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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/742284

**MARK:** XCALIBER



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** XCALIBER, LLC

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

XCB-10019/15

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: XCALIBER, LLC : BEFORE THE  
Trademark: XCALIBER : TRADEMARK TRIAL  
Serial No.: 78/742284 : AND  
Attorney: DOUGLAS J. MCEVOY, ESQUIRE : APPEAL BOARD  
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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**STATEMENT OF THE CASE**

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark XCALIBER for "automotive tires and wheels" in International Class 12 and "wholesale distributorships and retail store services for tires and wheels" in International

Class 35 on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

### FACTS

The Applicant applied for registration on the Principal Register for the trademark XCALIBER for “automotive tires and wheels” classified in International Class 12 and “wholesale distribution and retail services for tires and wheels” classified in International Class 35 on October 28, 2005. The examining attorney issued an initial Office Action on May 9, 2006 refusing registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), because of the likelihood of confusion with U.S. Registration No. 0596332 (“EXCALIBUR” for “automobiles”), U.S. Registration No. 1300467 (“EXCALIBUR EXCALIBUR” and design for “automobiles”), and U.S. Registration No. 1514523 (“EXCALIBUR” for “automobiles”). The Office Action also required the Applicant to amend the recitation of services in International Class 35.

The applicant amended the recitation of services as required. The applicant attempted to overcome the likelihood of confusion refusal by asserting that its mark differs in appearance from the three prior registrations and that its goods and services are unrelated to those of the prior registrant. The applicant also asserted that the channels of trade differ and that the purchasers of the relevant goods and services are sophisticated purchasers.

A final refusal to register the Applicant’s mark was issued on August 23, 2006 based upon the marks in U.S. Registration Nos. 0596332, 1300467, and 1514523. The Applicant filed a notice of appeal on May 1, 2007. The Applicant also filed its appeal brief on May 1, 2007. The application was forwarded to the examining attorney by the Trademark Trial and Appeal Board for the examiner’s appeal brief.

### ISSUE

The issue on appeal is whether the similarity of the Applicant’s mark and the marks in U.S. Registration Nos. 0596332, 1300467, and 1514523 is likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d) given the related nature of the parties’ goods and services.

### OBJECTION TO UNTIMELY EVIDENCE

Before addressing the main issue, the examining attorney formally objects to Exhibit A appended to Applicant’s brief. The contents of this Exhibit – printouts from the registrant’s website – were not part of the evidentiary record at the time Applicant’s brief was filed. The record in the application should be complete prior to the filing of an appeal. TBMP Section 1203.02(e); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1446 n.2

(TTAB 2000) (although applicant had properly submitted copies of third-party registrations, additional registrations listed in applicant's brief, which were not commented on by examining attorney in her brief, not considered). The examining attorney respectfully requests that the Board not consider the contents of this Exhibit.

### ARGUMENT

THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE VERY SIMILAR AND THE GOODS AND SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION (2)d OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052(d).

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the Applicant's mark, when used on or in connection with the identified goods and services, so resembles the marks in U.S. Registration Nos. 0596332, 1300467, and 1514523 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.*

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the Registrant and against the Applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *See In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

#### A. THE MARKS ARE VERY SIMILAR

In testing for likelihood of confusion under Section 2(d), the examining attorney must consider "[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both Applicant's and Registrant's marks. *See e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen*

*Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and “21” CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii).

In this case, the Applicant’s mark XCALIBER creates a commercial impression that is highly similar to that of the registered marks EXCALIBUR (typed), EXCALIBUR EXCALIBUR (with design), and EXCALIBUR (stylized). The spelling of the parties’ marks is almost identical. The applicant asserts that the distinction between “X” in the applicant’s mark and “EX” in the registrant’s marks is sufficient to distinguish the marks in the minds of purchasers. However, the marks are essentially phonetic equivalents. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963); TMEP §1207.01(b)(iv).

Even though the mark in U.S. Registration No. 1300467 includes a design feature and the mark in U.S. Registration No. 1514523 is in stylized form, it is the word portion in each mark that is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods. The word portion in each of the parties’ marks should be accorded greater weight in determining likelihood of confusion. *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). Since the average purchaser retains a general rather than specific impression of trademarks, the examining attorney maintains that the parties’ marks XCALIBUR, EXCALIBUR, EXCALIBUR EXCALIBUR, and EXCALIBUR create the same common commercial impression. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The parties’ marks have the same connotation in that the word “EXCALIBUR” references the legendary sword of King Arthur. *Please see* the attached dictionary definition. Besides this definition of the term, “Excalibur” (in the present context) has no meaning other than its trademark significance. When viewed in conjunction with the claimed goods and services, the parties’ marks convey virtually the same meaning.

The fact that the Registrant owns three registrations containing the wording EXCALIBUR for goods related to those of the Applicant strengthens the association

between the Registrant as a source of the goods and owner of the marks. Furthermore, this fact increases the likelihood that consumers seeing the Applicant's mark used in connection with its related services would mistakenly believe that the Applicant's services originated from or are affiliated with the source of the Registrant's goods. The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods or services, but it also protects against "reverse confusion," that is, that the junior user (herein the applicant) is the source of the senior user's (herein the registrant) goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Banff Ltd., v. Federated Department Stores*, 6 USPQ2d 1187 (2d Cir. 1988); *Fisons Horticulture v. Vigoror Industries*, 31 USPQ2d 1592 (3d Cir. 1994). Even if purchasers are sophisticated or knowledgeable in a particular field, this does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). Where the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1304 (TTAB 2004) (as stated in *KOS Pharmaceuticals Inc., v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004), and citing *Checkpoint Sys., Inc., v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285, 60 USPQ2d 1609, 1617-1618 (3d Cir. 2001)). Given the nature of the parties' goods and services, both are intended to be purchased (at least in part) by the general public.

**B. THE GOODS AND SERVICES AND THEIR TRADE CHANNELS ARE CLOSELY RELATED**

If the marks of the respective parties are identical or highly similar, the commercial relationship between the goods or services of the parties must be considered to determine whether there is a likelihood of confusion. *See In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). "It is a well settled principle of trademark law that it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion." *In re International Telephone and Telegraph Corporation*, 197 USPQ 910, 911 (TTAB 1978). Rather, "[i]t is sufficient for purposes herein that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could because of the similarity of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer." *Id.* *See also In re Mack*, 197 USPQ 755, 756 (TTAB 1977), *Sealed Air Corporation v. Scott Paper Company*, 190 USPQ 106, 108 (TTAB 1975), and *Guardian Products Company, Inc. v. Scott Paper Company*, 200 USPQ 738, 741 (TTAB 1978). It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir.

1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

The Applicant has identified its goods and services as “automotive tires and wheels” in International Class 12 and “wholesale distributorships and retail store services for tires and wheels” in International Class 35. The applicant’s automotive tires and wheels are clearly related to the registrant’s automobiles. It is a common practice of most automobile dealers to sell tires and wheels on their automobiles. A search of the records of this Office has clearly indicated that the same entity will use the same mark on both automobiles and tires and/or wheels. For example, Tom’s Co., LTD. is using the mark TOM’S (U.S. Registration No. 2643759) on automobiles, trucks, vans, race cars, sport utility vehicles, tires, and wheels; IAC International Incorporated is using the mark IAC INTERNATIONAL (U.S. Registration No. 2911417) on automobiles, wheels, and tires; Asiasonic International Industrial Co., is using the mark ASIASONIC (U.S. Registration No. 2873867) on automobiles, alloy wheels, and tires; and Honda Motor Co., Ltd. is using the mark A-SPEC (U.S. Registration No. 2977710) on automobiles, alloy wheels, and tires. The relevant registrations are attached to the May 9, 2006 Office Action. Furthermore, an Internet search conducted on August 23, 2006 yielded several relevant websites featuring automobile manufacturers who also offer tires and/or wheels for purchase separate from their automobiles. For instance, Fork Motor Company markets automobiles as well as wheels; General Motors is selling automobiles as well as wheels; Toyota is marketing automobiles and tires; and Dodge is selling automobiles and tires. Printouts from the relevant websites are attached to the Final Office Action, which issued on August 23, 2006.

Wheels are considered structural parts of an automobile. They are defined in part as “a circular object connected at the centre to a bar, which is used for making vehicles or parts of machines move.” CAMBRIDGE ADVANCED LEARNER’S DICTIONARY. A copy of the definition is attached. Without wheels, tires could not be attached to an automobile. A “tire” is “[a] covering for a wheel, usually made of rubber reinforced with cords of nylon, fiberglass, or other material and filled with compressed air. DICTIONARY.COM. A copy of the definition is attached. Wheels and tires are clearly two of the many features that allow automobiles to function as intended. If the wheels, tires and the automobile all bear the same or similar trademark, clearly purchasers are going to mistakenly believe that all the goods come from a common source. The website printouts attached to the August 23, 2006 Final Office Action clearly depict the automobiles as having both wheels and tires. Purchasers of automobiles have a reasonable expectation that these types of goods can come from a common source. In fact, based upon the evidence in the record, the examining attorney finds that purchasers are accustomed to purchasing automobiles, wheels, and/or tires from a common source. The Trademark Trial and Appeal Board has consistently found that the use of identical or similar marks on automobiles and on tires is likely to cause confusion. *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor confusingly similar to LAREDO for pneumatic tires); *Ford Motor Company v. Hi-Performance Motors, Inc.*, 186 USPQ 64 (TTAB 1975) (representation of a coiled snake for automobile tires likely to cause confusion with COBRA for automobiles and automobile

components); *In re McCreary Tire & Rubber Company*, 183 USPQ 256 (TTAB 1974) (THE PARK AVENUE for tires likely to cause confusion with PARK AVENUE for automobiles); *Jetzon Tire & Rubber Corporation v. General Motors Corporation*, 177 USPQ 467 (TTAB 1973) (GEMINI and GMINI for automobiles likely to cause confusion with GEMINI for vehicle tires). Furthermore, the Trademark Trial and Appeal Board has consistently found “that manufacturers of vehicles also produce accessories and attachments for these goods and market them under the same mark. This has been recognized by the fact that it has consistently been held over the years that there is such a definite relationship between a vehicle and the various accessories, parts, and attachments thereof in the mind of the average person that the marketing thereof by different parties under the same or similar marks is likely to cause confusion as to source.” *In re General Motors Corp.*, 23 USPQ2d 1465, 1469 (TTAB 1992) (quoting *In re Sien Equipment Co.*, 190 USPQ 84, 85 (TTAB 1976)); see *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 476 (TTAB 1973).

Any goods or services in the registrant’s normal fields of expansion must also be considered in order to determine whether the registrant’s goods are related to the applicant’s identified goods and services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant’s logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). Based upon the evidence of record, the examining attorney maintains that the applicant’s “wholesale distributorships and retail store services for tires and wheels” are within the registrant’s normal field of expansion. The website printouts attached to the Final Office Action, which issued on August 23, 2006, clearly indicate that automobile dealers such as Ford Motor Company, General Motors, Toyota, and Dodge also distribute and sell tires and wheels for use on their automobiles. Since the registrant has been using its mark EXCALIBUR on automobiles since December of 1950, it has accumulated a significant amount of goodwill attached to its trademark. Should the applicant be allowed to proceed, purchasers could reasonably believe that the registrant’s automobiles and the applicant’s tires, wheels, distributorship, and retail store services all emanate from a common source.

The presumption under the law is that each of the prior registrations encompasses all the goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). TMEP §1207.01(a)(iii). TMEP §1207.01(a)(iii). The parties’ automobiles, tires and wheels are so highly related that they are likely to be found in the same channels of trade. See *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). In considering the relevant channels of trade, the examining attorney must keep in mind that “a registration with the presumptions afforded it under Section 7(b) of the Statute bestows upon the owner a prima facie presumption of use of the registered mark upon all of the goods encompassed by the description of goods, including, in the absence of a limitation therein, a prima facie presumption that the goods move through all channels of trade suitable for goods of that type and they reach all purchasers and potential purchasers



thereof.” *Guardian Products Company, Inc. v. Scott Paper Company*, 200 USPQ 738, 741 (TTAB 1978). Since the channels of trade through which the registrant markets its automobiles have not been limited in scope, the examining attorney asserts that the automobiles may be advertised in newspapers, trade publications, flyers, brochures, signage, on television, over the radio, and via the Internet. The channels of trade through which the applicant will markets its goods and services are have not been determined since the applicant has filed its application under Section 1(b) of the Trademark Act. Given the related nature of the parties’ goods and services, it is a reasonable possibility that the parties’ channels of trade will overlap. Certainly purchasers of automobiles will be eventually in the market for wheels and/or tires, as well as retail services featuring the same.

It is important to note that the “likelihood of confusion is not limited to purchasers of the goods in question but may occur at any stage of the distribution process.” *In re Decombe*, 9 USPQ2d 1812, 1815 (TTAB 1988). Other individuals involved in preparing and publishing advertisements, and/or listing the parties’ services in business directories and the like, are also subject to mistakenly believing that the services come from a common source given the related nature of the services and the similarity of the marks. Since the applicant and the registrant are using such similar marks on closely related goods and services, purchasers could mistakenly believe that the goods and services emanate from a common source. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein.

The evidence in the record clearly shows that the goods and services of the parties are sufficiently related under Section 2(d) of the Trademark Act, such that purchasers would confuse the source of those goods and services.

### CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register the Applicant’s mark under Section 2(d) of the Trademark Act be affirmed.

Respectfully submitted,

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