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Subject: U.S. TRADEMARK APPLICATION NO. 86425269 - TRUE VELOCITY - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86425269

MARK: TRUE VELOCITY



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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: Prosser, Inc.

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the trademark TRUE VELOCITY in standard character form for "polymer-based center fire rifle cartridges meeting military specifications and provided solely in connection with Department of Defense, governmental and military use in automatic machine guns and semi-automatic machine guns, excluding all other ammunition, shotgun shells and shotgun shell shot" on the grounds that the mark, under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), is likely to be confused with the registered mark VELOCITY in standard

character form for “ammunition; shotgun shells; shotgun shell shot” that is the subject of U.S. Registration No. 2386219.

FACTS

On October 16, 2014, Applicant applied to register the mark TRUE VELOCITY for “ammunition”. The Applicant then amended its identification to “ammunition provided solely in connection with governmental and military use” and finally, to “polymer-based center fire rifle cartridges meeting military specifications and provided solely in connection with Department of Defense, governmental and military use in automatic machine guns and semi-automatic machine guns, excluding all other ammunition, shotgun shells and shotgun shell shot”. In the Office Action dated January 26, 2015, the examining attorney refused registration under Trademark Act Section 2(d) based on a likelihood of confusion with the registered mark VELOCITY for “ammunition; shotgun shells; shotgun shell shot”. The examining attorney made the refusal to register final in the Office Action dated April 28, 2015.

Applicant filed an Amendment to Allege Use (AAU) on October 19, 2015 which was accepted on October 22, 2015.

Applicant filed a Request for Reconsideration and Notice of Intent to Appeal on October 27, 2015. The examining attorney denied the Request for Reconsideration December 3, 2015. Subsequently, Applicant filed this appeal on February 8, 2016, and the case was forwarded to the examining attorney on February 11, 2016, for submission of his brief.

ARGUMENT

THE MARKS OF THE APPLICANT AND REGISTRANT ARE SIMILAR AND THE GOODS ARE SO RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case,

depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and similarity of the trade channels. The other factors cannot be considered because no relevant evidence concerning those factors is contained in the record. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

THE MARKS ARE CONFUSINGLY SIMILAR

In determining whether there is a likelihood of confusion, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. Similarity in any one of these elements alone is sufficient to find a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 177 USPQ at 567.

The applicant has applied to register TRUE VELOCITY in standard character form. The registered mark is VELOCITY in standard character form. The marks share the word VELOCITY with the Applicant merely adding the word element TRUE to the registered mark. Additionally, VELOCITY is the dominant element in the proposed mark as the word element TRUE is used as an adjective and merely modifies the noun and dominant word element "VELOCITY".

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under Applicant's and Registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). In this case, consumers will undoubtedly retain a similar general recollection of the marks; namely, VELOCITY and TRUE VELOCITY for ammunition.

Furthermore, the applicant's proposed mark incorporates the entirety of the registrant's mark. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); TMEP §1207.01(b)(iii). Here the marks are identical in part. Additionally, these are the only two registered or pending marks using the word "VELOCITY" for ammunition.

Applicant argues on page two and three of its Brief and on page six of its Response to Office Action that the marks are not similar and create a different commercial impression. Applicant argues that the addition of the word "TRUE" creates a different commercial impression. It does not. There is no known meaning or definition of TRUE VELOCITY. Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). 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); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751 (Fed. Cir. 1985). Again, adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar);

Applicant also argues that “TRUE”, as the first word element, is the dominant portion of the proposed mark. See Applicant’s Brief at page 13. It is not. Applicant argues that consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). While this statement is generally correct the dominant word in the Applicant’s proposed mark is the second word “VELOCITY”. Here the first word, “TRUE” is used as an adjective and as such merely modifies the noun and dominant word element “VELOCITY”. Thus, the “TRUE” element is in fact less significant in terms of affecting the mark’s commercial impression, and renders the wording “VELOCITY” the more dominant wording in the Applicant’s proposed mark.

For the reasons set forth above, and inasmuch as the marks share the identical dominant term “VELOCITY” and would at the very least engender similar meanings as well as commercial impressions, source confusion is likely.

THE WORD VELOCITY IS NOT DILUTED

Applicant further argues that the term “VELOCITY” is weak and highly descriptive of ammunition and therefore entitled to little or no protection. See Applicant’s Response to Office Action at page 1; Request for Reconsideration at page 1 and Applicant’s Brief at pages 4-13. Applicant goes to great lengths arguing the alleged weakness of the term “VELOCITY” stating there are “numerous” third party registrations containing the word “VELOCITY” for ammunition. However, in support of this statement the applicant has only provided a total of ten registrations in classes 9, 13 and 28 containing the word “VELOCITY” or a derivative thereof and specifically discusses only seven of the ten in its Brief. See Applicant’s Brief at pages 7 and 8.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). Furthermore, nine of the ten registrations submitted by Applicant can be easily distinguished as most of the goods listed in the third-party registrations are totally different from the ammunition goods at issue here. Three are for fireworks, three for protective body armor clothing, one is for toy guns and one is for paintball loaders. Only two of the registrations are even related to the ammunition goods identified, namely VELOCITOR for "ammunition", which can be distinguished as a made-up inherently distinctive word without meaning, which creates an entirely different commercial impression sharing part of the word "VELOCITY" and VELOCITY TACTICS for "ballistic weapons" which shares the term "VELOCITY" with the registered mark but adds the non-descriptive word TACTICS and identifies goods that are unlikely to use the registrant's ammunition unless the calibers of the ammunition and the weapons are the same. As only one cited registration even uses the word "VELOCITY" for related goods the cited registered marks do not show that the "VELOCITY" is commonly used in connection with ammunition. One distinguishable registration does not equate to "numerous" third-party registrations for "VELOCITY" used with ammunition. Therefore the cited mark is in fact strong and as such is entitled to every protection available for like or similar marks. Applicant's next argues that the use of the proposed mark and the registered mark on respective packaging further differentiates the marks. Such use is not relevant to this proceeding and should not be considered.

Furthermore, even assuming that the word “VELOCITY” when used with ammunition is determined to be weak, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978). Moreover the cited registration and the Applicant’s proposed mark are the only registered or pending marks using the word “VELOCITY” for ammunition.

Applicant’s next argues that the use of the proposed mark and the registered mark on respective packaging further differentiates the marks. Such use is not relevant to this proceeding and should not be considered. The applicant’s proposed mark and the cited registered mark are both in standard character form. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii).

THE GOODS ARE LEGALLY IDENTICAL

Applicant admits that there is no dispute that Applicant’s and Registrant’s goods are ammunition in class 13. *See Applicant’s Brief* page 16. However, Applicant attempts to differentiate its goods based on its more specific identification, including exclusionary language and target consumers and by attempting to mischaracterize the Registrant’s goods as being merely “shotgun shells and shotgun shell

shot for recreational hunting and sports” or stating that “given the evidence of record, it is clear that Registrant included the term ‘ammunition’ in its identification of goods because that is the term consumers use to generically refer to all types of bullets” . See Applicant’s Brief at page 16-17. With respect to Applicant’s and Registrant’s goods, the Applicant is reminded that the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Here the Registrant’s goods as identified in its registration are “ammunition; shotgun shells; shotgun shell shot”, in class 13. The Applicant’s goods are “polymer-based center fire rifle cartridges meeting military specifications and provided solely in connection with Department of Defense, governmental and military use in automatic machine guns and semi-automatic machine guns, excluding all other ammunition, shotgun shells and shotgun shell shot”, in class 13. The Registrants’ identification “ammunition” is broad and encompasses and includes the Applicant’s more narrow “polymer-based center fire rifle cartridges meeting military specifications...” as such cartridges are a type of ammunition. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)). Additionally, the Applicant’s use of exclusionary language in its identification does not obviate the refusal or the relatedness of the goods. The identification set forth in the registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is 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. See *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); TMEP §1207.01(a)(iii). This includes the Applicant's polymer-based center fire rifle cartridges.

Applicant also attempts to undermine the Registrant's identification by suggesting that the terminology it is not clear or undefined and that Applicant should be allowed to provide extrinsic evidence to show that the Registrant's identification has a specific meaning to members of the trade. See Applicant's Brief at Page 18. The Registrant's identification is crystal clear and specifically defined with the words having a plain and known meaning within the industry. Extrinsic evidence is not required, should not be allowed and should not be considered by the Board.

Lastly, applicant argues that the purchasers are sophisticated and different and that the respective markets are different. Applicant also attempts to define the Registrant's users describing them as "recreational hunters and sportsman". See Applicant's Brief at page 20. The Registrant's identification does not specify any type users or classes of purchasers. In fact the identification set forth in the registration contains absolutely no restrictions whatsoever as to nature, type, channels of trade, or classes of purchasers. Therefore, under Trademark Act Section 7(b), 15 U.S.C. §1057(b), the presumption is 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 goods and/or services. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); see TMEP §1207.01(a)(iii). This includes the applicant's Department of Defense, governmental and military users. Furthermore, 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., Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

CONCLUSION

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect Registrant from adverse commercial impact due to use of a similar mark by a newcomer. *In re Shell Oil Co.*, 992 F.2d at 1208, 26 USPQ2d at 1690. Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of Registrant. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); TMEP §1207.01(d)(i). For the reasons set forth above, the refusal to register under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,
/JSD/

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