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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86054033

MARK: LIFEXTEND



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: 5K CAR STORE, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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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 "LIFEXTEND" on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with U.S. Registration No. 1357182 ("EXTENDALIFE VPI").

FACTS

Applicant filed this application on September 3, 2013, applying to register the mark “LIFEXTEND” on the Principal Register for “Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors.”¹

In the initial Office Action dated December 16, 2013, the examining attorney issued a 2(d) likelihood of confusion refusal based on U.S. Registration No. 1357182, as well as an identification of services requirement.

On May 28, 2014, applicant submitted an amended identification of services and argued against the 2(d) refusal. In response, on July 8, 2014 the examining attorney accepted the amended identification of services. However, a final action based on the 2(d) refusal citing U.S. Registration No. 1357182 was issued.

On December 24, 2014, applicant submitted a Request for Reconsideration in which the arguments against the 2(d) refusal were continued and maintained, and the identification of services was amended. On March 4, 2015, the examining attorney issued a subsequent Final action maintaining the Section 2(d) refusal and also refusing the amended identification as beyond the scope of the previously accepted identification of services. On January 7, 2015, applicant filed an appeal.

ISSUE ON APPEAL

The issues on appeal are: (1) whether the mark, when used in connection with the identified services in International Class 037, so resembles the mark in U.S. Registration No. 1357182 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act

¹ The identification reflects changes made by the applicant in correspondence dated December 24, 2014. However, on March 4, 2015, the examining attorney refused this identification of services because it is beyond the scope of the previously accepted identification of services. Please note, the previously accepted identification of services was submitted on May 28, 2014 – set forth as: “Vehicle reconditioning services” in Class 037.

Section 2(d); and (2) whether the most recently amended identification of services is beyond the scope of the previously accepted identification of services.

LIKELIHOOD OF CONFUSION REFUSAL

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the services, to cause confusion, mistake or to deceive the potential consumer as to the source of the services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the services. The overriding concern is to prevent buyer confusion as to the source of the services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

LIKELIHOOD OF CONFUSION ARGUMENT

I. THE MARKS ARE HIGHLY SIMILAR

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In the instant case, applicant's mark is "**LIFEXTEND**" and registrant's mark is "**EXTENDALIFE VPI**" with "VPI" disclaimed. The dominant feature of the registrant's mark is "EXTENDALIFE" due to the descriptive nature of "VPI", which is considered less significant. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for an applicant's services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). As such, the applicant's mark ("LIFEXTEND") is essentially the registrant's mark ("EXTENDALIFE") transposed. Therefore, the marks are so similar in their connotation and commercial impression, that there is a likelihood of confusion.

Applicant argues that "the words LIFEXTEND and EXTENDALIFE do not sound the same. The words are different in appearance, as EXTENDALIFE consists of two additional letters and the combination of words is reversed."² Applicant further argues that the marks at issue are analogous to *In re Akzona Inc.*, 219 U.S.P.Q. (BNA) ¶ 94 (P.T.O. May 20, 1983), in which the Board held that although the goods were commercially related, the marks SILKY TOUCH and TOUCH O' SILK were not likely to cause confusion.³

However, it is well established that confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); see, e.g., *In re Wine Soc'y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design, for "wine club membership

² See Appellant's Brief, pg. 6.

³ See Appellant's Brief, pg. 6.

services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant,” likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER, with "RUST" disclaimed, for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil). The marks do not require exact transposition of terms to present similar commercial impressions. Similar to *In re Wine Soc’y of Am. Inc.*, registrant has merely inserted a non-dominant word “A” between “EXTEND” and “LIFE”, whereas applicant’s mark is “LIFEXTEND”. Therefore, in both parties’ marks, it is clearly conveyed that they provide similar reconditioning services that will extend the life of a motor/vehicle.

It is also worth noting that in *In re Akzona Inc.*, the mark, SILKY TOUCH connotes a characteristic of the way the goods feel (i.e., synthetic textile yarn that feels silky); whereas the mark TOUCH O’ SILK connotes the material featured in the goods (i.e., men’s clothing made, in part, of silk). As such, the marks present different commercial impressions. Conversely, this is not the case here, where applicant’s and registrant’s marks convey the same meaning and commercial impression (i.e., both parties in the case at issue provide similar reconditioning services that will extend the life of a motor/vehicle).

In sum, the applicant’s and registrant’s marks are so similar in their appearance, sound, connotation and commercial impression that there is a likelihood of confusion.

II. THE SERVICES ARE CLOSELY RELATED

The services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 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.”); TMEP §1207.01(a)(i).

The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

In the present case, the applicant’s identified services, as most recently amended, are for “Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors” in Class 037. Applicant’s previously amended (and accepted) identification of services are for “Reconditioning of motor vehicles.” The registrant’s services are for “Reconditioning of electric motors” in Class 037. Whether applying the previously accepted identification of services, or the most recently amended identification of services, the applicant’s services are related to the registrant’s services. Specifically, in the accepted identification of services, namely, “reconditioning of motor vehicles,” applicant’s services could include reconditioning of electric motors, since motor vehicles often include electric or hybrid motors (see evidence below).

Additionally, with regard to the most recently amended identification of services, namely, “repair, maintenance and reconditioning services for motor vehicles, excluding electric motors,” the services are still related since the registrant’s services are listed as “reconditioning of electric motors” with no limitation as to the types of electric motors. As such, the registrant’s reconditioning of electric motors includes electric motors for vehicles.

Applicant argues that its “goods are not related or marketed in such a way that they would be confused with the goods offered by the Registrant. Applicant’s services are limited to vehicles, and explicitly exclude reconditioning ‘electric motors.’ Registrant’s services are limited to reconditioning of electric motors. Applicant’s services pertain to maintenance and reconditioning engines for cars’ engines while Registrant’s services pertain to electric motors for large-scale industrial use.”⁴

Applicant further argues that “[a]lthough vehicles with electric motors are becoming more common, they are still a minority and reconditioning such motors requires a completely different set of skills. Applicant does not offer reconditioning services for electric motors and will not be expanding to offer such services in the future.”⁵

However, likelihood of confusion is determined on the basis of the services identified in the application and registration. If the application or registration describes the services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the application and registration encompass all services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant’s argument that its goods are sold only in its own retail stores is not persuasive ... There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold”); TMEP §1207.01(a)(iii). Here, the registrant’s services are listed as “reconditioning of electric motors” with no limitation as to the types of electric motors. As such, the registrant’s reconditioning of electric motors must be presumed to include electric motors for vehicles.

⁴ See Appellant’s Brief, pg. 7.

⁵ See Appellant’s Brief, pg. 7.

Please note that the current identification of services on which applicant bases its argument was refused as beyond the scope of the previously accepted identification of services (“Vehicle reconditioning services” in Class 037).⁶ See argument below.⁷ Nonetheless, even if applicant’s identification of services, as amended to exclude electric motors, was found to be acceptable, the services would still be related because the registrant’s services, namely, “reconditioning of electric motors”, could include reconditioning of electric motors for vehicles. Thus, reconditioning services for vehicles and reconditioning services for electric motors often emanate from a common source.

In the Office action dated July 8, 2014, the examining attorney attached evidence to illustrate how companies that provide reconditioning services related to electric motors often include services for reconditioning electric motors for vehicles.⁸

The evidence includes websites from:

- Brets Autoworks⁹
- Chelmsford Auto Electric, Inc¹⁰
- Choate Auto Electric¹¹
- Denver Transmission¹²
- Schelen Gray Auto and Electric¹³
- Kal’s Automotive Center¹⁴
- Masters Touch Automotive¹⁵

6 See Subsequent Final Action dated March 4, 2015.

7 See Subsequent Final Action dated March 4, 2015.

8 See Final Action dated July 8, 2014.

9 See Final Action dated July 8, 2014: pgs. 3-4.

10 See Final Action dated July 8, 2014: pgs. 5-6.

11 See Final Action dated July 8, 2014: pg. 7.

12 See Final Action dated July 8, 2014: pgs. 8-11.

13 See Final Action dated July 8, 2014: pgs. 12-15.

14 See Final Action dated July 8, 2014: pgs. 16-18.

- Superstition Motors Ltd.¹⁶

Based on the aforementioned standards and evidence, the applicant's services are closely related to the registrant's services because they could be marketed and sold together and/or in the same channels of trade.

III. SOPHISTICATION OF PURCHASERS DOES NOT OVERCOME A LIKELIHOOD OF CONFUSION

Lastly, applicant argues that it "proffered evidence that the channels of trade were sufficiently distinct and that the consumers in the relevant markets would have a sophisticated understanding of the services offered and would therefore not be confused."¹⁷ More specifically, in its May 28, 2014 response, applicant argued that "[t]he respective mark owners only sell to sophisticated customers in need of repairs to large and small motors including: AC & DC electric motors, large synchronous motors, explosion proof motors, squirrel cage rotors, generators, pumps, fans, gearboxes, rolls, impellers and babbitt bearing, none of which are related to vehicle motors ... Customers in the industry field must have substantial expertise in their industry, and so can distinguish readily the respective products and their sources."¹⁸ To support its argument, applicant submitted a copy of the registrant's website showing a listing of the aforementioned AC & DC electric motors, etc. However, as previously discussed, there is a presumption that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the *registration*. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified services. Nonetheless, even if the respective parties do only market/sell their services

15 See Final Action dated July 8, 2014: pgs. 19-27.

16 See Final Action dated July 8, 2014: pgs. 28-31.

17 See Appellant's Brief, pg. 4.

18 See Appellant's May 28, 2014 Response to Office Action, pgs. 1-2.

to knowledgeable consumers, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

IMPROPER AMENDMENT OF IDENTIFICATION OF SERVICES ARGUMENT

On December 24, 2014, applicant filed a Request for Reconsideration based on the following amended identification of services: “*Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors*” in Class 037. However, the particular wording in the proposed amendment to the identification is not acceptable because it exceeds the scope of the previously accepted identification of services. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

It is well established that an acceptable identification of services is required in an application. *See* 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01. Further, an applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Scope is generally determined by the ordinary meaning of the wording in the identification. TMEP §1402.07(a).

In this case, the application originally identified the services as follows: “*Vehicle reconditioning and safety and damage inspections and disclosures*” in Class 037, which was found to be indefinite. On May 28, 2014, the applicant amended its identification of services to “*Vehicle reconditioning services*” in Class 037, which was accepted and entered into the record.

Most recently, applicant proposed an amendment set forth in the Request for Reconsideration, which identifies the services as follows: “*Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors*” in Class 037. However, “repair” and “maintenance” services are defined more broadly than “reconditioning services” and beyond the scope of the previously accepted identification of services.

Specifically, the term “recondition” means to “bring into an improved condition.”¹⁹ Within the automotive industry, “vehicle restoration is the process of *reconditioning* it from a used condition in an effort to return it to like-new condition.”²⁰ However, vehicle maintenance refers to “the act of inspecting or testing the condition of car subsystems (e.g., engine) and servicing or replacing parts and fluids”;²¹ while “repair” means “to restore to sound condition after damage or injury; fix.”²² As such, although the terms “repair” and “maintenance” are similar to “recondition”, the definitions of such wording are broader than the previously accepted identification and are not acceptable. See 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01. As such, the operative identification of services should be the previously accepted amendment, “vehicle reconditioning services.”

19 See Subsequent Final Action dated March 4, 2015, pgs. 10-11.

20 See Subsequent Final Action dated March 4, 2015, pgs. 2-3.

21 See Subsequent Final Action dated March 4, 2015, pg. 7.

22 Please see attached definition from: The American Heritage® Dictionary of the English Language, Fifth Edition copyright ©2014 by Houghton Mifflin Harcourt Publishing Company. All rights reserved. - The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; see *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (taking judicial notice of definition from *Dictionary.com* because it was from The Random House Unabridged Dictionary); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition from *Encarta Dictionary* because it was readily available in specifically denoted editions via the Internet and CD-ROM); TMEP §710.01(c); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

CONCLUSION

Applicant's mark LIFEXTEND is likely to be confused with registrant's mark EXTENDALIFE VPI because applicant's mark creates a highly similar commercial impression and the marks are used with services that are closely related. Furthermore, the applicant's most recently amended identification of services is unacceptable because it is beyond the scope of the previously accepted identification. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), as well as the identification of services requirement, be affirmed.

Respectfully submitted,

/tfrazier/

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re·pair¹ (ri·pär)

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v. re·paired, re·pair·ing, re·pairs

v.tr.

1. To restore to sound condition after damage or injury; fix: repaired the broken watch.
2. To set right; remedy: repair an oversight.
3. To restore or renew: repair the immune system.
4. To make up for or compensate for (a loss or wrong, for example).

v.intr.

To make repairs.

n.

1.
 - a. The work, act, or process of repairing.
 - b. often repairs An instance or a result of repairing. The accident resulted in a costly repair to the car. My bike is in the shop for repairs.
2.
 - a. The state of being fit for use. The furnace is out of repair.
 - b. General condition after use or repairing; in good repair.

[Middle English *reparen*, *reparisen*, from Old French *reparer*, from Latin *reparare*: re-, re- + *parare*, to prepare, put in order; see *para-*¹ in the Appendix of Indo-European roots.]

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re-pair *a*-ble *adj*
re-pair *a*-bly *adv*
re-pair *er*

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re-pair ² (*ri*paɪ)

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intr. v. re-paired, re-pair-ing, re-pairs
1. To beset oneself; go: repair to the dining room.
2. To go frequently or habitually: repairs to the restaurant every week.

n.

- 1. An act of going or stopping: our annual repair to the mountains.
- 2. A place to which one goes frequently or habitually; a haunt.

Archaic

[Middle English *repareren*, to return, from Old French *reparier*, from Late Latin *reparitare*, to return to one's country; see *REPATRIATE*.]

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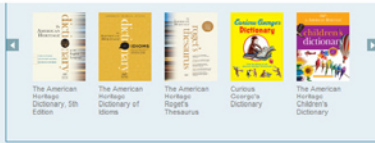
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