.html>.

¹² *Id.*

¹³ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, under the rubric of “standing.” We now refer to this inquiry as “entitlement to a statutory cause of action.” Despite the change in nomenclature, our prior decisions and those of the U.S. Court of Appeals for the Federal Circuit interpreting “standing” under Sections 13 and 14 of the Trademark Act remain applicable. *Chutter, Inc. v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, at *10 n.39 (TTAB 2021) (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020)).

Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, ___ S. Ct. ___, 2021 WL 4507693 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within its zone of interests and it has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating: (1) a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement; and (2) a reasonable belief in damage proximately caused by registration of the mark).



The USPTO cited Respondent’s Mark, , as a bar to the registration of Petitioner’s pleaded application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) (20 TTABVue 122-29). This is sufficient to prove Petitioner’s commercial interest in the proceeding, and is a reasonable basis for Petitioner’s belief of damage as well:

We regard the desire for a registration with its attendant statutory advantages as a legitimate commercial interest. To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit ... or, as here, a rejection of an application.

Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (“Because the USPTO refused Cubatabaco [sic] registration based on a likelihood of confusion with General Cigar’s Registrations, Cubatabaco has a real

interest in cancelling the Registrations and a reasonable belief that the Registrations blocking its application are causing it damage.”). Thus, Petitioner has proven his entitlement to a statutory cause of action.

IV. Priority

Petitioner asserts that he, through his predecessor-in-interest SPW Industries Inc., has used the VELLANO FORGED WHEELS mark in the United States for “Wheel rims; Wheel rims; Wheel rims for motor cars; Wheel rims for motorcycles; Wheels; Caps for wheel rims; Land vehicle parts, namely, wheels; Rims for vehicle wheels; Vehicle wheel rims; Vehicle wheel rims and structural parts therefor; Vehicle wheels; Vehicle parts, namely, steering wheels,” (1 TTABVUE 4 ¶ 6) from a date prior to Respondent’s filing date (May 15, 2018), and from a date prior to the Respondent’s first use of its mark. Respondent, in its brief, contests Petitioner’s assertion of priority (26 TTABVUE 8-10, 19).

It is well-settled that in the absence of any evidence of earlier use, the earliest date upon which Respondent may rely is the filing date of the application underlying the VALINO & Design registration. *See* Trademark Act Section 7(c), 15 U.S.C. § 1057(c); *see also Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995) (discussing *Zirco Corp. v. Am. Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991)). Respondent filed the application which matured into the involved registration on May 15, 2018. Respondent did not introduce any evidence as to its date of first use, so Respondent’s constructive use priority date is May 15, 2018.

In order for Petitioner to prevail on his Section 2(d) claim, first he must prove that he has a proprietary interest in the VELLANO FORGED WHEELS mark, and then he must prove that interest was obtained prior to May 18, 2018. *Herbko Int’l Inc. v. Kappa Books*

Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993) (citing *Zirco*, 21 USPQ2d at 1542). Such rights may be shown by Petitioner's ownership of an application with a filing date (or a registration with an underlying application filing date) prior to May 18, 2018, prior trademark or service mark use, or prior use analogous to trademark or service mark use. *Id.*

Petitioner did not file his application to register VELLANO FORGED WHEELS until July 28, 2019 (19 TTABVUE 5), but claims that use of the VELLANO FORGED WHEELS mark by his predecessor-in-interest SPW Industries Inc. since at least January 2003 inures to his benefit (20 TTABVUE 3 ¶ 4). To corroborate his testimony, Petitioner introduced a copy of the agreement with SPW, Inc. (20 TTABVUE 4, 104-109). The relevant pages of the Fixed Assets Purchase Agreement are reproduced below.¹⁴

¹⁴ Amended Stevens Decl., 20 TTABVUE 104 and 108.

FIXED ASSETS PURCHASE AGREEMENT

This Fixed Assets Purchase Agreement ("Agreement") is made by and among SPW, Inc. ("Seller or Company") and Sean Stevens ("Buyer").

Background:

A. Current Status. Seller owns the entire ongoing business (the "Business") doing business as "Vellano Forged Wheels".

B. Intended Transaction. Buyer desires to purchase the fixed assets of the Business on the terms and conditions set forth in this Agreement.

C. Business Fixed Assets. The fixed assets of the Business (the "Assets") include the following (ITEMS FOR SALE):



2) All office equipment to include furniture, printers, computers and their contained information (software, designs, contracts, financial information including sales history, emails, contacts (both vendor and customer)), as well as advertising and marketing information.

3) All designs, contracts, financial information including sales history, emails, contacts (both vendor and customer), as well as advertising and marketing information not contained within the computers and office equipment listed in #2 (above).

4) All physical inventory of supplies, materials, parts, packaging and sundries, including, but not limited to: centers (blanks, machined, partially machined, defective or otherwise), monoblocks (blanks, machined, partially machined, defective or otherwise), rim halves (finished or unfinished, defective or otherwise), caps, or any other physical items listed as Vellano Forged Wheel/SPW, Inc. property.

5) All intellectual Property of The Company to include all wheel designs, completed or partial, both within the computer systems as well as drawings not stored as such. Any other programs or designs used or owned by SPW, Inc.

6) All marketing and advertising materials (banners, catalogs, and promotional SWAG) and equipment used to produce said advertising to include computers and their software, cameras (both still and video) and any associated items.

7) Vellano Forged Wheels name and all associated branding.

Items specifically excluded from Sale: All pallet racking and the existing forklift.

(f) **Attorneys' Fees.** If any action or proceeding is brought by any party against another under this Agreement, the prevailing party will be entitled to recover from any non-prevailing party an amount as the court or arbitrator may adjudge to be reasonable attorneys' fees, in addition to other fees and costs (including but not limited to expert witness fees).


(g) **Captions; Gender.** The titles and captions in this Agreement are included solely for convenience and will neither constitute a part of this Agreement nor be construed to define, limit or prescribe the scope or intent of the text of the particular areas to which they refer. Whenever the masculine gender is used in the Agreement it will also include the feminine or neuter gender, and vice versa, whenever the context in which the words are used in this Agreement requires or permits.

(h) **Legal Counsel.** The buyer will obtain his own legal counsel, who will not undertake any duties or obligations to Seller or agreed to act or has acted as an escrow agent, tax counsel, business broker or business consultant in connection with this Agreement. The parties represent that each has had the full opportunity to have this Agreement reviewed by its respective legal, tax, Business, financial advisors regarding their implications. This Agreement will be considered a result of the joint efforts and contribution of advisors to all the parties. Any ambiguity will not be attributed to the drafting of the Agreement by one side or another.

(i) **Complete Agreement.** This Agreement and the Security Agreement constitute the entire agreement among the parties concerning the subject matter of this Agreement. This Agreement may be altered amended modified or extended only in a writing signed by all the parties. No waiver of any provision of this Agreement will be valid unless that waiver is made in writing by the waiving party.

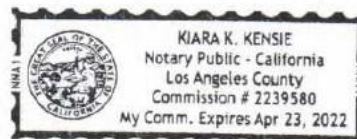
IN WITNESS WHEREOF, the parties hereto have executed this Agreement as of the dates set forth opposite their names.

Date: 21 SEP 2018


By Chul W. Cho, President of SPW, Inc.

Date: 21 Sep 2018


Sean K. Stevens



⌘ Please see attached

There appears to be a gap in the evidence regarding the chain of title. The face of the Fixed Assets Purchase Agreement shows that SPW, Inc., the “seller,” was doing business as “Vellano Forged Wheels” at the time the agreement was executed. But during discovery and in his brief, Petitioner continuously refers to his “predecessor in interest” as “SPW Industries Inc.”¹⁵

To address this gap in the evidence, Petitioner relies on the now canceled registration for the VELLANO Stylized Mark, previously owned by an “SPW Industries Inc.” of Los Angeles, California, in an apparent attempt to connect the prior use and ownership of the VELLANO Stylized Mark with the use and ownership of the VELLANO FORGED WHEELS mark. But a canceled or expired registration has no probative value other than to show that it once issued, and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] canceled registration does not provide constructive notice of anything.”); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(d)] presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”). In any event, the registration is unhelpful in and of itself, as it doesn’t explain the relationship, if any, between SPW, Inc. and SPW Industries Inc.

We note that the arguments in Petitioner’s brief and some of the documents Petitioner produced are inconsistent with the face of the Fixed Assets Purchase Agreement.

¹⁵ See Petitioner’s NoR, 13 TTABVUE 3 ¶ 2; Redacted Stevens Decl., 15 TTABVUE 2 ¶ 4; Petitioner’s Amended NoR, 19 TTABVUE 3 ¶ 2; Amended Stevens Decl., 20 TTABVUE 3 ¶ 4; Petitioner’s Brief, 23 TTABVUE 9.

Cumulatively, however, as discussed below, Petitioner's trial evidence is sufficient for us to find that the entities discussed here are related for purposes of priority.¹⁶

The face of the Fixed Assets Purchase Agreement shows that the seller is SPW, Inc., doing business as "Vellano Forged Wheels." Petitioner testifies that his predecessor-in-interest is SPW Industries Inc.¹⁷ While his testimony is unexplained, it is also uncontradicted, and therefore, we accept it. Furthermore, Petitioner entered into the record packing lists from the year 2008 showing that Petitioner's goods — some sold under the "Vellano" mark — were sent from "Vellano Forged Wheels" to various customers across the United States (20 TTABVUE 3 ¶ 5, 8-32). Petitioner entered into the record redacted annual financial statements for "Vellano Forged Wheels" for calendar years 2008 through 2020 (20 TTABVUE 3-4 ¶ 6, 33-74). Petitioner also entered into the record evidence such as screen shots of pages from his YouTube account taken on March 18, 2021, featuring thumbnails of product videos captioned "Vellano Forged Wheels" dating back to March 2013 (20 TTABVUE 92-93); an advertisement for VELLANO FORGED WHEELS from the June 2012 issue of *Rides-Mag.com* (20 TTABVUE 101-02); an advertisement for VELLANO FORGED WHEELS from the December 2012 issue of *Excellence* magazine (20 TTABVUE 97-98); an advertisement for VELLANO FORGED WHEELS from the September 2013 *duPont Registry* (20 TTABVUE 95- 96); Specialty Equipment Market Association ("SEMA") trade show expense sheets for fall 2008 (20 TTABVUE 5 ¶ 13, 114-15), and SEMA 2006 trade show registration documents (20 TTABVUE 5 ¶ 13, 111-12) along with a photo of the "Vellano Forged Wheels" booth at SEMA dating back to October

¹⁶ *Id.*

¹⁷ *Id.*

31, 2006 (20 TTABVUE 5 ¶ 13, 113). Nothing in the record shows that the packing lists, financial statements, and trade show documents are from an entity unrelated to “SPW, Inc.,” “SPW Industries Inc.,” or “Vellano Forged Wheels.”



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¹⁸ Amended Stevens Decl., 20 TTABVUE 97.



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Clearly, Petitioner views SPW, Inc. and SPW Industries Inc. as one in the same, and has introduced evidence which reveals a basis for his position, while Respondent has not

¹⁹ *Id.* at 96.

called Petitioner's position into question. More to the point, Respondent has not contradicted the evidence that Petitioner has priority of use through its predecessor. So based on this record, and in the absence of contradictory evidence, we find that Petitioner's predecessor-in-interest — SPW — first used VELLANO FORGED WHEELS as a trademark well before Respondent's May 15, 2018 constructive use date for the VALINO & Design Mark. Therefore, Petitioner has established priority of use of the VELLANO FORGED WHEELS mark for wheels and wheel rims ("rims").

V. Likelihood of Confusion

Turning to the merits of Petitioner's likelihood of confusion claim, our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162- 63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See 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 and differences in the marks.").

"Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3

(Fed. Cir. 2020). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

A. The Similarity or Dissimilarity and Nature of the Goods

First, as to the goods, we must determine whether consumers would mistakenly believe the parties’ goods emanate from the same source. In this regard, we look to the identification of goods in Respondent’s registration, as well as any goods for which Petitioner has established prior use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to the source of the goods. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”).

It is sufficient that the goods of the Petitioner and the Respondent are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See Coach Servs., Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d

1715, 1724 (TTAB 2007)); *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000).

Respondent argues that consumers would not view the parties' goods as emanating from the same source, inasmuch as tires, wheels, and rims are "rarely, if ever marketed under the same mark" (26 TTABVUE 16). Instead, to show that tires and wheels are not offered under the same mark, Respondent proffered pages from websites such as American Racing LLC; Enkei International, Inc.; Superior Industries International, Inc.; Goodyear Tire & Rubber Company; Michelin North America, Inc.; and Firestone (21 TTABVUE 175-97). All of these websites show tires — not wheels or rims — being offered for sale. At the same time, however, the American Racing, Enkei, Goodyear, Michelin, and Firestone webpages also feature photographs clearly showing tires mounted on wheels (and, necessarily, rims). In addition, Respondent's Instagram page features a photo of wheels, rims, and tires together (*see* 21 TTABVUE 235). Thus, the wheels, rims, and tires are used together.

Petitioner argues that the "parties' goods are confusingly similar" (23 TTABVUE 17), pointing to the third-party website evidence offered by the Examining Attorney in a nonfinal Office Action refusing Petitioner's involved application under Trademark Act § 2(d), based on likelihood of confusion with Respondent's Mark. In the Office Action, the Examining Attorney entered into evidence the websites for tirerack.com (20 TTABVUE 130), discounttire.com (20 TTABVUE 131), tiresandhweels.com (20 TTABVUE 132), and realtruck.com (20 TTABVUE 133), to demonstrate that Petitioner's and Respondent's goods are related. All of the websites offer tires, wheels, and rims under their respective marks. In rebuttal, Respondent argues that such evidence is

of little probative value since the websites are for stores which offer a wide variety of goods and services (26 TTABVUE 16).

We find Petitioner's and Respondent's goods to be complementary, based on the website evidence from the nonfinal Office Action refusing Petitioner's Mark, which clearly shows tires, wheels, and rims being offered together at the same websites, as well as the aforementioned evidence from Respondent's Notice of Reliance which shows tires, wheels, and rims being used together. *See, e.g., In re Sela Prods., LLC*, 107 USPQ2d 1580, 1587 (TTAB 2013) (finding purchasers likely to encounter both surge protectors, and wall mounts and brackets, during course of purchasing a television, audio or home theater system). Overall, we find this evidence to be probative of relatedness: consumers of tires are likely to be exposed to wheels and rims upon which tires could be mounted, and vice versa. *See, e.g., Jetzon Tire & Rubber Corp. v. Gen. Motors Corp.*, 177 USPQ 467 (TTAB 1973) (finding automobiles and vehicle tires complementary). *Cf. In re Gen. Motors Corp.*, 23 USPQ2d 1465, 1468 (TTAB 1992) (automotive parts and tires are closely related); *In re Jeep Corp.*, 222 USPQ 333, 334 (TTAB 1984) (finding similar marks for vehicles and tires are likely to cause confusion in part because it has frequently been found that similar marks for vehicular parts, including tires, are likely to cause confusion); *Gen. Motors Corp. v. Pac. Tire & Rubber Co.*, 132 USPQ 562, 564 (TTAB 1962) (finding an obvious relationship between automotive vehicles and tires and tubes). Petitioner's goods and Respondent's goods are related. This *DuPont* factor weighs in favor of a finding of likelihood of confusion.

B. Channels of Trade

There are no limitations as to trade channels or classes of purchasers in the Petitioner's application or Respondent's registration, so it is presumed that the parties' marks encompass all goods of the type described (tires and wheels of any type), that the goods move in all normal trade channels for those goods, and that the goods are available to all classes of purchasers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018). We find that the website evidence previously discussed shows that tires, wheels, and rims are offered in the same trade channels to the same classes of purchasers. This *DuPont* factor weighs in favor of a finding of likelihood of confusion.

C. Degree of Consumer Care

Next, we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration (i.e., consumer purchasing care). Purchaser sophistication or degree of care when encountering marks may minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items where consumers pay little attention to the source of the products may tend to have the opposite effect. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005).

Petitioner argues that the purchasers of both parties' goods "likely do not exercise exceptional care in selecting their merchandise and ensuring its origin" (23 TTABVue 19). Petitioner further argues that both parties' goods are "relatively inexpensive" goods primarily marketed to automobile enthusiasts. *Id.*

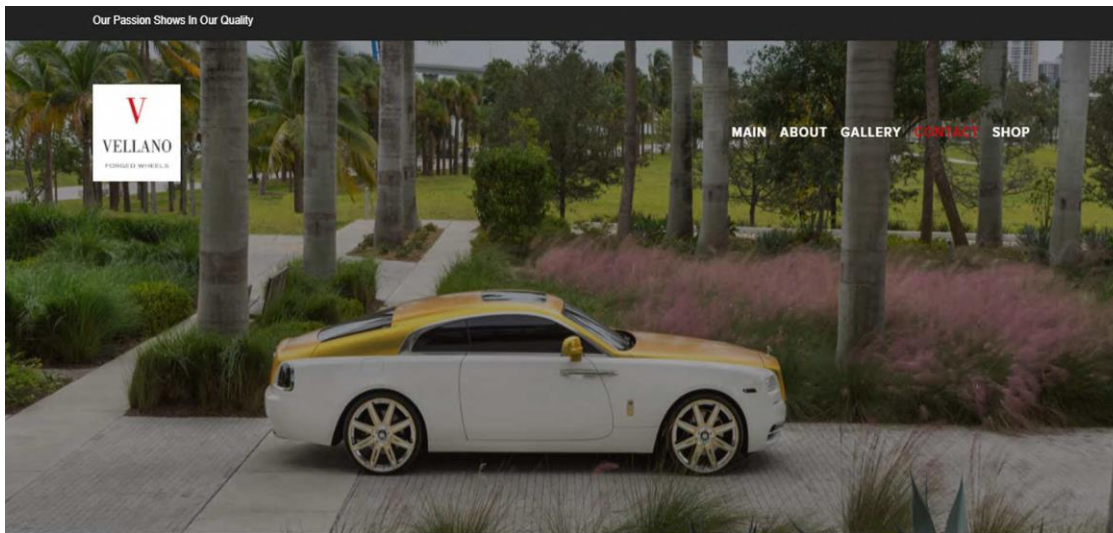
In contrast, Respondent asserts that its goods are high performance tires specifically marketed to drift racing competition enthusiasts (26 TTABVue 17), but its description of

goods has no such restriction or limitation. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). In considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the Respondent's actual goods, customers, or channels of trade. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983)). We do not read limitations into the identification of goods. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *47 (TTAB 2020). Therefore, we must assume that Respondent's goods could include tires for lawnmowers, bikes, and wheelbarrows, for example, rather than just specialized drift racing automobiles.

The evidence of record shows that Petitioner's wheels and rims are "forged"²⁰ and marketed as a luxury item (26 TTABVUE 18), each wheel and rim combination being "custom built to your specifications" (21 TTABVUE 232). The evidence of record is also

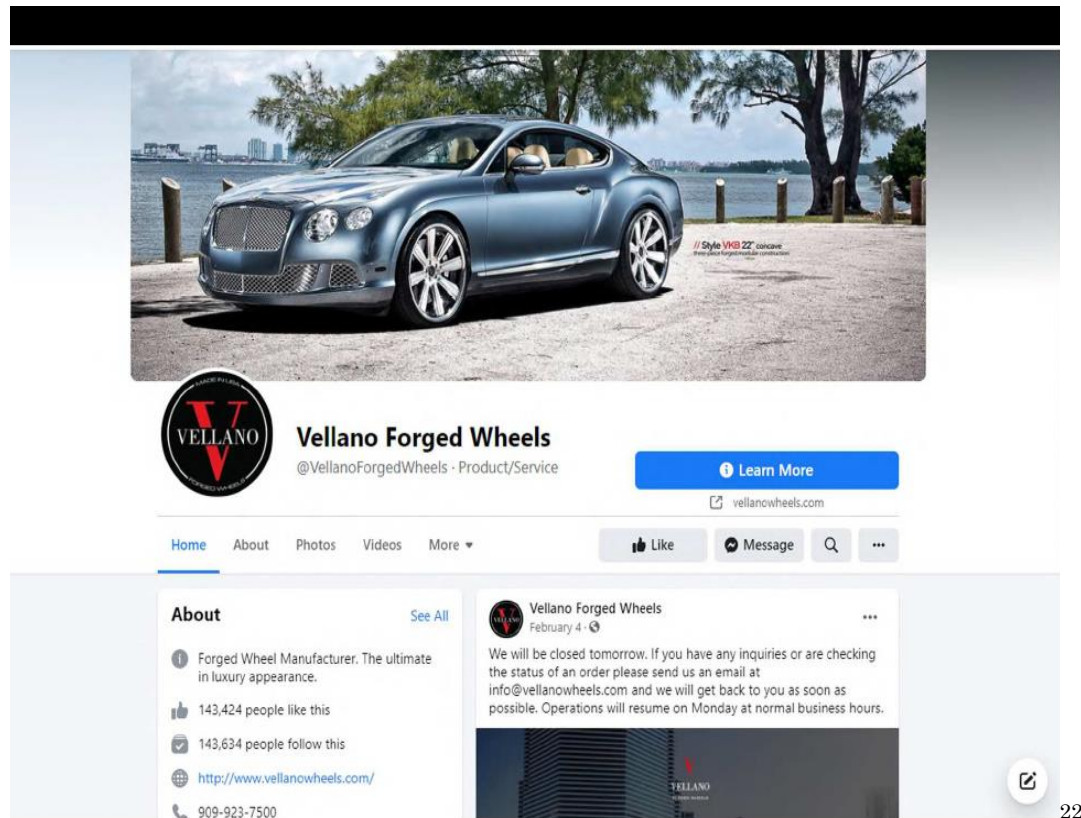
²⁰ We take judicial notice that the adjective "forged" means "formed by pressing or hammering with or without heat, *especially*: made into a desired shape by heating and hammering." MERRIAM-WEBSTER DICTIONARY (2022) (<https://www.merriam-webster.com/dictionary/forged>) (last accessed Feb. 9, 2022). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

highly probative of the specialized nature of Petitioner's goods. *See In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (Board used evidence in the record to find that purchasers would exercise a high degree of care in making decisions to purchase trucks and recreational vehicle towable trailers, even though neither the applicant nor the examining attorney presented evidence regarding the degree of consumer care). "Forged wheels" are exclusive automotive aftermarket products. *See infra* note 26. Petitioner's wheels and rims are advertised in the *duPont Registry*, a publication which specializes in goods such as luxury automobiles, luxury real estate, and yachts (20 TTABVUE 96). In addition, Petitioner's wheels and rims, which are custom made, are shown in advertising, on social media pages, and on high-end luxury vehicles such as Rolls Royce, Bentley, Mercedes AMG, Maserati, Audi, Range Rover, Aston Martin, Ferrari, and Lamborghini (*see* 20 TTABVUE 75-102). These vehicles are typically advertised to sophisticated purchasers at a price point that would cause such purchasers to exercise an extremely high degree of care when making purchasing decisions.



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²¹ Amended Stevens Decl., 20 TTABVUE 80 (cropped webpage).



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The overlap between the Petitioner's purchasers and Respondent's purchasers are purchasers of forged, custom built, luxury wheels and rims who also purchase tires. Accordingly, due to the fundamental nature of the Petitioner's wheels and rims which may be used with Respondent's tires, and their common purchasers, we find that such purchasers are more likely to exercise a high degree of purchasing care when making purchasing decisions for Petitioner's goods. Overall, we find that Petitioner's wheels and rims are directed to a purchaser who would exercise a much higher degree of care than an average purchaser of wheels and rims, and as a result, the high degree of care exercised by these purchasers weighs against a finding of likelihood of confusion.

²² *Id.* at 82 (cropped Facebook page).

D. The Strength of Petitioner's Mark

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself, and its commercial strength, based on the marketplace recognition of the mark. *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 (distinctiveness) and its marketplace strength (secondary meaning).”); *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); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. Dec. 2021 Update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use.[] The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

For purposes of analysis of likelihood of confusion, a mark’s renown “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). The proper standard is the mark’s “renown within a specific product market,” *id.*, and “is determined from the viewpoint of consumers of like products,” *id.* at 1735, and not from the viewpoint of the general public.

Petitioner argues that the VELLANO FORGED WHEELS mark is inherently distinctive and “has further acquired distinctiveness” due to extensive use by Petitioner “continuously and exclusively since at least 2004” (23 TTABVUE 18-19). Petitioner further asserts that the

word “VELLANO” is arbitrary as applied to wheels and rims, because it does not describe or suggest anything about the goods (23 TTABVUE 18-19).

Respondent does not argue, specifically, that Petitioner’s Mark is conceptually or commercially weak. The record is devoid of any registrations incorporating the words “VELLANO” or “FORGED WHEELS” for wheels, rims, or related goods. In addition, there is no evidence of marketplace use of third-party marks similar to Petitioner’s for wheels, rims, or related goods. However, the Examining Attorney has refused the registration of Petitioner’s Mark subject to a disclaimer of “FORGED WHEELS,”²³ and the term “FORGED WHEELS” is merely descriptive of a type of aluminum wheel that is very dense, strong, and light.²⁴

Respondent does argue, however, that the parties’ marks are entitled to a “narrower scope of protection” because both marks are primarily merely surnames, or that they have the “look and feel” of surnames (26 TTABVUE 14-15). Therefore, Respondent posits, both marks can coexist without creating a likelihood of confusion. *Id.*

In support of its argument that “Vellano” is a surname, Respondent entered into the record summary results from the Whitepages.com database for a search of the word “Vellano” that generated over 100 records for 14 cities in the state of New York (21 TTABVUE 166-70), a Merriam-Webster.com Online Dictionary search result page showing the absence of an entry for “vellano” (21 TTABVUE 172-73), and the application file for the mark VELLANO, Serial No. 77412971 (now abandoned), filed by Precision Transducer Systems, Inc. of Ontario, California (21 TTABVUE 114-51). As to the

²³ See *infra* note 26.

²⁴ *Id.*

application, an abandoned one has “no probative value other than as evidence that the application was filed.” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010) (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)). However, the remaining evidence of record supports our finding that “Vellano” is a surname. Generally, without evidence of acquired distinctiveness, surnames are conceptually weak and only entitled to a narrow scope of protection. *Compare Chase Fed. Sav. & Loan Ass’n. v. Chase Manhattan Fin. Servs., Inc.*, 681 F.Supp. 771, 784 (S.D. Fla. 1987) (where no secondary meaning was shown, “CHASE,” a “common surname,” was found to be an inherently weak mark “deserving only a narrow range of protection.”), with *G.H. Tennant Co. v. Wyandotte Chemicals Corp.*, 154 USPQ 453, 455 (TTAB 1967) (after opposer’s long and extensive use of the surname “TENNANT” for its floor maintenance products, mark had acquired distinctiveness and was not weak). *See also Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1447 (TTAB 2014) (“a surname such as WINSTON would **ordinarily suffer some inherent weakness** as a source identifier,” but WINSTON had secondary meaning in the field of jewelry, making it a “strongly distinctive” trademark) (emphasis added); *In re Martin’s Famous Pastry Shoppe, Inc.*, 221 USPQ 364, 367 n.6 (TTAB 1984) (“[S]urnames have not been regarded as weak marks **once statutory surname issues have been resolved.**”) (emphasis added). Yet the fact that “Vellano” is a surname does not automatically render Petitioner’s entire mark weak or only entitled to a narrow scope of protection. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1639 n.20 (TTAB 2007).

To prove the commercial strength of his mark, Petitioner introduced his testimony declaration regarding his and his predecessor-in-interest’s significant sales and

advertising figures for VELLANO FORGED WHEELS branded products in this country since at least 1988 (20 TTABVUE 3-4, 33-74), lists of sales of VELLANO FORGED WHEELS branded products by customer since 1988 (20 TTABVUE 33-74), the VELLANO FORGED WHEELS website and social media asset pages (i.e., account pages) (20 TTABVUE 75-93, 99-100), and magazine advertisements for VELLANO FORGED WHEELS branded products (20 TTABVUE 96-97, 102). And, as previously discussed, we find that Petitioner's use of the VELLANO FORGED WHEELS trademark, through his predecessor-in-interest, has been exclusive since long before Respondent's constructive use date.²⁵

We note, however, that the sales and advertising figures and customer sales lists are of limited probative value inasmuch as the record lacks information about business customer type, sales volumes, or advertising dollars spent for Petitioner's forged wheels and rims in the United States. *See, e.g., Anthony's Pizza & Pasta Int'l v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 F. Appx 222 (Fed. Cir. 2010) (telephone directory listings for restaurants listed under variations of the name "Anthony's" were of limited probative value because they did not demonstrate that the public was aware of the businesses, their customers, or areas of trade). Likewise, the screenshots of pages from Petitioner's YouTube channel and the number of followers of Petitioner's Facebook and Instagram pages are of limited probative value inasmuch as the record lacks information about the number of his YouTube channel subscribers and Facebook and Instagram followers in the United States. *See, e.g., id.*

²⁵ *See supra* p. 17.

Accordingly, we find that Petitioner's Mark is conceptually weak when used in connection with Petitioner's wheels and rims. With respect to commercial strength, Petitioner's Mark falls in the middle of the spectrum from very weak to very strong. Thus, the mark is entitled to a somewhat normal scope of protection. This *DuPont* factor weighs in Petitioner's favor.

E. The Similarity or Dissimilarity of the Marks

Next, we consider the *DuPont* factor relating to the similarity of the marks. In comparing the marks, we must consider their appearance, sound, connotation, and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. Similarity as to any one of these factors may be sufficient to support a finding that the marks are confusingly similar. *See Krim-Ko Corp. v. Coca-Cola 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."); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.") (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. Sept. 13, 2019)).

"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." *In re i.am.symbolic*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs.*, 101 USPQ2d at 1721).

We must focus our analysis on the recollection of the average purchaser — here, consumers of wheels and tires — who normally retain a general, rather than specific,

impression of trademarks. We remain mindful that “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side-comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).


When evaluating a composite mark consisting of words and a design, like Respondent’s Mark, the literal elements are normally accorded greater weight because they are likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Vitterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). So even though we evaluate Petitioner’s Mark and Respondent’s Mark by considering them in their entirety, we consider the literal, or verbal, elements of the marks to be the dominant features, and accord greater weight to such portions. *Vitterra*, 101 USPQ2d at 1911. There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *Id.* at 1908; *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In analyzing the similarity or dissimilarity of the marks, descriptive matter is often “less significant in creating the mark’s commercial impression,” *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001), and may be given little weight. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). Consumers are also more likely to remember the more distinctive elements of a mark. For that reason, we place less weight on descriptive (or generic) terms found in multi-word marks. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25

(TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

Petitioner's Mark, VELLANO FORGED WHEELS, is in standard characters. Marks presented in standard characters are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording, and not in any particular display. Petitioner's Mark might be depicted in any manner, regardless of the font style, size, or color. Accordingly, we must assume that Petitioner could display his mark in a stylization similar to that of the Respondent's Mark. *Aquitaine Wine*, 126 USPQ2d at 1186 (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citation omitted); *see also SquirtCo*, 216 USPQ at 939.



Turning to the Respondent's Mark, , as a whole, the mark features the word “VALINO” in bold, stylized typeface to the right of three vertically stacked chevrons which represent a tire tread.

We acknowledge that there are differences in sound and appearance between the marks due to the addition of the term “FORGED WHEELS” in Petitioner's Mark, as well as the prominent lead position of the tire tread design in Respondent's Mark. However, we find that the marks are more similar than dissimilar, largely due to the literal elements of both.

As previously discussed, greater weight is often given to the literal elements of marks because it is the wording that purchasers use to refer to or request the goods. *See Viterra*, 101 USPQ2d at 1911. Here, based on our taking judicial notice of the dictionary definition of “forged,” and the evidence (which uses the term “forged wheels” descriptively) included

in the prosecution history of Petitioner's application to register his mark (*see* Oct. 22, 2019 Nonfinal Office Action, TSDR 9-10), we find that "VELLANO" is the dominant element of Petitioner's Mark, given the descriptiveness of the term "FORGED WHEELS,"²⁶ and given that "VELLANO" is the first element of the mark. *See Palm Bay*, 73 USPQ2d at 1692 (consumers more likely to note and remember first term in a multi-word mark). Also, "VELLANO" and "VALINO" are three syllable names that begin with the letter "v" and end with "no." Respondent argues that the "I" in "VELINO" and the "A" in "VELLANO" distinguish the marks because the vowels are pronounced differently, regardless of regional dialect (26 TTABVUE 13). However, "there is no correct pronunciation of a trademark." *Viterra*, 101 USPQ2d at 1912.

In short, we find Respondent's "VALINO" and Petitioner's "VELLANO" to be structurally, visually, and aurally similar, thereby resulting in similar overall commercial impressions of Petitioner's Mark and Respondent's Mark. This *DuPont* factor weighs in Petitioner's favor.

²⁶*See All Wheels Are Round Or Are They?*, (<https://www.tirerack.com/tires/tiretech/techpage.jsp?techid=90>), Amended Stevens Decl., 20 TTABVUE 134 ("The ultimate in one-piece wheels, Forging is the process of forcing a solid billet of aluminum between the forging dies under an extreme amount of pressure. This creates a finished product that is very dense, very strong and therefore can be very light. The costs of tooling, development, equipment, etc., make this type of wheel very exclusive and usually demand a high price in the aftermarket."). *See also What Are Forged Wheels and Why You Don't Need Them*, (<https://medium.com/@DriveSlate/what-are-forged-wheels-and-why-you-dont-need-them-42d57b585a5c>), Oct. 22, 2019 Nonfinal Office Action at TSDR 10 ("When looking for aftermarket wheels, there are only 2 types of wheels you will consider: cast or forged. ... [I]f you're in the market for just after market wheels you can daily drive ... you probably don't need to spend the extra 2 grand on forged wheels.").

Petitioner states that the Office has asked him to disclaim the term "FORGED WHEELS" in the application to register VELLANO FORGED WHEELS, Serial Number 88543679 (23 TTABVUE 15). *See also* Amended Stevens Decl., 20 TTABVUE 122-26 (office action). As of the date of this opinion, Petitioner has not disclaimed the term "FORGED WHEELS."

F. Lack of Actual Confusion

In addition to the foregoing factors, Respondent raised the *DuPont* factor relating to a lack of actual confusion, arguing that it is unaware of any instances of confusion between its mark and Petitioner's Mark (26 TTABVUE 18). Under this *DuPont* factor, we consider "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion." *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, *19 (TTAB 2020) (quoting *DuPont*, 177 USPQ at 567).

The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Respondent of its mark for a significant period of time in the same markets as those served by Petitioner under his mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.").

Respondent has offered its tires and related goods in the United States only since November 15, 2018 (21 TTABVUE 12), and its uncorroborated statement of no known


instances of actual confusion, without evidence of sales, marketing, or advertising, is of little evidentiary value. *See Majestic Distilling*, 65 USPQ2d at 1205 (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value.”). Under such circumstances, the lack of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). Petitioner, who has offered wheels and rims in the United States (through his predecessor-in-interest) long before Respondent, has not entered any evidence of actual confusion into the record. Therefore, this *DuPont* factor is neutral.

G. Any Other Established Fact Probative of the Effect of Use

Finally, to clarify the record, Respondent argues that Petitioner submitted evidence in his Amended Notice of Reliance showing the activities of Valino Tires International, and not Respondent Valino Tires USA LLC. Specifically, the evidence is a page from the Facebook account of Valino Tires International, written in Japanese and showing automobile wheels offered for sale (20 TTABVUE 117). Respondent argues that the evidence proffered by Petitioner shows activities targeted to consumers in non-U.S. markets, and as a result, is irrelevant to this proceeding (26 TTABVUE 18). We agree, and therefore decline to consider this evidence. This *DuPont* factor is neutral.

VI. Conclusion

After considering all of the evidence and arguments, on this record, we find that confusion is likely between Petitioner’s VELLANO FORGED WHEELS mark and

Respondent’s  mark, despite the high degree of care that purchasers may exercise when purchasing the goods. The marks are similar in sound and appearance, the

goods are complementary, and the channels of trade are without limitation. These factors outweigh any consumer sophistication or care in purchasing. *See Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweighed sophisticated purchasers, careful purchasing decisions, and expensive goods).

Decision: The Petition is granted.