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Precedent of the TTAB

Mailed: September 19, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re West L.A. Corp. d/b/a California Beemers

Serial No. 87354651

Elizabeth A. Linford of Ladas & Parry LLP
for West L.A. Corp. d/b/a California Beemers.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Zervas, Adlin and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant West L.A. Corp. d/b/a California Beemers seeks a Principal Register registration for the proposed mark CALIFORNIA BEEMERS, in standard characters (with CALIFORNIA disclaimed¹), for “retail services in the field of automobiles, namely, automobile dealership services,” in International Class 35, and “automobile customization services; vehicle repair services, namely, vehicle repair and

¹ The Examining Attorney indicated in the December 20, 2017 Office Action that Applicant’s disclaimer of CALIFORNIA “will not be accepted or entered into the record.” The Examining Attorney has not substantively addressed the disclaimer issue since. Nevertheless, the Application currently includes the disclaimer.

maintenance” in International Class 37.² The Examining Attorney refused registration on the grounds that Applicant’s proposed mark: (1) falsely suggests a connection with Bayerische Motoren Werke AG (“BMW”) under Section 2(a) the Trademark Act; and (2) is geographically descriptive under Section 2(e)(2) of the Act. After the refusal became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.

I. The Evidence

In support of his finding of a false suggestion, the Examining Attorney relies on several dictionary definitions of the term BEEMER. According to Oxford Living Dictionaries, the term is informal for “a car or motorcycle manufactured by the company BMW.”³ May 31, 2017 Office Action TSDR 5.⁴ Both Collins Dictionary⁵ and MacMillan Dictionary⁶ define “beemer” as informal for “a BMW car.” *Id.* at 9, 12. Finally, the Cambridge Dictionary of British English defines the term as “a motorcycle or car made by the German company BMW.”⁷ *Id.* at 14. Thus, all of the dictionary evidence of record indicates that “beemer” means a BMW vehicle.

² Application Serial No. 87354651, filed March 1, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use dates of June 15, 1998.

³ <https://en.oxforddictionaries.com/definition/us/Beemer>.

⁴ References to the application record are to the Trademark Status and Document Retrieval (“TSDR”) system.

⁵ <https://www.collinsdictionary.com/dictionary/english/beemer>.

⁶ <http://www.macmillandictionary.com/dictionary/american/beemer>.

⁷ <http://dictionary.cambridge.org/dictionary/english/beemer?a=british>. We have considered this definition because it is consistent with the others, but generally “British English” is of little or no relevance to United States trademark cases.

The Examining Attorney also relies on articles about BMW, its cars or its reputation. An “editorial” on the “streetdirectory.com” website asserts that “BMW vehicles have the reputation for giving its users the ultimate in driving experiences,” because the vehicles are “meticulously engineered” and “designed to be distinct”:

Editorials » Automobiles » Car Parts

The BMW Reputation and Its Interior Part

By: Gladys Rejon

Replace - OE Replacement Engine



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CARiD.com - Car & Truck Accessories Replace

>

BMW vehicles have the reputation for giving its users the ultimate in driving experiences. Owning a BMW vehicle brings great pride to drive since it is meticulously engineered to respond with precision and agility to whichever commands that are given to it by whomever happens to be behind the wheel. It is because of the BMW's celebrated road performance that the brand was eventually tagged as "The Ultimate Driving Machine." This quality of the BMW vehicle provides drivers with the ease and comfort that all car consumers look for.

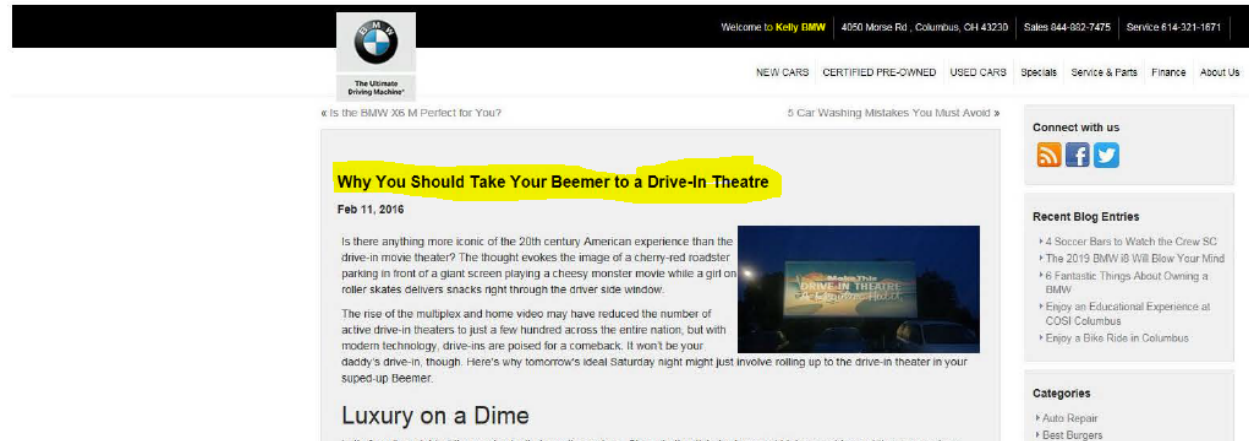
BMW vehicles are designed to be distinct. Aside from the superb quality these BMW vehicles exhibit, these car units

Id. at 17. Articles on the “yankodesign.com” and “time.com” websites mention or review particular BMW models. July 18, 2018 Office Action TSDR 6-9. The “time.com” article uses the term BEEMER to refer to one of Applicant’s cars, the M2: “The M2 – the M stands for ‘Motorsport,’ as in BMW’s racing division – is Beemer’s entry-level performance model.” *Id.* at 7-8. Similarly, the title of an article on the “thedrive.com” website, “2019 BMW M850i xDrive Coupe: The Pinnacle of Beemer’s Revived 8 Series Starts at \$111,900,” uses BEEMER to refer to another BMW car. *Id.* at 10-12. An

Serial No. 87354651

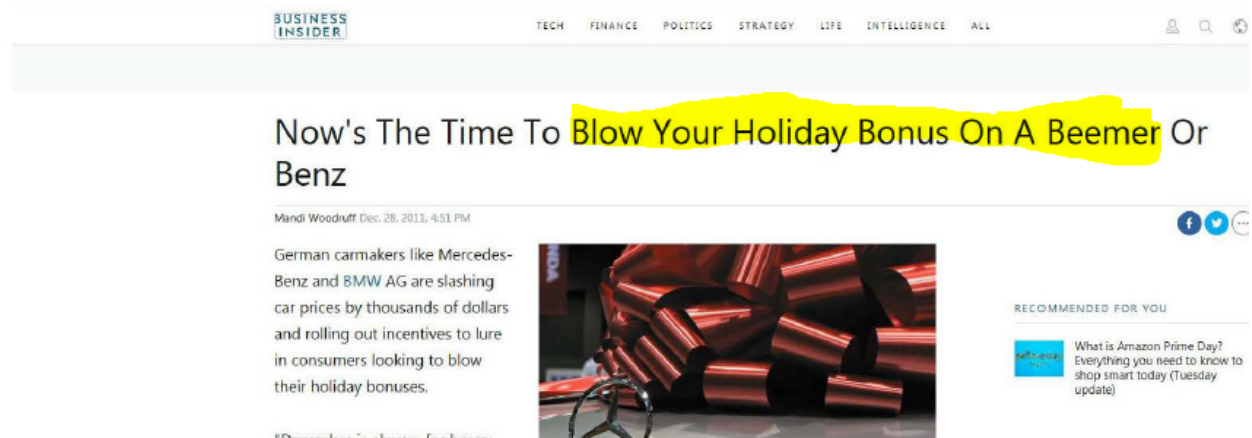
article on “exoticcarlist.com” also uses BEEMER in reference to Applicant’s cars. *Id.* at 15. Kelly BMW, one of BMW’s United States dealers, also uses BEEMER to refer to BMW cars:

<https://www.kellybmw.com/blogs/1072/why-you-should-take-your-beemer-to-a-drive-in-theatre/07/17/2018-01:39:06-PM>



Id. at 13. Similarly, a Business Insider article, BizWest promotional column and independent used car dealers’ and auto repair websites use BEEMER in reference to BMW cars:

<http://www.businessinsider.com/nows-the-best-time-to-get-a-beemer-or-mercedes-2011-12/07/17/2018-01:43:50-PM>



<https://bizwest.com/2001/10/19/guest-column-beemer-culture-stems-from-bmw-quality/>
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Guest Column: "Beemer culture" stems from BMW quality

a d f k v s

While speaking with a gentleman at Co's BMW Center, he mentioned almost purchasing a BMW from Co's about 17 years ago, but he couldn't justify that much money for a car. I decided to share with him that "BMW is more than a car, it's a culture." He asked me to explain what I meant.

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The rich history of BMW has long been one of dedication to excellence. With the beginnings of BMW came the manufacturing of airplane engines. The origins of the airplane-engine industry are symbolized today by the BMW logo — the Roundel — a stylized whirling propeller against a Bavarian blue sky. A walk through the BMW Zentrum museum in Spartansburg, S.C., or Munich, Germany, will answer many questions about the culture of BMW.

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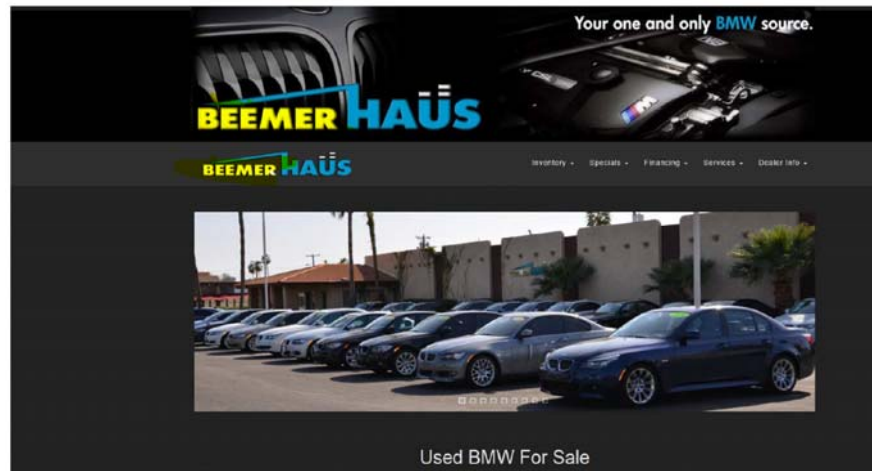
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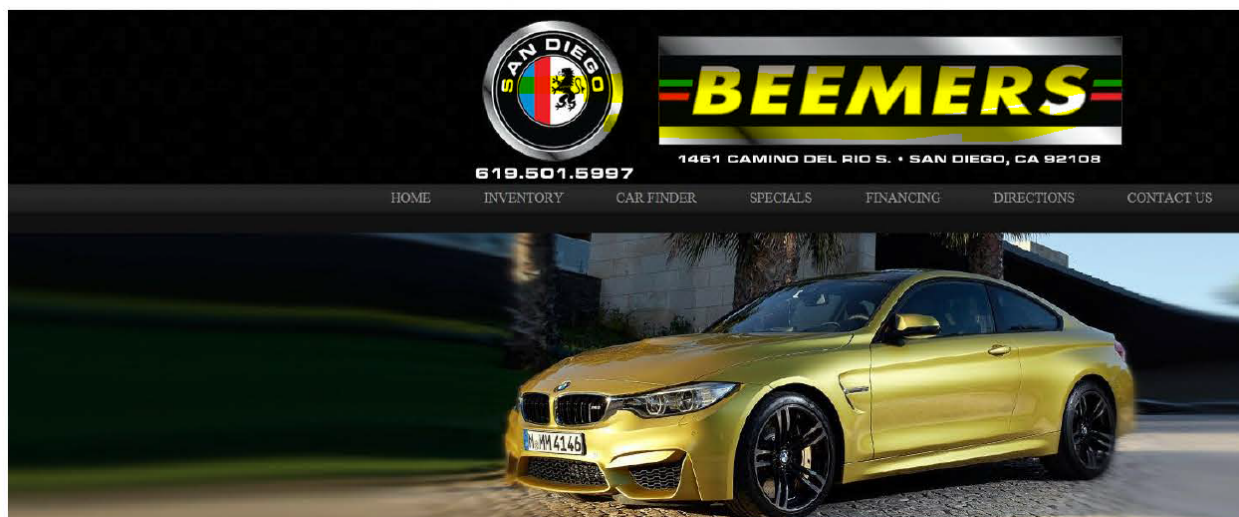
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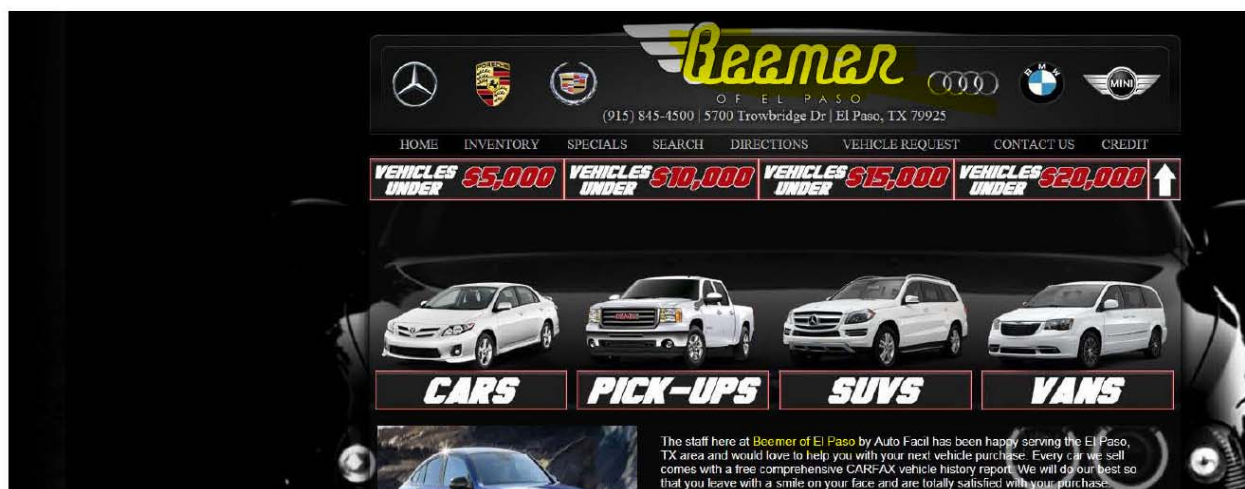
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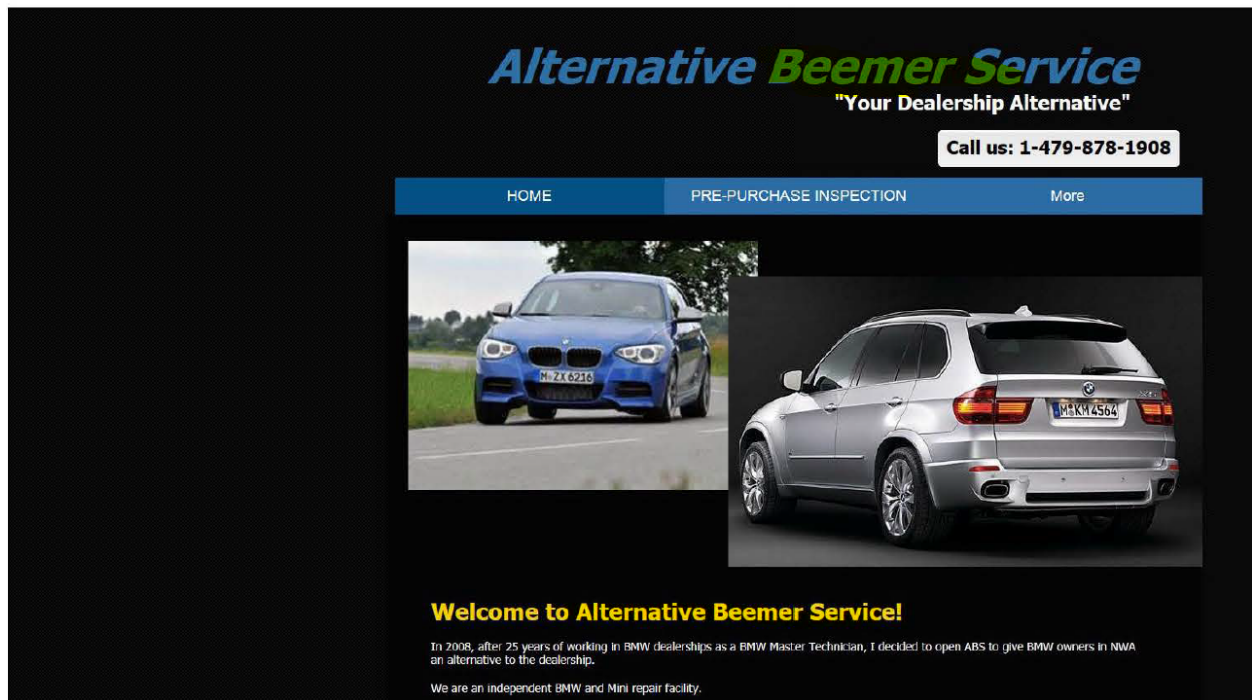


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Id. at 17, 19, 21, 23, 24, 26, 28, 30.


For its part,⁸ Applicant relies on the Complaint filed and Stipulated Judgment and Permanent Injunction issued in BMW's federal trademark infringement, dilution and unfair competition case against Applicant in 2000.⁹ June 20, 2018 Office Action response TSDR 26-53. In the Complaint, BMW challenged Applicant's use of the BMW mark and variations thereof, but not Applicant's use of BEEMER, if any. *Id.* at 27-41. In the Stipulated Judgment and Permanent Injunction, Applicant stipulated that it infringed the BMW mark and to an injunction against its continued use of

⁸ The Examining Attorney's objection to evidence Applicant submitted for the first time with its Appeal Brief is sustained because the evidence is untimely. Trademark Rule 2.142(d).

⁹ *BMW of North America, Inc. v. California Beemers*, Case No. 00-03204 NM (RNBx).

BMW or variations thereof, but neither the stipulation nor the injunction relate to the term BEEMER. *Id.* at 43-53.

Applicant also relies on the following third party registrations:

Mark	Reg. No.	Goods/Services
BEMER (standard characters) (Section 2f claim)	5080758	Medical apparatus and instruments, namely, physical vascular trademark machines ...
BEAMER (standard characters)	5433559	Tobacco accessories, namely, pipe screens, tobacco and smoking implement grinders, ashtrays ...
	4740251	Candles
BEAMER (standard characters)	3667212	Endoscopic surgical products, namely, flexible probes for use in argon gas assisted electrosurgery
	5062900	Association services, namely, promoting the interests of vehicle maintenance and repair service professionals and business owners ... Education services, namely, providing training programs pertaining to vehicle maintenance and repair and the vehicle maintenance and repair business
BIMMER SPECIALIST (standard characters)	3730256	Online retail store services and retail store services in the field of automotive parts and accessories
BimmerFix (standard characters)	4694290	Automotive parts
BEEMERVILLE (standard characters)	4278998	Organizing educational and entertainment exhibitions and cultural events in the nature of motorcycle rallies ... conducting seminars, courses and workshops in the fields of history, safety and products related to motorcycles ...

Id. at 16-24; November 30, 2017 Office Action response TSDR 10-12.

In support of the geographic descriptiveness refusal, the Examining Attorney relies on reference materials about California, which reveal that it is the most populous state in the United States. December 20, 2017 Office Action TSDR 4.

II. False Suggestion of a Connection

In connection with the false suggestion refusal, the Examining Attorney bears the burden of establishing that: (1) CALIFORNIA BEEMERS is the same as, or a close approximation of, BMW's previously used name or identity; (2) CALIFORNIA BEEMERS would be recognized as such, in that it points uniquely and unmistakably to BMW; 3) BMW is not connected with Applicant's activities under the CALIFORNIA BEEMERS mark; and 4) BMW's name or identity is of sufficient fame or reputation that when Applicant uses CALIFORNIA BEEMERS in connection with its services, a connection with BMW would be presumed. *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983); *In re Pedersen*, 109 USPQ2d 1185, 1188-89 (TTAB 2013). *See also Bos. Athletic Ass'n v. Velocity*, 117 USPQ2d 1492, 1495 (TTAB 2015); *Hornby v. TJX Cos., Inc.*, 87 USPQ2d 1411, 1424 (TTAB 2008); *Association pour la defense et la Promotion de L'oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1842 (TTAB 2007); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

A. Is CALIFORNIA BEEMERS the Same As, Or a Close Approximation of, BMW's Previously Used Name or Identity?

The four dictionary entries of record are consistent, corroborate each other and establish that BEEMER is an informal term or nickname for BMW cars. In fact, these dictionary definitions "represent an effort to distill the collective understanding of the

community with respect to language and thus clearly constitute more than a reflection of the individual views of either the examining attorney or the dictionary editors.” *In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1478 (Fed. Cir. 2003).

The dictionary evidence is consistent and confirms that BEEMER has only one meaning, BMW vehicles. To the extent BEEMER may refer to BMW motorcycles as opposed to cars, it is referring to the same ultimate source, BMW, and is thus still BMW’s identity.¹⁰ There is no evidence that BEEMER refers to anything other than BMW or its vehicles. *See Association pour la defense et la Promotion de L’oeuvre de Marc Chagall*, 82 USPQ2d at 1842 (“the MARC CHAGALL mark has no significance other than as the name of the painter Marc Chagall”).

Applicant argues, however, that BEEMER is not the same as BMW’s name or identity because BMW itself does not use BEEMER.

While there are references on the Internet discussing Beemers, there is simply no evidence that Bayerische Motoren Werke AG itself has ever promoted its vehicles under the terms, BEEMERS or BIMMERS. Thus, Applicant contends that it is not reasonable to assume that consumers would believe the services offered by Applicant under the CALIFORNIA BEEMERS are actually offered by Bayerische Motoren Werke AG, that the services offered by Applicant are related to or are, in fact, an official BMW dealership or that there is a false connection to the company. The public, upon viewing Applicant’s mark, would immediately realize that Applicant’s auto dealership is not sponsored by Bayerische Motoren Werke AG and

¹⁰ Applicant cited but failed to introduce into the record a newspaper article and book which apparently indicate that BIMMER is the correct term for BMW cars, and BEEMER is the correct term for BMW motorcycles. Even if this evidence was of record and we found it persuasive, it would not change our ultimate decision.

that the German car manufacturer would not identify itself as a “California” based business.

4 TTABVUE 7-8 (Applicant’s Appeal Brief at 5-6).

Applicant’s argument is not well-taken. As the Examining Attorney points out, even though BEEMER is a nickname or informal name, that is essentially irrelevant to whether BEEMER is BMW’s name or identity, even if BMW does not use the term BEEMER itself. *Bos. Athletic Ass’n v. Velocity*, 117 USPQ2d 1492, 1494-95 (TTAB 2015) (“The fact that neither BOSTON MARATHON nor MARATHON MONDAY is Opposer’s official name is not a dispositive factor. A nickname or an informal reference, even one created by the public, can qualify as an entity’s ‘identity,’ thereby giving rise to a protectable interest.”); *In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1635-36 (TTAB 2015) (PRINCESS KATE falsely suggests a connection with Kate Middleton, even though Ms. Middleton does not use the term herself); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff’d*, 26 F.3d 140 (Fed. Cir. 1994) (finding a false suggestion of a connection with Bo Jackson, stating that “[t]he aforementioned evidence establishes that ‘Bo’ is widely recognized and used as Bo Jackson’s nickname); *Buffett*, 226 USPQ at 429 (“an opposer in a proceeding of this character may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner ... though there may be no likelihood of confusion as to the source of the goods, even under a theory of sponsorship or endorsement, nevertheless an opposer’s right to control the use of its identity may be violated”) (citing *Notre Dame*, 217 USPQ at 509).

Applicant's argument that consumers would not assume that BMW would identify itself as a California-based business is unsupported by any evidence. Furthermore, the argument is belied by the evidence that BMW has United States-based dealers. July 18, 2018 Office Action TSDR 13 (printout indicating that Kelly BMW is located in Columbus, Ohio). We do not need additional evidence to know that a number of foreign automobile manufacturers have American dealers, including in California, or that the public is aware of this.¹¹ Thus the term CALIFORNIA in the involved mark simply identifies the location of Applicant's business. *See Pierce Arrow Society v. Spintek Filtration, Inc.*, 2019 WL 3834985 (TTAB 2019) ("Society' merely identifies the nature of Opposer's entity and serves only to call attention to its referent, the term 'PierceArrow,' which is common to Opposer's name and Applicant's mark.").

Applicant's reliance on the lawsuit BMW filed to challenge Applicant's use of the BMW mark is also misplaced. While BMW's lawsuit was focused on the BMW mark, and BMW did not also challenge Applicant's use of CALIFORNIA BEEMERS in the lawsuit, there is no evidence that Applicant was even using CALIFORNIA BEEMERS at the time, 19 years ago.¹² Moreover, even if Applicant was using the term in 2000, and BMW chose not to challenge that use at that time, BMW could very well object now. In any event, BMW is not a party to this ex parte appeal, its current

¹¹ While some consumers could very well perceive CALIFORNIA BEEMERS as a term used by a California-based BMW dealer, we need not so find. This prong of the test merely asks whether CALIFORNIA BEEMERS is a close approximation of BMW's name or identity.

¹² Neither Applicant's claimed date of first use of CALIFORNIA BEEMERS in its involved application, nor its specimen of use, constitutes evidence of Applicant's use of the term in commerce. In any event, the specimen is undated and was not submitted to the Office until 2017.

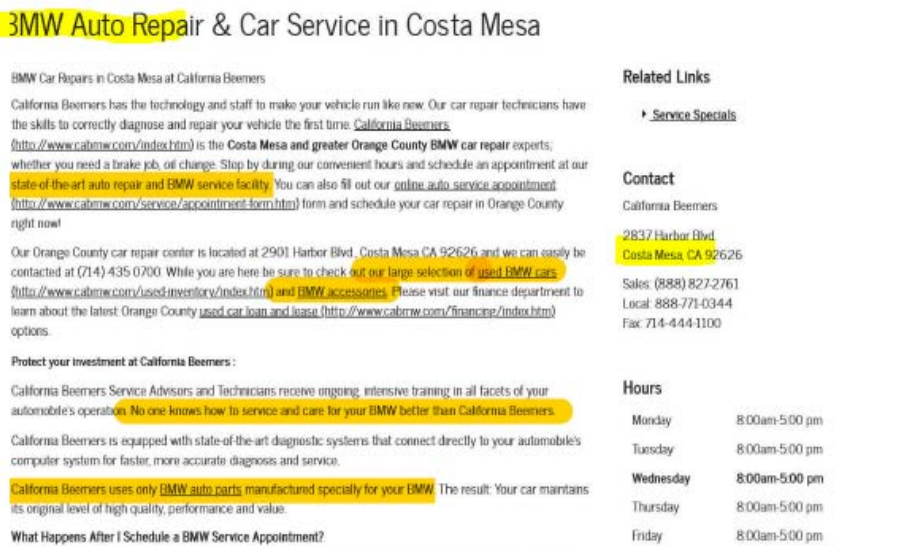
views are unknown and the question under Section 2(a) in the ex parte context is not whether or to what extent BMW objects, but whether the term in question falsely suggests a connection with BMW.

B. Would CALIFORNIA BEEMERS Be Recognized as BMW's Name or Identity and Point Uniquely and Unmistakably to BMW?

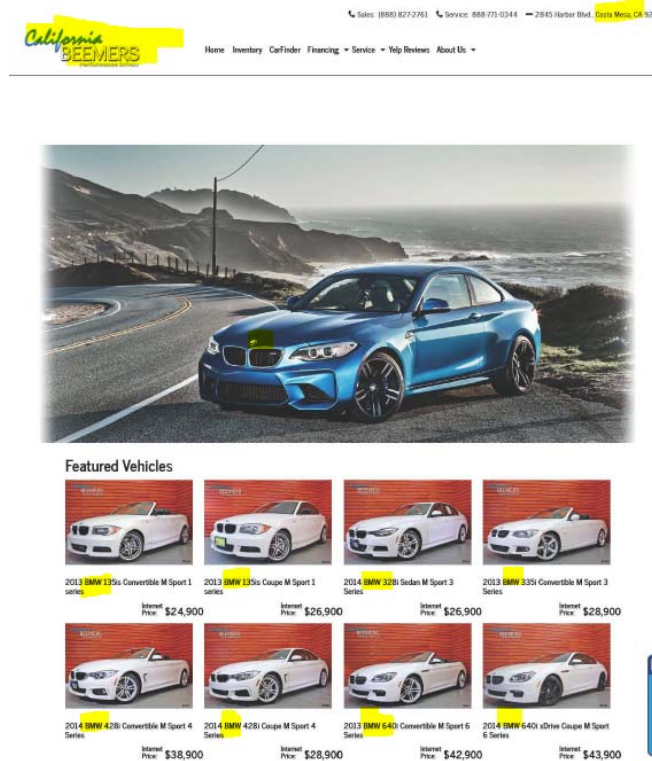
In determining whether CALIFORNIA BEEMERS would be recognized as BMW's name or identity, the question is whether it points "uniquely and unmistakably" to BMW "in the context of" Applicant's services. *Hornby*, 87 USPQ2d at 1424, 1426-27; *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re Wielinski*, 49 USPQ2d 1754, 1757 (TTAB 1998). The record reveals that it does.

In fact, Applicant uses the term CALIFORNIA BEEMERS for automobile dealership services, with no limitation on the type of automobiles or type of dealership. In other words, Applicant's identification of services in Class 35 encompasses both new and used car sales. Thus, if Applicant obtained a registration, it could use CALIFORNIA BEEMERS for new cars, including even new BMW cars. Similarly, Applicant's identification of services in Class 37 is unlimited with respect to the type of automobiles on which Applicant would provide its customization and repair services. Thus, Applicant could service or customize BMW vehicles. *See In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1508 (TTAB 2009) ("Applicant's use of the former U.S. Customs Service seal in connection with its offer of legal services 'concentrating' on U.S. customs law is strong evidence that applicant is attempting to draw a connection between its services and the agency that oversees customs issues").

Applicant’s website makes clear that CALIFORNIA BEEMERS points uniquely and unmistakably to BMW. Indeed, Applicant specifically intends to point uniquely and unmistakably to BMW, as it promotes its “BMW Service”:



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And as the media and other third party uses of BMW set forth above make clear, BEEMER is a commonly-used and recognized nickname or informal name for BMW and its vehicles, while CALIFORNIA merely identifies Applicant's location and where it performs its services.

Applicant's argument that BEEMER does not point uniquely and unmistakably to BMW because third parties own registrations for variations of the term in connection with automobile-related goods and services is misplaced. The only evidence Applicant relies upon in support of this argument is third party registrations for BIMMER SPECIALIST, BIMMERFIX, BIMRS & Design and BEEMERVILLE, summarized in the chart above. These registrations do not support Applicant's argument for several reasons.

First, there is no evidence supporting Applicant's mere assumption that none of the third parties are affiliated with or authorized by BMW.¹³ Second, "neither the Trademark Examining Attorney nor the Board is bound to approve for registration an Applicant's mark based solely upon the registration of other assertedly similar marks for other goods or services having unique evidentiary records." *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merit Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court."). Third, generally mere "third-party registrations are not evidence of third-party use of the registered marks in the marketplace" *In re Davey Prods. Pty Ltd.*, 92 USPQ 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). *See also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them"). Fourth, three of the four registrations Applicant cites do not even include the term in question, BEEMER. Moreover, the only registration for a non-unitary mark containing BIMMER is registered on the Supplemental Register, because of either a finding or concession that the term

¹³ The BEEMERVILLE registration is owned by BMW Motorcycle Owners of America, Inc.

BIMMER SPECIALIST is merely descriptive of retail store services in the field of automobile parts and accessories.¹⁴ Finally, “applicant has pointed to no case law holding that third-party registrations and/or applications should be accorded significant weight in our analysis of a Section 2(a) false suggestion refusal. In this case, we are unable to conclude from the third-party [BEEMER/BIMMER/BIMRS] registrations that the public is aware of the marks shown therein such that the term [BEEMER/BIMMER/BIMRS] does not point uniquely to [BMW].” *In re White*, 80 USPQ2d at 1660.

In short, CALIFORNIA BEEMERS points to BMW uniquely, and unmistakably. Indeed, Applicant’s specimens and all of the evidence reveal that the term BEEMER points to nothing else.

C. Is Applicant Connected to BMW or Its Activities?

Applicant concedes that it is not connected to BMW or its activities. 4 TTABVue 11 (Applicant’s Appeal Brief at 9).

¹⁴ Neither the “fair use” nor the “noncommercial use” defense are applicable in Board proceedings, such as this one, in which a party is claiming and attempting to register trademark rights rather than asserting non-trademark, noncommercial or fair use. *See e.g.* 15 U.S.C. §§ 1115(b)(4) and 1125(c)(3)(C); *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1298 (TTAB 2010) (“the ‘noncommercial use’ exception set out in Trademark Act § 43(c)(3)(C) does not apply in a Board proceeding involving a mark sought to be registered as a trademark or service mark, because an applicant seeking registration is necessarily relying on a claim of use of its mark, or intended use of its mark, in commerce.”); *Truescents LLC v. Ride Skin Care, L.L.C.*, 81 USPQ2d 1334, 1338 (TTAB 2006) (fair use “is a defense available to a defendant in a federal action charging infringement of a registered mark, and it has no applicability in inter partes proceedings before the Board, which deal with the issue of registrability ... Applicant is not using the words GENUINE and SKIN merely in a non-trademark, descriptive manner, but instead has included those words as part of the mark it seeks to register. This is trademark use, not non-trademark fair use”).

D. Is BMW Sufficiently Famous that When Applicant Uses CALIFORNIA BEEMERS a Connection with BMW Would Be Presumed?

The inquiry under this Section 2(a) factor differs from the traditional likelihood of confusion or dilution analyses of fame in that “the key is whether the name per se ... *as used* would point uniquely to the person or institution.” *In re White*, 73 USPQ2d 1713, 1720 (TTAB 2004) (emphasis in original); *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999). Thus, we must consider whether Applicant’s use of CALIFORNIA BEEMERS “would point consumers of the goods or services uniquely to a particular person or institution.” *In re White*, 73 USPQ2d at 1720. The record reveals that it would.

In fact, the evidence establishes that BMW and its cars are widely reported on and discussed in the media, including national publications such as Time Magazine, and by third parties. *See e.g.*, May 31, 2017 Office Action TSDR 17; July 18, 2018 Office Action TSDR 6-13, 15, 17, 19, 21, 23, 24, 26, 28, 30. In these materials, BMW cars are often referred to as BEEMERS. Some articles specifically mention BMW’s “reputation,” or its “meticulously engineered” and “quality” cars which are “designed to be distinct.”

Applicant uses CALIFORNIA BEEMERS for some of the same services BMW offers: automobile dealerships and automobile repair. Perhaps more importantly, Applicant does not just use CALIFORNIA BEEMERS with cars generally. Rather, it uses the term specifically in connection with selling and repairing BMW-manufactured cars, and its website highlights this specific connection.

Therefore, Applicant's use of CALIFORNIA BEEMERS would point automobile buyers and owners of automobiles in need of repair uniquely to BMW. Indeed, the record establishes BMW's fame in the United States for cars, and given Applicant's use of BMW's nickname BEEMER for car sales and car repair, "we may draw an inference that applicant intends to create a connection with" BMW, and that the public would make the false association. *In re Peter S. Herrick*, 91 USPQ2d at 1509 (citing *In re N. Am. Free Trade Ass'n*, 43 USPQ2d 1282, 1285 (TTAB 1997) (quoting *Univ. of Notre Dame*, 217 USPQ at 509)).

III. Conclusion

The Examining Attorney has established that use of Applicant's proposed mark would falsely suggest a connection with BMW.¹⁵

Decision: The refusal to register Applicant's proposed mark under Section 2(a) of the Trademark Act is affirmed.

¹⁵ We need not reach the refusal under Section 2(e)(2) of the Act. *In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018).