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Filing date: **04/23/2018**

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

Proceeding	79185205
Applicant	Hyundai Motor Company
Applied for Mark	G65
Correspondence Address	CHARLES T J WEIGELL FROSS ZELNICK LEHRMAN & ZISSU PC 4 TIMES SQUARE 17TH FL NEW YORK, NY 10036 UNITED STATES Email: weigell-docket@fzlz.com
Submission	(1) Request for Remand; (2) Request for Reconsideration After Final Action (with Consent and Coexistence Agreement appended)
Attachments	Request for Remand.pdf(122775 bytes ) Request for Reconsideration with Consent and Coexistence Agree- ment.pdf(873051 bytes )
Filer's Name	Charles T. J. Weigell
Filer's email	weigell-docket@fzlz.com
Signature	/ctw/
Date	04/23/2018

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

Applicant:	HYUNDAI MOTOR COMPANY	:
Serial No:	79/185,205	:
Mark:	G65	:
Filed:	January 18, 2016	:
Our Ref:	HUND 1605216	:

Box TTAB – NO FEE

**REQUEST FOR REMAND TO EXAMINING  
ATTORNEY AND FOR SUSPENSION**

Pursuant to TBMP Section 1209.04, Applicant requests remand of the Application referenced above to the jurisdiction of the assigned Examining Attorney and suspension of the current appeal.

Applicant requests remand and suspension so that the Examining Attorney can consider the appended Request for Reconsideration, along with a copy of a Consent and Coexistence Agreement signed recently by Applicant and Daimler AG, the owner of cited U.S. Registration 4,639,241.

Good cause for the remand is present as the appended Agreement comprises new evidence not heretofore available which Applicant believes will ultimately resolve the refusal to register under Trademark Act §2(d), now on appeal.

In further support of its request, Applicant directs the Board to TBMP Section 1207.02 which states that “because a consent agreement offered in response to a refusal to register under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), is inherently difficult and time consuming to obtain, and may be highly persuasive of registrability, the Board will grant a

request to suspend and remand of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal." See also: *In re N.A.D., Inc.*, 224 USPQ 969, 970 (Fed. Cir. 1985).

In view of the above, Applicant requests favorable consideration and granting of its request for remand and suspension.

Dated: New York, New York

April 17, 2018

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:



Charles T. J. Weigell

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**REQUEST FOR RECONSIDERATION AFTER FINAL ACTION**

Applicant requests reconsideration and withdrawal of the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), in view of the mark in U.S. Registration No. 4,639,241, based on the attached signed Consent and Coexistence Agreement (hereafter “Consent Agreement”) between the Applicant and the owner of the cited registration, Daimler AG.

Applicant appealed the decision of the Examining Attorney to finalize the refusal to register. Along with this Request for Reconsideration, Applicant has filed a Request for Remand and Suspension requesting that the Board remand the instant application for consideration of this Request for Reconsideration and the attached Consent Agreement.

In the Consent Agreement, Daimler AG specifically consents to the registration of the above referenced Application, subject to the terms and conditions set out. The Consent Agreement is signed by authorized agents of both the current Applicant and Daimler AG and it references the respective uses of the marks by the parties as well as the parties’ belief that the

marks will not likely cause any confusion, mistake or deception. It also commits the parties to take action if any instances of actual confusion arise among their respective consumers.

Applicant submits that in view of the Consent Agreement, the refusal to register under Section 2(d) should be withdrawn. The Court of Appeals for the Federal Circuit has long held that consent agreements should be given considerably weight in a Section 2(d) analysis. In the precedential Du Pont case the Federal Circuit stated that:

*...when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't.*

*In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 568 (CCPA 1973)

Moreover, the Consent Agreement must be considered in the context of the particular industry and businesses involved. Applicant and Registrant are large entities and competitors with very longstanding and extensive familiarity with the car manufacturing industry. They have thought out their commercial interests with care and would not deliberately create any situation in which the sources of their respective products would be confused by their customers. *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985).

In this respect, the parties to the Consent Agreement are in a far better position than the USPTO to evaluate whether the marks can co-exist. In *In re Four Seasons Hotels, Ltd.* the Federal Circuit reversed a Board decision affirming a Section 2(d) refusal where the applicant and registrant had concluded a consent agreement, stating:

*Believing that its role in enforcing section 2(d) of the Lanham Act is to second-guess the conclusions of those most familiar with the marketplace, the PTO "is, at times, like a cat watching the wrong rat hole." The role of the PTO is not in "denying registration if it feels there is, by its independent determination, any likelihood of confusion of any kind as between the mark sought to be registered and the prior registration, without regard to the desires, opinions, or agreements of the owner of the prior registration.*

*In re Four Seasons Hotels, Ltd.*, 26 USPQ2d 1071, 1071-1072 (Fed. Cir. 1993).

In all, the Consent Agreement submitted is strong evidence that no likelihood of confusion exists between the marks at issue. To the extent that there are any doubts on this matter, Board precedent states that Registrant's consent to Applicant's registration of its mark negates the presumption that doubts about likelihood of confusion are to be resolved in favor of the registrant. *In re Donnay International Societe Anonyme*, 31 USPQ2d 1953, 1956 (TTAB 1994) (by giving consent to the registration of applicant's mark, registrant has removed the basis for applying the equitable concept of resolving doubt in favor of the registrant).

In accordance with the above referenced Board and Federal Circuit precedent, the Applicant's signed Consent Agreement should be accepted and the refusal to register should be withdrawn.

Dated: New York, New York

April 20, 2018

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:

A handwritten signature in black ink, appearing to read 'C. T. J. Weigell', is written over a solid horizontal line.

Charles T. J. Weigell

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# **Appendix**

## **Consent and Coexistence Agreement**

## CONSENT AND COEXISTENCE AGREEMENT

This Consent and Coexistence Agreement by and between Hyundai Motor Company, a Korean corporation with an address at 12 Heolleung-ro, Seocho-gu, Seoul 06797 Republic of Korea ("Hyundai"), and Daimler AG, a German corporation with an address at Mercedesstrasse 137 Stuttgart, Federal Republic of Germany 70327 ("Daimler") is effective as of the last date signed below.

WHEREAS, Daimler uses or intends to use the mark G 65 for "automobiles and their structural parts" ("Daimler's Goods"); and

WHEREAS, Daimler is the owner of U.S. Trademark Registration No. 4639241 for G 65 for "automobiles and their structural parts" in Class 12 ("Daimler's Registration"); and

WHEREAS, Hyundai uses or intends to use the mark G65 in connection with "Automobiles; sports cars; structural parts for automobiles; parts and accessories for automobiles, namely, wheel bearings, couplings, axle journal boxes and axel bearings; speed change gears for land vehicles; suspension shock absorbers for vehicles; braking systems for land vehicles; passenger cars; power transmissions and gearings for land vehicles; transmissions for land vehicles; automobile engines" ("Hyundai's Goods"); and

WHEREAS, Hyundai has applied to register the mark G65 (U.S. Application No. 79185205) in connection with "Automobiles; sports cars; structural parts for automobiles; parts and accessories for automobiles, namely, wheel bearings, couplings, axle journal boxes and axel bearings; speed change gears for land vehicles; suspension shock absorbers for vehicles; braking systems for land vehicles; passenger cars; power transmissions and gearings for land vehicles; transmissions for land vehicles; automobile engines" in Class 12 ("Hyundai's Application"); and

WHEREAS, registration of Hyundai's Application was refused on the basis of a likelihood of confusion with Daimler's Registration; and

WHEREAS, the parties have exchanged information and believe that due to the different manners of use and use of the respective marks in close proximity to well-known house marks, and the other confusion-avoiding circumstances named herein, that there would be no likelihood of confusion;

NOW, THEREFORE, for good and valuable consideration, the parties agree as follows:

1. The parties believe that confusion is unlikely because both marks will be used in close proximity to house-marks and with other distinguishing names and indicia sufficient to allow consumers to distinguish the respective commercial sources of the various goods. Moreover, Hyundai intends to use the G65 mark primarily with sedans (and their parts, fittings and structures), while Daimler uses the G 65 mark for off-road vehicles and SUVs. Although the parties believe that confusion is unlikely between the marks, they



will cooperate to take any steps necessary to prevent any possible confusion to the public that may arise in the future.

2. Hyundai consents to the use and registration of the G 65 mark by Daimler for Daimler's Goods, and will not interfere with the use or registration of the G 65 mark by Daimler for Daimler's Goods.
3. Daimler consents to the use and registration of G65 by Hyundai for Hyundai's Goods, and will not interfere with the use or registration of the G65 mark by Hyundai for Hyundai's Goods.
4. This Agreement shall be effective in the United States of America and its territories, and shall be binding, valid and enforceable against, and the benefits thereof shall inure to the successors, licensees and assigns of Hyundai and Daimler, and parties in privity with them.
5. The parties shall execute such further documents consistent with the terms of this Agreement as may be reasonably necessary or required in order to confirm or perfect the intent of this Agreement, at no charge. A facsimile or scanned signature on this agreement shall have the same evidentiary effect as an original signature.
6. This Agreement shall remain in full force and effect so long as either party has not abandoned all rights and registrations for marks that incorporate the terms G 65 or G65, either standing alone, or as part of a compound mark.

**HYUNDAI MOTOR COMPANY**

By: **WONHEE LEE**  
President

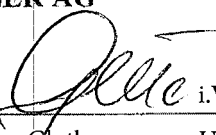

Date: April 12th 2018

**HYUNDAI MOTOR COMPANY**

  
\_\_\_\_\_  
President



**DAIMLER AG**

By: i.V.  i.V.   
Sabine Gluthe Ute Spiegel  
(both Authorized Representatives)

Date: Stuttgart, April 16, 2018