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

Proceeding	77653767
Applicant	Nitro AG
Applied for Mark	NITRO
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APPLICANT: Nitro AG  
MARK: NITRO  
SERIAL NO.: 77653767  
FILING DATE: February 26, 2015  
CLASS: 25

EXAMINING ATTORNEY: Brian Pino  
LAW OFFICE: 114

**APPLICANT’S APPEAL BRIEF**

Applicant Nitro AG (“Applicant”) requests reversal of the Trademark Office’s refusal under Section 2(d) of the Lanham Act to register the mark NITRO for *clothing, namely outerwear for use in snowboarding, namely insulated jackets, beanies, hats, pants, gloves, and mittens; snowboard boots* in International Class 25 (“Applicant’s Mark”).

**I. FACTS**

On January 21, 2009, Applicant filed a use-based application to register the mark NITRO for *clothing, namely outerwear for use in snowboarding, namely insulated jackets, beanies, hats, pants, gloves, and mittens; snowboard boots*. On December 17, 2013, the USPTO issued an office action refusing registration of Applicant’s Mark under Section 2(d) of the Lanham Act (“Non-Final Office Action”) relying on U.S. Registration No. 4,187,221 NITRO for *protective helmets for motorcycle riding; motorcycle helmets; protective clothing and footwear for protection against accidents; protective clothing and footwear for protection against motorcycle accidents; protective motorcycle suits for protection against accidents; gloves for protection against accidents* (“Cited Mark”), owned by Lloyd IP Limited (“Registrant”).

Applicant responded to the Non Final Office Action on June 16, 2014, arguing there was no likelihood of confusion between the respective marks because, among other things: (1) the Cited Mark's scope of protection is narrow due to the Registrant's own admissions, and because it already co-exists with other marks involving the term NITRO for goods and services related to motorcycles; (2) the Examining Attorney failed to consider the relatedness of the fields of use of the goods involved; and (3) the goods of Applicant and Registrant are completely different in their nature and function, making confusion unlikely.

The USPTO issued a final refusal on June 27, 2014 ("Final Office Action"). Applicant filed its Notice of Appeal to the Board on December 29, 2014, and respectfully submits this appeal brief for the Board's consideration.

## **II. ISSUE**

The only issue before the Board is whether Applicant's Mark is confusingly similar to the Cited Mark.

## **III. ARGUMENT**

Likelihood of confusion is determined by weighing the well-known factors set forth in *E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Applicant respectfully submits that the following factors demonstrate that consumer confusion is unlikely: (1) the crowded field for NITRO-formatives in clothing; (2) the dissimilarity of the goods; and (3) the dissimilarity of the trade-channels.

### **A. The Crowded Field of NITRO-Formative Marks for Clothing Entitles the Registrant to a Narrow Scope of Protection, as the Registrant Itself Has Acknowledged.**

The relative strength of a mark is relevant to the likelihood of confusion inquiry. *Sun Banks of Florida, Inc. v. Sun Federal Savings & Loan Assoc.*, 651 F.2d 311, 315 (5th Cir. 1981)

(strength or weakness of a mark is “a vital factor” in the likelihood of confusion determination). Indeed, the similarity of two marks cannot be properly evaluated without first considering the relative distinctiveness of the senior mark. In such an analysis, evidence of third party registrations that include an identical word for similar goods or services is probative of a given mark’s distinctiveness. *Id.*; *ABC Consolidated Corporation v. Chandler*, 170 U.S.P.Q. 417, 421 (T.T.A.B. 1971) (“third party registrations are admissible as evidence to show that a mark may be a ‘weak’ mark thus resulting in a narrowing of a party’s rights therein...”).

Here, the Cited Mark was itself the subject of a refusal based on several then-existing senior marks, including a registration for NITRO (U.S. Reg. No. 1,467,490) covering “Clothing, namely pants, jackets, sweaters, shirts, blouses, skirts, dresses and shorts.” To overcome that refusal, the Registrant conceded a narrow scope of protection, and expressly admitted that its goods “relate specifically to motorcycle products and accessories, and are distinctly different from the general category of clothing...As a result, [Registrant’s] goods are likely to be sold through different sales channels as well as to attract different types of consumers.” (Registrant’s Response to Office Action dated April 5, 2007.) Three years after making those concessions, Registrant reiterated the specialized nature of its goods to distinguish itself from another mark, NITRO SYNDICATE (U.S. Reg. No. 3,544,186) covering “T-Shirts and jackets sold in connection with motorcycle drag racing events” amongst other goods. In explaining how niche its products are, even within the motorcycle industry, Registrant stated:

“In particular, Applicant’s NITRO mark is *used to identify sophisticated motorcycle protective clothing and gear. Such gear is purchased at specialty outlets by discerning riders for use in connection with recreational motorcycling.* By contrast, the cited NITRO SYNDICATE mark is used in connection with inexpensive goods used in promoting a very particular type of motorsport event and sold through relevant merchandise outlets.” (emphasis added). (Registrant’s Response to Office Action dated May 21, 2010.)

The file history of the Cited Mark reflects these statements and underscores the purposefully limited nature of Registrant's rights. Registrant deleted all of its class 25 goods – “motorcycle clothing, footwear and headgear; motorcycle riding suits; motorcycle jackets; motorcycle trousers; motorcycle boots; motorcycle waterproof clothing” – to emphasize the differences between itself and the NITRO (Reg. No. 1,467,490) and NITRO SYNDICATE (Reg. No. 2,554,186) goods, and achieve registration. (Registrant's Response to Office Action dated May 21, 2010.)

If Registrant successfully argued before the USPTO that no likelihood of confusion exists between NITRO and NITRO SYNDICATE for covering overlapping motorcycle-related goods, then it should not now enjoy a broad scope of rights that would block Applicant's registration for even more unrelated snowboarding goods. Accordingly, Applicant's Mark should be accepted for publication.

**B. The Goods Are Completely Different Because they are Specialized for Their Unique Functions.**

When two users of the same or similar marks are operating in different product markets, “consumers are less likely to assume that their similarly branded products come from the same source.” *See, e.g., Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 150 (2d Cir. 2003). Indeed, courts have consistently held that identical or similar marks used on non-competitive or non-related goods are not confusingly similar. *See, e.g., Toro Mfg. Corp. v. Gleason Works*, 474 F.2d 1401 (C.C.P.A. 1973) (Affirming that mark “Toro” used for grass cutting machinery and the mark “Toroid” for gear cutters and blades are not confusing); *Riva Boats Int'l v. Yamaha Motor Corp.*, 223 U.S.P.Q. 183 (C.D. Cal. 1983) (the same mark “Riva” used for both luxury power boats and motor scooters not confusing); *King Research, Inc. v. Shulton, Inc.*, 324 F. Supp. 631

(S.D.N.Y. 1971) (the same mark “Ship-Shape” used for both comb & brush cleaner and hair spray not confusing), aff’d, 454 F.2d 66 (2d Cir. 1972).

The goods at issue here – snowboarding apparel vs. motorcycle apparel – are very different and are specifically designed for different consumers to wear while engaged in different sports. Snowboarding gear is designed to be waterproof, warm, flexible, and breathable to perform in extreme snow conditions and allow the wearer to move constantly. Snowboarding jackets are longer than regular jackets because they are designed to keep snow from getting into the athlete’s pants. By contrast, Registrant’s motorcycle gear is designed to “protect against motorcycle accidents.” As such, it is made of leather and other thick, strong materials that can safeguard against abrasions from contact with hard roads and other vehicles. Unlike snowboarding jackets, motorcycle jackets are short so that riders can comfortably bend at the hip when steering their vehicle. Motorcycling does not require constant movement or flexibility, and this is reflected in the specialized apparel. One would not wear snowboard apparel for motorcycling, and visa-versa because it would not serve their needs for those activities. Clearly, the nature and function of the goods sold under each mark are dissimilar, underscoring that the fields of use are not overlapping and leading to the conclusion that there is no likelihood of confusion between them.

### **C. The Goods Are Sold Through Distinct Trade Channels.**

The fact that motorcycle and snowboard gear is, on occasion, sold through the same retail outlets is not dispositive. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1330 (Fed. Cir. 2000) (“The law is that products should not be deemed related simply because they are sold in the same kind of establishments[;]” there must also be evidence that “the products are sold in close proximity to one another.”) citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103

(CCPA 1976) and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566–67 (Fed.Cir.1984). Here, there is no evidence that snowboarding and motorcycle gear is sold near each other, so there can be no assumption that they are related. Any such assumption (i.e. that the goods are similar because goods of those types can be sold through the same trade channels) runs counter to the TTAB's repeated rejection of any rule that certain goods are "per se" related. Moreover, a review of the respective websites demonstrates that Registrant does not sell snowboard equipment or apparel, and Applicant does not sell motorcycle goods or apparel. (<http://www.nitroriderusa.com/> and <http://nitrousa.com/en-us/men/snowboards>). In fact, the Registrant agrees that its mark is "used to identify sophisticated motorcycle protective clothing and gear [that is] purchased at specialty outlets by discerning riders..." Registrant's Response to Office Action dated May 21, 2010.

Even when marks are identical and the goods are in the same general category, sales to different groups of purchasers through different channels of trade "are sufficient to raise a doubt as to likelihood of confusion, mistake or deception." *In re Radiant Color Co.*, 156 U.S.P.Q. 703, 704 (T.T.A.B. 1968) (RADIANT for coated paper not confusingly similar to RADIANT for loose paper); *accord Paul Sachs Originals Co. v. Sachs*, 325 F.2d 212 (9th Cir. 1963) (use of identical SACHS name on different dresses of different sizes sold in different stores not likely to cause confusion). Here, there is no evidence that the goods are sold through the same or similar channels, and likelihood of confusion cannot be supported on that basis.

#### IV. CONCLUSION

There is no likelihood of confusion between Applicant's Mark and the Cited Mark because the key *Du Pont* factors weigh in Applicant's favor, namely that (1) the crowded field of NITRO-formative marks in clothing permits each registrant very narrow rights, making room for

Applicant's Mark; (2) the goods are distinct; and (3) the goods are offered through different trade channels.

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Respectfully submitted,

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## INDEX OF CITED CASES

1. *ABC Consolidated Corporation v. Chandler*, 170 U.S.P.Q. 417, 421 (T.T.A.B. 1971)
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3. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976)
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