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U.S. Application Serial No. 88343768

Mark: ROXWRAP

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Reference/Docket No. 68938-177

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant, Mahindra Vehicle Sales and Service, Inc., appeals a refusal to register the applied-for mark "ROXWRAP" in Application Serial No. 88343768, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on a likelihood of confusion with the mark in Registration No. 4438298 ("ROX SPEED FX").

II. FACTS AND BACKGROUND

Applicant seeks registration of the mark “ROXWRAP” in standard characters for “Pre-designed vehicle wraps specifically adapted for utility terrain vehicles (UTVs)” in International Class 12.

On May 31, 2019, the examining attorney issued an Office action refusing the applied-for mark under Trademark Act Section 2(d) based on a likelihood of confusion with Registration No. 4438298 for the mark “ROX SPEED FX” in standard characters for “Parts and accessories for snowmobiles, namely, handlebars, handlebar risers, handguards, handguard mounts, handguard flares, running board grip strips, running board edge grippers, running board traction plates, running board powder grips, number plates, snake straps, bar pads and sticker wraps; parts and accessories for all-terrain vehicles (ATVs), namely, handlebars, handlebar risers, handguards, handguard mounts, handguard flares, dash panels, relocation plates, ring levers, bar pads, lock spacers and sticker wraps; parts and accessories for motorcycles, namely, handlebars, handlebar risers, handguards, handguard mounts, handguard flares, dash panels, bar pads, lock spacers and sticker wraps” in International Class 12, “Clothing, namely, hats” in International Class 25, and “Retail store services and online ordering services featuring clothing” in International Class 35.

On November 15, 2019, applicant responded, providing arguments and evidence addressing the Section 2(d) refusal, which the examining attorney found unpersuasive. As a result, on November 26, 2019, the examining attorney issued a final refusal, maintaining the refusal based on a likelihood of confusion with Registration No. 4438298 and providing additional evidence. On May 26, 2020, the applicant requested reconsideration of the final refusal, and provided arguments and evidence addressing the Section 2(d) refusal. The examining attorney found applicant’s arguments unpersuasive, and on June 15, 2020 denied applicant’s request for reconsideration. This appeal followed.

III. ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark so resembles the registered mark, when used in connection with their respective identified goods, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

IV. ARGUMENT

APPLICANT'S MARK CREATES A CONFUSINGLY SIMILAR COMMERCIAL IMPRESSION TO THE CITED REGISTERED MARK, AND THE PARTIES' GOODS ARE CLOSELY RELATED, SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT, 15 U.S.C, § 1052(d).

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "du Pont factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192

USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

In this case, the following factors are the most relevant: the similarity of the marks, and the similarity and related nature of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. APPLICANT’S MARK IS CONFUSINGLY SIMILAR TO REGISTRANT’S MARK BECAUSE THE MARKS ARE SIMILAR IN APPEARANCE, MEANING, SOUND, AND COMMERCIAL IMPRESSION

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant’s mark is “ROXWRAP” in standard characters. The registered mark is “ROX SPEED FX” in standard characters.

In this case, applicant’s mark “ROXWRAP” creates a confusingly similar overall commercial impression as the cited registered mark “ROX SPEED FX.” Both marks lead with the identical and distinctive term “ROX.” The inclusion of the disclaimed descriptive terms “SPEED FX” in registrant’s mark and the generic term “WRAP” in applicant’s mark does not obviate the similarity between the two marks “ROXWRAP” and “ROX SPEED FX.” The primary visual, aural, and connotative impact of both

marks is “ROX,” and both marks present essentially the same overall commercial impression due to this shared dominant term.

The distinctive and leading term “ROX” is the dominant element in both marks. 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 Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Matter that is disclaimed, or that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)). In the present case, the registered mark disclaims “SPEED FX.” The term “WRAP” in applicant’s mark is generic for applicant’s goods, which are identified as “pre-designed vehicle **wraps** specifically adapted for utility terrain vehicles (UTVs)” (emphasis added).

The compound nature of applicant’s mark “ROXWRAP” does not obviate the generic significance of the term “WRAP” in the context of applicant’s goods, or otherwise take away from the dominance of the term “ROX.” Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding terms that are generic, descriptive, or suggestive of the named goods or services; if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See* TMEP §1207.01(b)(iii). Here, a consumer encountering the mark “ROXWRAP” for vehicle wraps will immediately appreciate the generic meaning of “WRAP” even when preceded by the distinctive term “ROX,” as consumers are accustomed to compound mark formatives that identify both the source (“ROX”) and the generic wording for the product (“WRAP”). Thus, the word “WRAP” in applicant’s mark and the wording “SPEED FX” in the registered mark are less significant in terms of affecting the respective marks’ commercial impression, and render the term

“ROX” the most dominant element of each mark. It is the identical term “ROX” in both marks that carries the source-identifying significance, and including additional descriptive or generic terms is not sufficient to change the overall connotation or commercial impression to one which is not confusingly similar.

Both marks incorporate the identical initial and dominant term “ROX,” and consumers are most likely to retain and recall this term. 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) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).

Both marks incorporate the identical term “ROX,” creating an overall similar commercial impression. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Applicant argues that the shared term “ROX” is “conceptually weak” because: it is the phonetic equivalent of “rocks,” that “rocks” is laudatory and/or suggestive, and that consumers will therefore look to the other elements in the marks to distinguish them. The evidence of record does not support the assertion that the term “ROX” is weak when used in the context of the goods at issue. The shared term in the marks is “ROX,” not “ROCKS,” and the series of mental leaps undertaken by applicant to get from the coined term “ROX” to the contention that it is laudatory (i.e., “[it] rocks!”) or suggestive (of rocks, e.g., rocky terrain) is the very hallmark of a distinctive term. Further, applicant has asserted that “[i]n Applicant’s mark, ‘ROX’ is a clear reference to Applicant’s well-known registered, house mark ROXOR under which Applicant sells utility terrain vehicles (‘UTVs’) and related accessories” (applicant’s Request for Reconsideration of May 26, 2020, TSDR Pgs. 4 and 12-16). “ROX” appearing as a callback to applicant’s distinctive house mark is likewise distinctive. Finally, the grammatical format of neither “ROXWRAP” nor “ROX SPEED FX” supports the conclusion that terrain or praise is meant. “ROX” is the first element of both marks, not the end like a laudatory phrase of “rocks!” or otherwise indicating terrain.

Although there is no mechanical test to determine the dominant element of a mark, consumers would be more likely to perceive a distinctive term, even if suggestive, rather than a generic or descriptive term as the source-identifying feature of the mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059-60 (TTAB 2017) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009)). In this case, even if “ROX” is at best suggestive, suggestive elements are still distinctive, and “ROX” is the dominant element in the mark.

Applicant argues that the examining attorney’s analysis gives “undue weight to the presence of ‘ROX’ in both marks.” 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. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985)). And, moreover, when viewed in their entireties, “ROXWRAP” and “ROX SPEED FX” are confusingly similar. Differences of a few syllables and the inclusion of descriptive or generic terms are not sufficient to obviate the identical impact of “ROX.” The meaning and connotation of applicant’s mark “ROXWRAP” is confusingly similar to the meaning and connotation created by the registered mark “ROX SPEED FX.” While the marks differ in minor ways, they nevertheless convey essentially the same idea based on the shared term “ROX.” The additional wording in each mark does not outweigh the similarities created by the leading, identical, distinctive term “ROX.”

“ROXWRAP” and “ROX SPEED FX” are confusingly similar, and consumers encountering the marks in the same commercial channels are likely to confuse the marks or at least mistake the underlying sources of closely-related goods provided under the marks

B. THE PARTIES’ GOODS ARE SIMILAR, CLOSELY RELATED, AND PROVIDED BY THE SAME SOURCES

The refusal to register should also be affirmed because the parties’ goods are similar, closely related, and provided by the same sources. The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

Applicant's goods are "Pre-designed vehicle wraps specifically adapted for utility terrain vehicles (UTVs)" in International Class 12, and registrant's goods, most relevantly, are "Parts and accessories for snowmobiles, namely...sticker wraps; parts and accessories for all-terrain vehicles (ATVs), namely...sticker wraps; parts and accessories for motorcycles, namely...sticker wraps" in International Class 12. These goods are very similar and closely related, as they are all wraps used for the purpose of decorating and/or refinishing light and sporty outdoor land vehicles. The same entities commonly provide wraps for these goods, and the goods are used for the same purpose and travel in the same channels of trade.

1. The Evidence Of Record Demonstrates The Similarity Of The Goods

Applicant's and registrant's goods are closely related and emanate from the same sources. Applicant's goods are vehicle wraps adapted for UTVs, and registrant's goods include sticker wraps for snowmobiles, ATVs, and motorcycles. These goods are very similar and closely related, as they are all wraps used for the purpose of decorating and/or refinishing light and sporty outdoor land vehicles. The same entities commonly provide wraps for these goods, and the goods are used for the same purpose and travel in the same channels of trade. The Internet evidence attached to the Office action of May 31, 2019, consisting of screenshots from third party retailers CamoWraps, WakeGraphics, and Invision Artworks, shows the same entities commonly provide wraps for ATVs, UTVs, and motorcycles (TSDR Pgs. 5-10). The Internet evidence attached to the final Office action of November 26, 2019 consisting of screenshots from third party retailers Botgals, Mossy Oak Graphics, Vividracing, and CreatorX Custom Graphics, shows the same entities commonly produce, market, and/or provide wraps in the nature of body stickers or decals for UTVs, ATVs, snowmobiles, and motorcycles (TSDR Pgs. 5-27). Thus, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Applicant argues that “sticker wraps” in registrant’s identification of goods is unclear, that the term “vehicle wrap” (not “sticker wraps”) is properly used to describe applicant’s goods, and that registrant’s goods are merely vinyl stickers. However, the terminology of “sticker wraps” in the cited registration is not unclear or undefined. The term “sticker wrap” is used to describe wraps used for the purpose of decorating and/or refinishing vehicles such as UTVs, ATVs, snowmobiles, and motorcycles, as shown in the evidence attached to the final Office action of November 26, 2019 in the nature of product listings from Allterrain Depot, Amazon, and Bonanza, Botgals, eBay, TCSLAW Market, and Vividracing, all of which use the phrase “sticker wrap” to describe and identify these goods (TSDR Pgs. 5-20; 22-27). As such, “sticker wraps” in the cited registration is not clear or undefined, and the evidence shows that, in the marketplace, both “sticker wraps” and “vehicle wraps” are used to identify the goods of both applicant and registrant. Applicant also submitted screenshots from registrant’s website showing vinyl stickers, arguing that registrant’s goods are simply stickers and therefore not highly similar and closely related to registrant’s goods. However, there is no evidence that the vinyl stickers from registrant’s website are the “sticker wraps” identified in the cited registration. Instead, the evidence shows that the everyday understanding in the field of the term “sticker wraps” are the same or closely similar goods to the “vehicle wraps” of applicant. Moreover, the plain reading of “sticker wraps” in registrant’s identification of goods is that these are indeed “sticker wraps,” not vinyl stickers, due to the deliberate use of the word “wrap” in the identification. Applicant seeks to recast registrant’s clear and definite “sticker wraps” into an entirely different product in order to advance its argument that the goods are not related, but there no doubt that the nature of the goods in the registration are closely related to the “vehicle wraps” identified by applicant. Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

2. The Evidence Of Record Does Not Support The Assertion That The Relevant Consumers Are Sophisticated Or Exercise A Higher Standard Of Care

Applicant argues that the relevant consumers are sophisticated, and that the goods and the vehicles on which they are used are high in cost and consumers would therefore exercise a higher degree of care. Assuming for the sake of argument that some of the relevant consumers who purchase the relevant goods are indeed sophisticated, 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); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 375518 (Fed. Cir. 2019). Moreover, while applicant asserts that the price of its own wraps start at \$16,000, that snowmobile wraps range in price from \$2,000 to \$10,000, and that UTV wraps range in price from \$300 to over \$2,000, the examining attorney's evidence shows prices for numerous wraps under \$100, including as low as \$26.40 (Response of November 26, 2019, TSDR Pg. 16). The evidence of record does not support the assertion that the purchasing process for these goods are subject to a higher degree of care by sophisticated consumers.

V. CONCLUSION

For the foregoing reasons, applicant's mark "ROXWRAP" conveys a confusingly similar overall commercial impression to that of the cited registration, "ROX SPEED FX." Furthermore, the marks are used on goods that are very closely related because they are provided by the same sources under the

same marks and marketed to similar consumers in the same channels of trade. Given the similarities between the marks, consumers encountering the marks for such closely related goods are likely to confuse the marks or at least mistake the underlying sources of the services bearing the marks. The examining attorney notes that the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register the applicant's mark under Trademark Act Section 2(d).

Respectfully submitted,

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