

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: November 16, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*The RV Factory, LLC*

*v.*

*Luxe RV, Inc., DBA Luxe RV*

—  
Cancellation No. 92068961

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Michael T. Smith of Birch, Stewart, Kolasch & Birch, LLP, for The RV  
Factory, LLC.

Saleem Hawatmeh, of Wingert Grebing Brubaker & Juskie, LLP, for  
Luxe RV, Inc.

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Before Lykos, Adlin, and Johnson,  
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Luxe RV, Inc. (“Respondent”), doing business as Luxe RV, is the owner of record of the registered mark LUXE RV<sup>1</sup> (“Respondent’s Mark” or “Registration”), issued on the

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<sup>1</sup> Registration No. 5252621 (the “621 Registration”) was issued on the Supplemental Register on July 25, 2017, from an underlying application filed on December 15, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C § 1051(a). “RV” is disclaimed.

Citations to the record or briefs are to the publicly available documents in TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

Supplemental Register for “Rental of vehicles; Rental of motor vehicles; Rental of traction vehicle and trailers; Vehicle rental; Providing a website featuring information about RV parking; Rental of motor homes,” in International Class 39.

By way of its amended Petition for Cancellation,<sup>2</sup> The RV Factory, LLC (“Petitioner” or “RV Factory”) seeks to cancel the Registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Respondent’s Mark, as applied to the services identified in the Registration, so resembles Petitioner’s mark, LUXE<sup>3</sup> (“Petitioner’s Mark”), previously used in connection with “Recreational vehicles, namely, fifth wheel travel trailers,” as to be likely to cause confusion, mistake, or to deceive. Petitioner alleges that its application to register its LUXE mark was refused registration based on a likelihood of confusion with Respondent’s Mark (Amended Petition, 9 TTABVUE 7¶ 9; Petitioner’s Brief, 46 TTABVUE 9), but neither party made Petitioner’s application of record.<sup>4</sup>

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Citations to application and registration records refer to the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO).

<sup>2</sup> Amended Petition for Cancellation (“Amended Petition”), 9 TTABVUE 5-10.

<sup>3</sup> On February 12, 2016, Augusta RV, LLC (“Augusta”), Petitioner’s predecessor-in-interest, filed an application to register the standard character mark LUXE with the USPTO, Serial No. 86906468. *See* 46 TTABVUE 9; 56 TTABVUE 8. Augusta executed a nunc pro tunc assignment of the LUXE mark to Petitioner with an effective date of October 31, 2016. The assignment was recorded in the records of the USPTO on June 30, 2018 at Reel 6369/Frame 0056. 24 TTABVUE 6.

<sup>4</sup> In their briefs, both Petitioner and Respondent state that the evidence of record includes the file for Petitioner’s LUXE application, Serial No. 86906468. *See* 46 TTABVUE 7; 56 TTABVUE 7. However, the application file is not included in any notice of reliance or any other evidentiary filing for this case. The prosecution file for Petitioner’s application does not form part of the record in a petition for cancellation without any action by the parties. *See* Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

In its Answer,<sup>5</sup> Respondent denies the salient allegations of the Petition for Cancellation and asserts four purported affirmative defenses, including the equitable defenses of acquiescence and laches.<sup>6</sup> (18 TTABVUE 4-5). As to acquiescence, Respondent alleges that Petitioner “actively represented that a right or claim would not be asserted against Respondent or the ‘621 Registration” (18 TTABVUE 4 ¶ 9), and that Respondent relied on that representation. (18 TTABVUE 5 ¶ 11). As to laches, Respondent alleges that it has been materially prejudiced by Petitioner, who waited over twelve months after the ‘621 Registration issued to bring this cancellation action, while Respondent built “a valuable business and goodwill around [Respondent’s Mark] during the time that Petitioner never objected.” (18 TTABVUE 5 ¶ 15).

The case is fully briefed. In order for Petitioner to prevail on its likelihood of confusion claim based on its common law rights in LUXE, Petitioner’s asserted mark must be distinctive, inherently or otherwise, and then Petitioner must show priority of use. *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981)). Petitioner also bears the burden of proving its statutory entitlement to bring a cause of action and Trademark Act Section 2(d) claim for cancellation by a preponderance of the evidence.

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<sup>5</sup> 18 TTABVUE.

<sup>6</sup> In addition, Respondent asserts that “Petitioner’s putative LUXE mark is merely descriptive of Petitioner’s goods.” 18 TTABVUE 4. We construe this assertion not as an affirmative defense, but as an amplification of Respondent’s denial of a likelihood of confusion. *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*4 n.5 (TTAB 2021) (amplification of a denial of likelihood of confusion should not be pled as a separate affirmative defense); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) (in opposition based on likelihood of confusion, pleading that opposer’s mark is merely descriptive and has not acquired distinctiveness is unnecessary, since establishing that its unregistered mark is distinctive is an element of opposer’s case in chief), *aff’d*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021).

*Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997); *West Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994).

Having considered the evidentiary record, the parties' arguments, and applicable authorities, for the reasons set forth below, we grant Petitioner's Section 2(d) claim and the Petition for Cancellation overall.

### **I. Evidentiary Issues**

Respondent filed two motions to strike certain testimony proffered by Petitioner, including exhibits to two declarations and documents submitted through Petitioner's Notice of Reliance. (See "Motion to Strike Testimony," 25 TTABVUE and 39 TTABVUE). The Board ruled on several of the issues in Orders at 36 TTABVUE and 43 TTABVUE. However, some of the issues were deferred until final hearing. (See 36 TTABVUE 3, 8-9; 43 TTABVUE 4-5). We address the outstanding issues below.

#### **A. Alleged Failure to Disclose Third-Party Webpages in Pretrial Disclosures**

Respondent argues that Petitioner's pretrial disclosures do not disclose "that any witness will introduce webpages belonging to third parties." (25 TTABVUE 3). For that reason, Respondent seeks to strike all of the third-party webpages introduced through the declarations of Messrs. Shea<sup>7</sup> and Thomas (24 TTABVUE), proffered by Petitioner pursuant to Trademark Rule 2.121(e), 37 C.F.R. § 2.121(e). Trademark Rule 2.121(e) requires disclosure of, in relevant part, "a general summary or list of the types of

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<sup>7</sup> The evidence of record does not include any third-party websites as exhibits to the Declaration of Brian Shea, 24 TTABVUE 2-83.

documents and things which may be introduced as exhibits during the testimony of the witness.” (25 TTABVUE 3).

Under subsection (e)(3), 37 C.F.R. § 2.123(e)(3), “[a] motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).” FED. R. CIV. P. 37(c)(1) governs whether evidence will be excluded from evidence for failure to disclose it, or allowed because the failure to disclose is substantially justified or harmless. *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1101 (TTAB 2018) (citing *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011) (internal citations omitted)). The Board considers the following five-factor test when determining whether to strike evidence or testimony that has not been adequately disclosed in a party’s pretrial disclosures: “1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) the importance of the evidence; and 5) the nondisclosing party’s explanation for its failure to disclose the evidence.” *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015) (Board struck from record forty-six exhibits attached to respondent’s testimony deposition; in its pretrial disclosures, respondent failed to identify a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness) (quoting *Great Seats*, 100 USPQ2d at 1327 (internal citation omitted)).

Petitioner’s Pretrial Disclosures (25 TTABVUE 12-14) do not state that Messrs. Shea and Thomas will testify about, or disclose, **third-party** webpages. The document discloses

generally, pursuant to FED. R. CIV. P. 26(a)(3)(A)(iii), “Advertisements of the **parties**, including, but not limited to, Internet web pages and social media postings.” (25 TTABVUE 13). Petitioner had ample opportunity to cure any possible surprise to Respondent, but instead of doing so, Petitioner argues that its evidence “admittedly contains screen shots from third party sites, but those sites contain listings for Petitioner’s goods bearing the LUXE mark that are being offered for sale on those sites. The disclosure identifies exactly these type of documents, namely, advertisements in the form of Internet web pages, which encompass the third party sites.” (26 TTABVUE 6).

Under FED. R. CIV. P. 26(e)(1), Petitioner was under a duty to supplement or correct its disclosures. *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 408.03 (2022). However, the same third-party webpages Respondent seeks to strike from evidence have been produced as Internet records through Petitioner’s Notice of Reliance. (*See* 44 TTABVUE 3). The better practice would have been for Petitioner to promptly correct its pretrial disclosures, but at this point, Respondent is aware of the third-party webpages, which eliminates the element of surprise. *See Sheetz of Del. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1345 n.7 (TTAB 2013). Therefore, we deny Respondent’s motion to strike them from evidence.

**B. Exhibit C to the Shea Declaration Not Produced in Discovery**

Respondent argues that the documents at Exhibit C of the Shea Declaration were not produced in discovery. (25 TTABVUE 4). Respondent filed a Motion to Compel (19 TTABVUE) responses to the interrogatories and requests for production served on Petitioner, but that motion was denied by the Board. (*See* 23 TTABVUE).

Exhibit C (24 TTABVUE 41-83) consists of promotional material found at Petitioner's website, luxefifthwheel.com.<sup>8</sup> Document request number twelve reads as follows:

REQUEST NO. 12: Representative samples of advertisement and promotional materials (e.g., print, radio, television, brochures, catalogues, flyers, press releases, **website pages**, website banners, in-store displays, point-of-sale promotional items) that have displayed Petitioner's Mark, including documents sufficient to show every manner of presentation of Petitioner's Mark and/or the marks in each type of advertisement or promotional material, and each type of service or service promoted in such materials.

19 TTABVUE 22 (emphasis added). In response to the motion to strike, Petitioner argues:

Exhibit C to the Shea Declaration consists of representative pages from the web site at the URL luxefifthwheel.com. During discovery these web site pages were not in the possession, custody, or control of Mr. Shea, and he had no duty to create a tangible representation of the pages from the site for production. The site was, and continues to be, publicly accessible, and the document introduced as Exhibit C was not generated until just prior to the time of Mr. Shea's Declaration. **Thus, there was no duty to produce Exhibit C in response to Registrant's discovery requests, and Exhibit C should not be stricken as a sanction.**

Petitioner's Response in Opposition to Registrant's Motion to Strike Evidence, 26 TTABVUE 6 (emphasis added).

At a minimum, Petitioner was under a duty to promptly supplement its response to request number twelve, but it declined to do so. *See* FED. R. CIV. P. 26(e)(1); TBMP § 408.03. *See also Zoltek Corp. v. U.S.*, 71 Fed. Cl. 160, 164 (Ct. Cl. 2006) ("The duty to supplement is a continuing duty, and no additional interrogatories by the requesting party are required to obtain the supplemental information—rather, the other party has an affirmative duty

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<sup>8</sup> The pages of Exhibit C also lack a URL path on each page, as well as the date on which the pages were allegedly printed. However, the Board allowed Petitioner to cure those deficiencies in its July 6, 2021 Order. *See* 43 TTABVUE 4.

to amend a prior response if it is materially incomplete or incorrect.”) (citations omitted). However, the same documents at Exhibit C also have been produced — with URL paths and dates on which the pages were accessed — as Internet records through Petitioner’s Notice of Reliance. (See 44 TTABVUE 2-3). Again, the better practice would have been for Petitioner to promptly supplement its response to request number twelve, but at this point, Respondent is aware of the subject matter of the documents at Exhibit C. See *Sheetz of Del.*, 108 USPQ2d at 1345 n.7. Therefore, we deny Respondent’s motion to strike Exhibit C from the Shea Declaration for failure to produce those documents during discovery.

**C. Trustworthiness and Competency: Shea Declaration Exhibits B and C**

Respondent also contends that the documents at Exhibits B and C of the Shea Declaration (24 TTABVUE 7-40, 41-83, respectively) should be stricken from the record “for failure to authenticate these putative business records and indicating a lack of trustworthiness under [Federal Rule of Evidence] 803(6)(E).” (25 TTABVUE 7). Specifically, Respondent argues that “Mr. Shea lays no foundation for these documents to be introduced as business records. He fails to establish that he is a competent witness, what the data in the documents is intended to reflect, when they were created, or whether they were kept and created by someone with knowledge of the facts stated therein.” (25 TTABVUE 7). Petitioner argues that Mr. Shea is competent to testify as a witness with knowledge, and Mr. Shea has knowledge that the documents are what they are claimed to be for purposes of authentication. (See 26 TTABVUE 3-4).

Exhibit B consists of a variety of confidential documents captioned as: RV Factory order forms for 2017 and 2018 LUXE Fifth Wheel RVs (24 TTABVUE 7-25, 33, 35-40); RV



Factory “purchase agreements” (24 TTABVUE 26-29, 31-32); RV Factory “MSRP” (24 TTABVUE 30); and RV Factory “Invoice.” (24 TTABVUE 34). Exhibit C (24 TTABVUE 41-83), discussed above, consists of printed pages from Petitioner’s luxefifthwheel.com website.

Mr. Shea testified, in relevant part:

2. I am the managing member of The RV Factory LLC, which is the Petitioner in this Cancellation proceeding. Unless otherwise stated herein, I have personal knowledge of the facts set forth below, and if called as a witness, I could and would competently testify thereto.

6. Since acquiring the LUXE mark and the application therefor in 2016, The RV Factory has used the LUXE mark continuously in connection with the sale of fifth wheel recreational vehicles (RVs).

7. A true and correct copy of representative invoices for RVs marketed and sold by The RV Factory under the LUXE mark is attached hereto as **Exhibit B**.

9. Since at least as early as June of 2017, The RV Factory has continuously promoted its LUXE-brand RVs on a web site at the URL luxefifthwheel.com. A true and correct copy of representative pages from the web site are attached hereto as **Exhibit C**.

Declaration of Brian Shea (“Shea Decl.”), 24 TTABVUE 2 ¶ 2; 3 ¶¶ 6, 7, 9. In a supplemental declaration, Mr. Shea further testified, in relevant part:

5. Exhibit B to my testimony declaration are true and correct copies of The RV Factory invoices, which reflect the sale of LUXE brand RVs by The RV Factory. 24 TTABVUE 7-40. I confirm that the invoices were made and kept in the course of regularly conducted business activity of The RV Factory.

6. The invoices in Exhibit B are business records that are routinely made and kept in the course of business, in The RV Factory’s usual practice.

7. The invoices in Exhibit B were made at or near the time of the transactions they record, and the invoices were made by a person with knowledge, or from information transmitted by a person with knowledge, and who reported such knowledge in the regular course of business.

Supplemental Declaration of Brian Shea, 38 TTABVUE 2-3.

Under FED. R. EVID. 803(6)(E) (“Records of a Regularly Conducted Activity”), a record of an act, event, condition, opinion or diagnosis is not excluded by the rule against hearsay, regardless of whether the declarant is available as a witness, if “the opponent does not show that the source of information or the method or circumstances of preparation indicate a lack of trustworthiness.” Here, the documents at Exhibit B clearly show, on their face, titles, customer names, order dates, specifications, and prices. Most of the documents are typed, and feature Petitioner’s RV Factory logo or Petitioner’s physical address printed in a standard location on the document. The documents at Exhibit C clearly display Petitioner’s LUXE mark, Petitioner’s physical address, along with other identifying information.

Although not all of the documents at Exhibit B are captioned as “invoices,” we find that they are trustworthy, not only because of what they show on their face, but also because we find Mr. Shea, Petitioner’s managing member, competent to testify as to the custody of these business records, as well as the fact that the records are what they claim to be, based on his personal knowledge. For the same reasons, we find the documents from Petitioner’s website at Exhibit C to be trustworthy. Testimony of a witness with knowledge that an item is what it is claimed to be satisfies the authentication requirement. *See* FED. R. EVID. 901(a), (b)(1). *See also U.S. v. Vayner*, 769 F.3d 125, 130 (2d Cir. 2014) (“the bar for authentication of evidence is not particularly high. ... The proof of authentication may be direct or circumstantial. The simplest (and likely most common) form of authentication is through the testimony of a witness with knowledge that a matter is what it is claimed to be.”). Therefore, we overrule Respondent’s trustworthiness objection to the documents at Exhibits B and C of the Shea Declaration, and we overrule Respondent’s objection

regarding the competency of Mr. Shea to testify about the documents at Exhibits B and C of his declaration.

**D. Trustworthiness and Competency: Thomas Declaration Exhibits B and C**

Next, Respondent contends that Exhibits B and C of the Thomas Declaration (24 TTABVUE 90-91, 92-133, respectively) should be stricken from the record for a lack of trustworthiness. (25 TTABVUE 7-8; 42 TTABVUE 4-5). Specifically, Respondent argues that Mr. Thomas testifies that Exhibit C comprises “invoices and related documents,” but he does not state what a “related document” is, nor does he “identify which documents are ‘invoices’ and which merely are ‘related.’” (42 TTABVUE 4-5). Respondent further argues that Mr. Thomas is not competent to testify as to the contents of Exhibits B and C. (25 TTABVUE 8). In response, Petitioner argues that Mr. Thomas is competent to testify because “he has personal knowledge of the facts about which he testifies in his Supplemental Declaration.” (41 TTABVUE 4).

Exhibit B to the Thomas Declaration (24 TTABVUE 90-91) is a confidential document dated “10/11/2013” and captioned “Invoice.” The word “PAID” is stamped prominently on the document. Exhibit C to the Thomas Declaration (24 TTABVUE 92-133) consists of a variety of confidential documents, many of which are captioned with “LUXE by Augusta” in stylized lettering. Below the stylized lettering is the phrase “*AUGUSTA RV—CONFIDENTIAL PRICING.*” (24 TTABVUE 93-114, 116-17, 127-28, 132). The remainder of documents at Exhibit C, which are confidential, are an invoice from Augusta RV (24 TTABVUE 115), a LUXE by Augusta “check list” (24 TTABVUE 118), orders and invoices from third parties (24 TTABVUE 119-24), an ARV “change order” (24 TTABVUE 126), Augusta RV “buyer’s agreement[s]” (24 TTABVUE 129, 131), a “decision notification”

email message (24 TTABVUE 130), and a document from a credit union captioned “Title and Registration Information.” (24 TTABVUE 133).

Mr. Thomas initially testified that he had personal knowledge of the facts set forth in his declaration:

2. I was the managing member of Augusta RV, LLC (Augusta). Unless otherwise stated herein, I have personal knowledge of the facts set forth below, and, if called as a witness, I could and would competently testify thereto.

Declaration of George Thomas (“Thomas Decl.”), 24 TTABVUE 84. In a supplemental declaration, Mr. Thomas further testified, in relevant part:

2. I was the managing member of Augusta RV, LLC (Augusta). Unless otherwise stated herein, I have personal knowledge of the facts set forth below, and, if called as a witness, I could and would competently testify thereto.

4. I previously provided declaration testimony regarding Augusta’s adoption and use of the LUXE mark in connection with the sale of RVs. *See* 24 TTABVUE 84-87.

5. Exhibit B to my testimony declaration is a true and correct copy of an Augusta invoice, which reflects Augusta’s first sale of a LUXE brand RV. 24 TTABVUE 90-91. I confirm that the invoice in Exhibit B was made and kept in the course of regularly conducted business activity, and that Exhibit B accurately reflects a commercial transaction for the sale of a LUXE brand RV from Augusta to Fedders Marine and RV.

6. The invoice in Exhibit B is a business record that was routinely made and kept in the course of business, in Augusta’s usual practice.

7. The invoice in Exhibit B was made at or near the time of the transaction that it records, and the invoice was made by a person with knowledge, or from information transmitted by a person with knowledge, and who reported such knowledge in the regular course of business.

8. Exhibit C to my testimony declaration is true and correct copies of Augusta invoices and related documents, which pertain to the sale of LUXE brand RVs by Augusta. 24 TTABVUE 92-133. I confirm that the invoices and business records in Exhibit C were made and kept in the course of regularly conducted business activity.

9. The invoices and documents in Exhibit C are business records that

were routinely made and kept in the course of business, in Augusta's usual practice.

10. The invoices and documents in Exhibit C were made at or near the time of the transactions they record, and the invoices and documents were made by a person with knowledge, or from information transmitted by a person with knowledge, and who reported such knowledge in the regular course of business.

Supplemental Declaration of George Thomas, 38 TTABVUE 4-5.

The documents at Exhibits B and C are business records, and the documents at Exhibit C are "invoices and related documents" that pertain to the sale of LUXE brand RVs by Augusta. The documents at Exhibit C are captioned and clearly show, on their face, titles and data. Thus, we find the documents at Exhibit B and C to be trustworthy, not only because of what they show on their face, but also because we find Mr. Thomas, Augusta's former managing member, competent to testify as to the custody of these business records, as well as to the fact that the records are what they claim to be, based on his personal knowledge. Again, testimony of a witness with knowledge that an item is what it is claimed to be satisfies the authentication requirement. The bar for authentication of evidence is not particularly high, and proof of authentication may be direct or circumstantial. *See* FED. R. EVID. 901(a), (b)(1); *see also Vayner*, 769 F.3d at 130. Therefore, we overrule Respondent's trustworthiness objection to the documents at Exhibits B and C of the Thomas Declaration, and we overrule Respondent's objection to the competency of Mr. Thomas to testify about the documents at Exhibits B and C of his declaration.

#### **E. Remaining Evidentiary Objections**

Regarding any remaining evidentiary objections, we remind the parties that "[t]he Board is entitled to weigh the evidence and has the discretion on how it considers evidentiary objections, especially in cases where numerous objections have been lodged or

the objections are not outcome determinative.” TBMP § 707.01. Keeping this in mind, we will accord the remaining evidence and testimony to which the parties object whatever probative value it has, if any. *See The Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at \*4 (TTAB 2020) (citations omitted), *aff’d in part and vacated in part*, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021); *see also RxD Media*, 125 USPQ2d at 1804 (“the Board is capable of weighing the relevance and strength or weakness of the objected to testimony and evidence, including any inherent limitations”); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (where parties devoted more than 30 pages of their briefing at final hearing to numerous detailed evidentiary objections, Board exercised discretion to rule explicitly only on major objections).

## **II. The Evidentiary Record**

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the prosecution file for Respondent’s LUXE RV registration. The parties also introduced the following evidence:

### **A. Petitioner’s Testimony and Evidence**

Petitioner submitted a revised notice of reliance<sup>9</sup> (44 TTABVUE), introducing into the record:

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<sup>9</sup> The Board struck the documents at 33 and 37 TTABVUE from the record for untimeliness, and because the documents lacked URLs and dates on which they were accessed. *See Order*, 43 TTABVUE 3. In the Order, *see* 43 TTABVUE 3-4, the Board allowed Petitioner to cure the technical deficiencies by submitting a Second Revised Notice of Reliance or exhibits, 44 TTABVUE, that provides “the URLs and access dates in the second Revised Notice of Reliance itself.” However, the exhibits and documents remain at 37 TTABVUE.

1. Printouts of pages from the luxefifthwheel.com website, Exhibit A (originally filed as Exhibit C to the Shea Decl.) (24 TTABVUE 41-83).

2. A printout of the following online article at Exhibit B (originally filed as Exhibit A to the Thomas Decl.) (24 TTABVUE 88-89):

*Augusta to Debut Luxe Fiver At FRVTA '14 Show*, RVBUSINESS (Nov. 14, 2013), <http://www.rvbusiness.com/augusta-to-debut-luxe-fiver-at-frvta-14-show/>.

3. A printout of the following online article at Exhibit C (originally filed as Exhibit E to Thomas Decl.) (24 TTABVUE 152-56):

Chris Hemer, *Luxe Life*, TRAILER LIFE (Dec. 22, 2015), <http://www.trailerlife.com/rv-gear/rvs/luxe-life/>.

4. Printouts of pages from the smartrvguide.com website at Exhibit D (originally filed as Exhibit D to Thomas Decl.) (24 TTABVUE 134-51).

In addition, Petitioner submitted:

5. The testimony Declaration of Brian Shea, managing member of The RV Factory, LLC, with Exhibits A-C (24 TTABVUE).

6. The rebuttal Declaration of Brian Shea, with Exhibit A (34 TTABVUE).

7. The Supplemental Declaration of Brian Shea (38 TTABVUE 2-3).

8. The Declaration of George Thomas, former managing member of Augusta RV, LLC, with Exhibits A-F (24 TTABVUE 84-158).

9. The Supplemental Declaration of George Thomas (38 TTABVUE 4-6).

## **B. Respondent's Testimony and Evidence**

Respondent submitted a Notice of Reliance in several parts (28, 29, and 30 TTABVUE), introducing into the record:

1. Printouts of the following online articles at 28 TTABVUE:
  - a. *10 holiday ideas you should consider this year*, TIME OUT DUBAI (Jan. 12, 2016), <https://www.timeoutdubai.com/travel/features/68849-10-holiday-ideas-you-shouldconsider-this-year> (Ex. A, 28 TTABVUE 7-27).
  - b. *Concierge RV Rental Firm Opens in Calif., Nev.*, RVBUSINESS (Mar. 11, 2016), <https://rvbusiness.com/concierge-rv-rental-firm-opens-in-calif-nev/> (Ex. C, 28 TTABVUE 63-66).
  - c. *Luxe RV Offers “First Class Voyage” to Renters*, RVBUSINESS (Feb. 11, 2017), <https://rvbusiness.com/luxe-rv-offers-first-class-voyage-to-renters/> (Ex. D, 28 TTABVUE 67-71).
  - d. *Luxe RV Offers Luxury RV Rentals in LA*, RV Pro (Jan. 26, 2017), <https://rv-pro.com/news/luxe-rv-offers-luxury-rv-rentals-la> (Ex. E, 28 TTABVUE 71-75).
  - e. Chris Preovolos, *Skip the hotel and rent an RV for Super Bowl?* (Jan. 28, 2016) BEAUMONTENTERPRISE, <https://www.beaumontenterprise.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B1, 28 TTABVUE 28-30).

The article listed at 1.e. is also reprinted at:

CTPOST, <https://www.ctpost.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B2, 28 TTABVUE 31-33).

SANANTONIOEXPRESSNEWS, <https://www.expressnews.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B2, 28 TTABVUE 34-35).

GREENWICHTIME, <https://www.greenwichtime.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B3, 28 TTABVUE 36-38).

CHRON.COM, <https://www.chron.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B3, 28 TTABVUE 39-42).

HOUSTONCHRONICLE, <https://www.houstonchronicle.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B4, 28 TTABVUE 43-44).

SEATTLEPI, <https://www.seattlepi.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B5, 28 TTABVUE 45-47).



MIDLANDDAILYNEWS,<https://www.ourmidland.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B6, 28 TTABVUE 48-50).

NEWHAVENREGISTER,<https://www.nhregister.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B7, 28 TTABVUE 51-53).

STAMFORDADVOCATE,<https://www.stamfordadvocate.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B8, 28 TTABVUE 54-56).

NEWTIMES, <https://www.newstimes.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php>(Ex.B9, 28 TTABVUE 57-59).

THE RIDGEFIELD PRESS,<https://www.theridgefieldpress.com/superbowl/article/Need-a-place-to-stay-for-Super-Bowl-50-Rent-an-RV-6790792.php> (Ex. B10, 28 TTABVUE 60-62).

2. Printouts of the article, *Fernando Alonso “jumped” this summer to Mercedes*, ¡HOLA! (Aug.22,2015) [https://translate.googleusercontent.com/translate\\_c?depth=1&pto=a...-a-mercedes\\_24013\\_102.html&usg=ALkJrhhsK29sADsPid2LX-2pWf8qrip1BA](https://translate.googleusercontent.com/translate_c?depth=1&pto=a...-a-mercedes_24013_102.html&usg=ALkJrhhsK29sADsPid2LX-2pWf8qrip1BA)(English language translation) (Ex. F2, 29 TTABVUE 7-11); original Spanish language article at [https://cronicaglobal.elespanol.com/vida/fernando-alonso-salto-este-verano-a-mercedes\\_24013\\_102.html](https://cronicaglobal.elespanol.com/vida/fernando-alonso-salto-este-verano-a-mercedes_24013_102.html) (Ex. F1, 29 TTABVUE 2-6).

3. 2019 INC. 5000 Rank and profile of Luxe RV, <https://www.inc.com/profile/luxe-rv> (Ex. G, 29 TTABVUE 12-16).

4. “RV hire in September,” TripAdvisor San Francisco Travel Forum (Mar. 15, 2019), [https://www.tripadvisor.com/ShowTopic-g60713-i30-k12408161-RV\\_hire\\_in\\_September-San\\_Francisco\\_California.html](https://www.tripadvisor.com/ShowTopic-g60713-i30-k12408161-RV_hire_in_September-San_Francisco_California.html) (Ex. H1, 29 TTABVUE 17-25).

5. “Which RV renting company is better?” TripAdvisor Road Trips Forums (2015), [https://www.tripadvisor.com/ShowTopic-g1-i12567-k8262736-Which\\_RV\\_renting\\_company\\_is\\_better-Road\\_Trips.html](https://www.tripadvisor.com/ShowTopic-g1-i12567-k8262736-Which_RV_renting_company_is_better-Road_Trips.html) (Ex. H2, 29 TTABVUE 26-31).

6. "Luxe RV Rental," Yelp, <https://www.yelp.com/biz/luxe-rv-rental-calabasas> (Ex. I, 29 TTABVUE 32-47).

7. Various entries from the Facebook pages for Luxe RV-Calabasas, [https://www.facebook.com/pg/luxerv/about/?ref=page\\_internal](https://www.facebook.com/pg/luxerv/about/?ref=page_internal) and [https://www.facebook.com/pg/luxerv/community/?ref=page\\_internal](https://www.facebook.com/pg/luxerv/community/?ref=page_internal) (Exs. J1 and J2, 29 TTABVUE 48-52); <https://www.facebook.com/luxerv/videos/vb.1489246924673963/1996999490565368/?type=2&theater> (Ex. J4, 29 TTABVUE 68); <https://www.facebook.com/luxerv/> (Ex. J5, 29 TTABVUE 70-272); and Luxe RV-Hallandale, [https://www.facebook.com/luxervflorida/?modal=admin\\_todo\\_tour](https://www.facebook.com/luxervflorida/?modal=admin_todo_tour) (Ex. J3, 29 TTABVUE 53-67).

8. Printed pages from the Luxe RV-Calabasas Instagram account (@luxerv), <https://www.instagram.com/luxerv/?hl=en> (Ex. K, 30 TTABVUE 2-10).

9. Printed pages from the Luxe RV-Calabasas Twitter account (@luxeRVrental), <https://twitter.com/luxeRVrental> (Exs. L and M, 30 TTABVUE 11-164).

10. Printed pages from the Luxe RV YouTube channel <https://www.youtube.com/channel/UC1ej048yRvMYxYSPVHly0iA> (Exs. N and O, 30 TTABVUE 165-77).

In addition, Respondent submitted:

The testimony Declaration of Adrian Ghila (31 TTABVUE), owner of Respondent LUXE RV, Inc., with Ex. A (32 TTABVUE) (confidential) and Exs. B-F (31 TTABVUE).

### III. The Parties

#### A. Petitioner The RV Factory, LLC

Petitioner RV Factory is a limited liability company organized and existing under the laws of the State of Indiana with offices in Elkhart. (9 TTABVUE 5). Petitioner asserts that, through its predecessor-in-interest Augusta, it has manufactured and offered for sale, since at least 2013, LUXE-branded recreational vehicles direct to the consumer. (See 24 TTABVUE 88-91; 37 TTABVUE 58-60). Petitioner proclaims that it is “the premier manufacturer of Luxe luxury fifth wheels<sup>10</sup> using the highest grade components.” (37 TTABVUE 6-7). Shown below are photos of Petitioner’s goods from its [luxefifthwheel.com](http://luxefifthwheel.com) website:

## Luxe Elite Fifth Wheel

The Best Constructed Luxury Fifth Wheel

[See Construction \(/luxury-5th-wheel-construction\)](#)



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<sup>10</sup> A “fifth wheel” is a type of towable recreational vehicle. See 24 TTABVUE 89, 153-56.

<sup>11</sup> Petitioner’s Notice of Reliance, 37 TTABVUE 12.

The Best Constructed Luxury Fifth Wheel

With Attic Storage

[See Construction \(/luxury-5th-wheel-construction\)](#)



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## Luxe Toy Hauler Fifth Wheel

The Best Constructed Luxury Toy Hauler

[See Construction \(/luxury-5th-wheel-construction\)](#)



[https://luxefifthwheel.com/index.php?option=com\\_rsform&view=rsform&formId=16&Itemid=545](https://luxefifthwheel.com/index.php?option=com_rsform&view=rsform&formId=16&Itemid=545)

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<sup>12</sup> 37 TTABVUE 23.

<sup>13</sup> 37 TTABVUE 31. A toy hauler is a towable recreational vehicle that has both a living area and a dedicated garage space. *See* 24 TTABVUE 60-61.

**B. Respondent Luxe RV, Inc.**

Respondent Luxe RV is a Delaware corporation with offices in Panorama City, California.<sup>14</sup> Since at least as early as October 2014, Respondent has used the LUXE RV mark in connection with the rental of recreational vehicles. (56 TTABVUE 7; 31 TTABVUE 2). Shown below are photos of some of the types of vehicles Respondent offers for rent featuring its LUXE RV mark:



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<sup>14</sup> TSDR record for Reg. No. 5252621.

<sup>15</sup> 31 TTABVUE 109.





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#### IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2066 (2014)). A party in the position of plaintiff may seek cancellation of a registration of a mark when doing so is within its zone of interests and it has a reasonable belief in damage that is proximately caused by registration of the defendant's mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating: (1) a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement; and (2) a reasonable belief in damage proximately caused by registration of the mark). *See also Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark*, 109 USPQ2d at 2067-69).

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<sup>16</sup> 29 TTABVUE 245 (cropped image from the Luxe RV-Calabasas Facebook page).

Because Petitioner properly introduced evidence of common law use of its asserted LUXE mark,<sup>17</sup> Petitioner has established its entitlement to a statutory cause of action for the cancellation. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*4 (TTAB 2019) (“standing” established by testimony with exhibits of earlier use of confusingly similar mark); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by showing of common law rights); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1964 (TTAB 2007) (cancellation petitioner’s standing based on prior common law use of elements contained in defendant’s registered marks); *see also* TBMP § 309.03(b) (“Entitlement to a Statutory Cause of Action”).

## V. Priority

Before we can address likelihood of confusion, we must address the issue of priority. Respondent argues that Petitioner’s asserted mark, LUXE, is merely descriptive, has not acquired secondary meaning, and thus, is not a protectable mark. (56 TTABVUE 18-19). In response, Petitioner asserts that: Respondent “has provided no evidence that Petitioner uses LUXE merely to describe a feature or characteristic of Petitioner’s recreational vehicles,” (Petitioner’s Reply Brief, 57 TTABVUE 6); its actual use of LUXE in large, stylized letters on and in conjunction with its goods is not descriptive or merely descriptive of them (57 TTABVUE 6); and the use by its predecessor-in-interest Augusta, if not technically proper, is use analogous to trademark use through which priority can be established, as Augusta created “an association in the minds of consumers of LUXE with

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<sup>17</sup> *See* 24 TTABVUE 88-91; 37 TTABVUE 58-60.

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recreational vehicles prior to Respondent’s first commercial use of LUXE RV.”  
(57 TTABVUE 7-8).

Below are photos from Petitioner’s website showing actual use of the stylized LUXE mark on Petitioner’s goods:



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<sup>18</sup> 37 TTABVUE 6.

<sup>19</sup> 37 TTABVUE 55.



“In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, [plaintiff’s] mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use.” *Wet Seal*, 82 USPQ2d at 1634 (citing *Otto Roth*, 209 USPQ at 43). “[E]ven though something is used as a trademark, if it is not distinctive, the user does not have a trademark because he has no existing trademark rights.” *Otto Roth*, 209 USPQ at 44.

A mark is merely descriptive if it “immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used.” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) (quoting *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980)). *See also Towers v. Advent Software Inc.*, 17 USPQ2d 1471, 1473 (TTAB 1989), *aff’d*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990). Moreover, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), “marks which arguably denote ‘high quality,’ ‘excellence’ and ‘superior quality’ are laudatory and thus merely descriptive.” *In re The Place, Inc.*, 76 USPQ2d 1467, 1468-69 (TTAB 2005).

Generally, for likelihood of confusion purposes, priority with respect to merely descriptive marks lies with the party that was the first to acquire distinctiveness for its mark. *Perma Ceram Enters., Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1136-38 (TTAB 1992). Indeed, with descriptive marks, “the priority contest ... is not solely one of who used the mark first chronologically – rather, the test is which party first achieved secondary meaning in its mark.” *Id.* at 1138 (citing J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (“MCCARTHY”) §16:12 (2d ed. 1984)). Secondary meaning “occurs when, in the minds of the public, the primary significance of a mark is to

identify the source of the product rather than the product itself.” *Real Foods Pty Ltd. v. Frito-Lay North Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000)). Petitioner’s burden of showing acquired distinctiveness increases with the level of descriptiveness; more descriptive terms require more evidence of secondary meaning. *Id.* (citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)). “Evidence of the public’s understanding of [a] term may be obtained from *any* competent source.” *Id.* at 1376 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018); *see also* 127 USPQ2d at 1048-49).

In its Amended Petition, Petitioner alleges that its asserted LUXE mark is distinctive, has become well-known, and that “items sold or marketed under the LUXE mark are immediately and exclusively associated with Petitioner.” (9 TTABVUE 6). Petitioner does not differentiate between its use of the standard character mark, LUXE, and the stylized LUXE mark that appears on its goods and website. Nevertheless, we do not find the degree of stylization of Petitioner’s LUXE mark to be sufficient to “carry the mark” apart from the literal element “luxe.” *See, e.g., Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1700 (TTAB 2006) (“the stylization of applicant’s mark [iSHINE] is not striking or otherwise dramatic; thus, prospective purchasers would readily perceive the essence of applicant’s mark as “iSHINE.”).

Petitioner’s asserted mark, LUXE, which is an adjective defined as “luxurious” or “sumptuous,”<sup>20</sup> is laudatory of the superior quality of Petitioner’s “recreational vehicles,

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<sup>20</sup> *See* March 31, 2016 Office Action for LUXE RV, Serial No. 86850349, at TSDR 4 (MERRIAM-WEBSTER DICTIONARY definition); *see also id.* at TSDR 3 (COLLINS ENGLISH DICTIONARY definition) and TSDR 5 (AMERICAN HERITAGE DICTIONARY definition).

namely, towable fifth-wheel travel trailers,” and thus, is merely descriptive. (*See, e.g.*, 37 TTABVUE 6-11). However, we also find that Petitioner has proffered enough evidence for us to conclude that LUXE has acquired distinctiveness, creating a proprietary right for Petitioner in the mark.

Brian Shea, Petitioner’s managing member, testified that from 2016 through July 14, 2020, “The RV Factory has sold nearly \$46 million dollars in LUXE-brand RVs” (24 TTABVUE 3 ¶ 8), and that “The RV Factory has spent approximately \$400,000 to market its RVs sold under the LUXE mark.” (24 TTABVUE 3 ¶ 10). But we infer that a significant commercial impression is created by the sheer size of the LUXE mark as it is displayed on Petitioner’s goods. As shown in the photo below, the word “LUXE” is displayed in sizeable lettering on Petitioner’s goods. *See also* pp. 19- 20, 24, *supra*. When motorists and non-motorists alike see Petitioner’s colossal recreational vehicles on America’s highways (and elsewhere), the public is exposed to the LUXE mark on full display in large, stylized letters. In addition, evidence of actual confusion proffered by Petitioner (*see* 34 TTABVUE), only bolsters Petitioner’s argument in support of the acquired distinctiveness of LUXE.



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In contrast, Respondent has proffered six online articles (one was reprinted in several publications), social media posts, and a few customer reviews that discuss LUXE RV in conjunction with Respondent's services. (*See generally* 28-31 TTABVUE). Mr. Ghila testified that from 2017 to 2018, Respondent's rental revenues increased over forty percent to more than two million dollars, and that Respondent's advertising spend increased twenty percent, to \$56,000, over the same time period. (31 TTABVUE 5 ¶ 28). Collectively, however, this evidence is insufficient to support a finding that Respondent has acquired distinctiveness in LUXE RV for its identified services. The record lacks any information about circulation figures for the articles or online publications, Respondent's LUXE RV-

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<sup>21</sup> 33 TTABVUE 64.

Calabasas Instagram page, @luxerv, has only 10,600 followers, (see 30 TTABVUE 3), and Respondent's LUXE RV-Calabasas Facebook page has less than 7,000 "total follows." (See 29 TTABVUE 52).<sup>22</sup> Respondent's other social media pages have even fewer subscribers, followers, and "likes."<sup>23</sup> And, the record lacks any context for Respondent's revenues and advertising spend. See, e.g., *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007) ("While there is no question that applicant has spent substantial sums of money to promote his product under the designation ULTIMATE POLO, the numbers only suggest the efforts made to acquire distinctiveness, and do not demonstrate that the efforts have borne fruit.") (citing *In re Pingel Enters. Inc.*, 46 USPQ2d 1811 (TTAB 1988); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991)).

Based on our review of the record, we find that Petitioner's Mark has acquired distinctiveness. As a result, Petitioner has priority in LUXE for "recreational vehicles, namely, towable fifth-wheel travel trailers."

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<sup>22</sup> Respondent's subsisting registration on the Supplemental Register is not entitled to any statutory presumptions of constructive use under Trademark Act Section 7(c), 15 U.S.C. § 1057(c), and is not evidence of anything except that the registration issued. See *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978); *Andrea Radio Corp. v. Premium Imp. Co.*, 191 USPQ 232 (TTAB 1976); *Aloe Creme Labs., Inc. v. Johnson Prods. Co.*, 183 USPQ 447 (TTAB 1974); *Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Aloe Creme Labs., Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970).

<sup>23</sup> Respondent's Luxe RV YouTube channel has 432 subscribers. See 30 TTABVUE 166. Respondent's LUXE RV-Calabasas Twitter page, @luxerVrental, has 212 followers. See 30 TTABVUE 162. And, Respondent's Luxe-RV-Hallandale Facebook page has only ten "likes." See 29 TTABVUE 65.

## VI. Affirmative Defenses: Laches and Acquiescence

### A. Laches

Respondent asserts the affirmative defense of laches. Laches may be asserted in an answer to a cancellation proceeding based on likelihood of confusion. Trademark Act Section 19, 15 U.S.C. § 1069; Trademark Rule 2.114(b)(2), 37 C.F.R. § 2.114(b)(2); *see also* TBMP § 311.02(b).

The elements of a laches defense are: (1) unreasonable delay in the assertion of one's rights against another, and (2) material prejudice to the latter attributable to the delay. *See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). Respondent, who is the party raising the affirmative defense, has the burden of proving it. *See Bridgestone/Firestone Rsch. Inc. v. Auto. Club de l'Ouest de la Fr.*, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001).

We look to the timing of a petitioner's awareness of the registration or underlying application to determine when the unreasonable delay begins to run. For marks such as Respondent's, which are registered on the Supplemental Register, we calculate notice by determining the date on which the petitioner first had knowledge of the issuance of respondent's Supplemental Register registration.<sup>24</sup> *See TPI Holdings, Inc. v. TrailerTrader.com, LLC and Trailer Central LLC*, 126 USPQ2d 1409, 1414 (TTAB 2018) (discussing the differences between Principal Register registrations and Supplemental

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<sup>24</sup> In its brief, Respondent states, incorrectly, "Petitioner had actual notice of Respondent's '349 application on February 29, 2016, and constructive notice of Respondent's '621 Registration on July 25, 2017." 56 TTABVUE 21. Constructive notice does not attach to registrations on the Supplemental Register. *TPI Holdings*, 126 USPQ2d at 1414 (citing *Loma Linda Food Co. v. Thompson & Taylor Spice Co.*, 279 F.2d 522, 126 USPQ 261, 263 (CCPA 1960)); *see* 15 U.S.C. §§ 1057(b), (c); 1094.

Register registrations when calculating the start of unreasonable delay in bringing a cancellation proceeding), *civil action dismissed*, No. 1:18-cv-00125-PLM-RSK (W.D. Mich. June 3, 2019).

Respondent's registration issued on July 25, 2017. On January 10, 2018, Petitioner's application was refused registration because of a likelihood of confusion with Respondent's registration. (46 TTABVUE 9, 57 TTABVUE 10). Thus, the date that laches began to run for purposes of this proceeding is January 10, 2018. The Petition for Cancellation was filed on July 10, 2018. (1 TTABVUE). We do not find a delay of six months to be sufficient to support a laches defense. *See, e.g., Ralston Purina Co. v. Midwest Cordage Co.*, 373 F.2d 1015, 153 USPQ 73 (CCPA 1967) (six month delay could never result in enough prejudice to constitute laches); *Double Coin Holdings*, 2019 USPQ2d 377409 (eight month delay not unreasonable, material prejudice not shown); *Charrette Corp. v. Bowater Comm. Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989) (fourteen month delay does not constitute a laches defense); *Nahshin v. Prod. Source Int'l LLC*, 107 USPQ2d 1257 (TTAB 2013) (eighteen month delay from registration was not long enough to create a laches defense). *See also* MCCARTHY § 20:76 (5th ed. September 2022 Update) (discussing when delay is, and is not, sufficient to support a laches defense).

## **B. Acquiescence**

Respondent also pleads acquiescence as an affirmative defense. In February 2016, counsel for Petitioner's predecessor-in-interest, Augusta, sent a letter to Mr. Ghila, Respondent's owner. The letter states, in relevant part:

Augusta's first use date predates LUXE RV's first use date by at least a year. Furthermore, our client sold its LUXE branded recreational vehicles in at least 14 states from Virginia to California and from Wisconsin to

Florida prior to the filing date of the [application to register LUXE RV]. Accordingly, Augusta RV's rights to the LUXE mark are clearly superior to any rights that LUXE RV could claim.

Furthermore, it appears that LUXE RV may have rented recreational vehicles but has not actually sold recreational vehicles under the LUXE RV mark. Accordingly, Luxe RV is clearly not entitled to registration of the LUXE RV mark for the goods listed in Class 12 of the [application to register LUXE RV].

In light of the foregoing, Augusta RV could successfully oppose registration of the LUXE RV mark and prevent Luxe RV from using that mark. However, Augusta would like to avoid costly and time-consuming opposition proceedings and litigation. Accordingly, Augusta RV is willing to resolve this matter on the following terms and conditions:

1. Luxe RV will amend the [application to register LUXE RV] to delete Class 12;
2. Luxe RV will agree to use and register its LUXE RV mark only in connection with the services presently listed in the [application to register LUXE RV];
3. Luxe RV will only offer the services referred to in point 2 above in the states in which it currently provides such services;
4. Luxe RV will consent to Augusta RV's use and registration of the LUXE mark in connection with any and all recreational vehicles and related goods and services.

If Luxe RV is unwilling to agree to these terms, Augusta RV will oppose registration of the [application to register LUXE RV] and seek to prevent Luxe RV from using the LUXE mark. I look forward to your response.

31 TTABVUE 111-12 (dated Feb. 29, 2016).

To establish acquiescence, the Board requires a respondent to prove that the petitioner's conduct amounted to an assurance to respondent, "either express or implied[,] that [petitioner] w[ould] not assert [its] trademark rights against the [respondent]." *Brooklyn Brewery Corp. v. Brooklyn Brew Shop*, 17 F.4th 129, 2021 USPQ2d 1069, at \* 7 (Fed. Cir. 2021) (citing *CBS, Inc. v. Man's Day Publ'g Co.*, 205 USPQ 470, 474-75



(TTAB 1980); *Coach House Rest. Inc. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1558 (11th Cir. 1991) (setting forth test for acquiescence in trademark cases)).

In support of its acquiescence affirmative defense, Respondent argues:

On February 29, 2016, Counsel for Augusta RV, demanded, among other things, that Respondent amend its '349 Application to delete Class 12. (31 TTABVUE 111-112) In exchange for accepting these terms, Augusta represented to Respondent that Augusta would 'resolve this matter.' *Id.* Respondent complied with this request. (31 TTABVUE 5) Augusta took no further action. *Id.* Respondent relied on Augusta's representation that the matter was resolved after Respondent complied with Augusta's demand. *Id.*

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Respondent relied on Petitioner's conduct, which amounted to an assurance to Respondent, that Petitioner would not assert a right or claim against Respondent's use of its mark in connection with the rental of recreational vehicles as to the amended the '349 Application. *Id.* The '349 Application matured in [sic] the '621 Registration on. [sic] July 25, 2017. Respondent, now the holder of a validly registered trademark, relied on Petitioner's silence and continued to build a valuable business around the LUXE RV mark. *Id.* From 2017 to 2018 alone, Registrant experienced a 40% increase in revenue, to over \$2 Million, accompanied by a 20% increase in advertising spend, from \$46,000 to \$56,000. *Id.* Respondent's business and advertising expenditures only have continued to grow. *Id.*

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In the time between Augusta's representation that it would not assert a right or claim against Respondent and Petitioner's filing of this Petition for Cancellation, Respondent has grown its business, expanded its reach, and developed a strong association between the LUXE RV mark and its services. Respondent's economic position dramatically changed based on Petitioner's acquiescence to the use of the mark. Petitioner cannot overcome its undue delay in bringing this action. Respondent would be irreparably harmed if it is forced to change its position based on Petitioner's reversal of its acquiescence for Respondent to use its LUXE RV mark.

Respondent's Brief, 56 TTABVUE 19-21.

In response, Petitioner argues that Respondent's acquiescence defense must fail since there is no evidence of record demonstrating Respondent's compliance with all of the requirements of the above-referenced letter, specifically that: (1) Respondent offer its RV rental services only in the states where it was doing business at the time, and (2) Respondent consent to Petitioner's use and registration of the LUXE mark "in connection with any and all recreational vehicles and related goods and services." (57 TTABVUE 10).

In fact, the record only includes Petitioner's letter — not any type of consent agreement. However, the record does include a representative sample of invoices for recreational vehicle rental services provided by Respondent under the LUXE RV mark before and after February 29, 2016. (31 TTABVUE 11-58). Obviously, Petitioner, through Augusta, was aware of Respondent's LUXE RV rental services after February 29, 2016 but the record does not include testimony or evidence revealing all of the states where Respondent offered its services on or before February 29, 2016. Nor does the record include any follow-up communication to the February 29, 2016 letter from Petitioner, Augusta, or Respondent. In the meantime, Respondent continued to build its business after it expressly abandoned Class 12 from its then-pending application to register LUXE RV. (See 32 TTABVUE 3, Ex. A (designated Confidential/Attorney's Eyes Only) (showing Respondent's rental revenues and advertising expenditures from 2014 through 2019)). As a result, we find Respondent's asserted acquiescence defense, based on what appear to be express and implied assurances by Augusta, to have merit.

However, acquiescence cannot serve as a bar against a petition for cancellation based on likelihood of confusion if confusion is, in fact, inevitable. When confusion is inevitable, any possible injury to respondent is outweighed by preventing confusion in the interest of

the public. *TPI Holdings*, 126 USPQ2d at 1418-19 (citing *Ultra-White Co. v. Johnson Chem. Indus., Inc.*, 465 F.2d 891, 175 USPQ 166, 167 (CCPA 1972); *Hornby v. Tjx Cos.*, 87 USPQ2d 1411, 1419 n.9 (TTAB 2008); *Christian Broad. Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1572 (TTAB 2007)).

## VII. Whether Confusion Is Inevitable

In determining likelihood of confusion, as well as inevitable confusion, we consider all of the *DuPont* factors that are relevant in this case and for which there is evidence of record. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also *Turner v. Hops Grill & Bar, Inc.*, 52 USPQ2d 1310, 1313 (TTAB 1999) (“to determine whether confusion is inevitable, we must use the multifactor analysis required by [*du Pont*]”). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, \*3 (Fed. Cir. 2020). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

The standard required for a finding of inevitable confusion is “an increment higher than that required for a finding of a likelihood of confusion.” *Coach House*, 19 USPQ2d at 1409; see also *Turner*, 52 USPQ2d at 1313 n.5. Generally, confusion has been found to be inevitable when the respective marks and goods or services are identical, or nearly identical. See, e.g., *Metro Traffic Control*, 41 USPQ2d at 1373 (affirming Board’s finding that confusion was “so likely that it is virtually inevitable, because the parties are using the identical mark for the identical services”) (internal citation omitted); *Ultra-White*,

175 USPQ at 167 (confusion inevitable for nearly identical BRIGHT WHITE and BRIGHTWHITE marks for laundry products). Other cases involving findings of inevitable confusion were based, at least in part, on evidence of actual confusion. *See, e.g., Resorts of Pinehurst, Inc. v. Pinehurst Nat'l Corp.*, 148 F.3d 417, 47 USPQ2d 1465 (4th Cir. 1998) (“[The trademark owner’s] strong proof of likelihood of confusion—indeed, actual confusion—trumps the defenses of laches and acquiescence.”).

We discuss Petitioner’s rights in its LUXE mark, the *DuPont* factors which are relevant,<sup>25</sup> and the supporting evidence of record, below.

### **A. Actual Confusion**

First, we consider the nature and extent of any actual confusion among consumers in view of the length of time and conditions under which there has been contemporaneous use of LUXE and LUXE RV. *DuPont*, 177 USPQ at 567. Evidence of actual confusion, where it exists, is highly probative. *Sabhnani*, 2021 USPQ2d at \*42-43 (citing *Brooklyn Brewery*, 2020 USPQ2d 10914, at \*19 (internal citation omitted)). “Properly introducing instances of actual confusion into the record and persuading the trier of fact as to the probative value of such evidence is [Petitioner’s] burden.” *Id.* (quoting *Brooklyn Brewery*, 2020 USPQ2d 10914, at \*19).

Respondent summarily dismisses Petitioner’s allegation of actual confusion, stating that it is not aware of any actual confusion, and argues that any alleged evidence of actual confusion is “insubstantial.” Respondent further argues “Petitioner’s allegations of

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<sup>25</sup> Respondent discussed the “fame of the prior mark” *DuPont* factor in its brief, *see* 56 TTABVue 16-17, but here, Respondent’s Supplemental Register mark is not the “prior mark”; none of the presumptions available to Principal Register registrations attach to Supplemental Register ones. *See* 15 U.S.C. §§ 1057(b), (c); 1094. Moreover, we have already found that Petitioner has priority. Therefore, the “fame of the prior mark” factor is inapplicable to Respondent’s LUXE RV.

confusion are suspect because the alleged instances of confusion came only after Petitioner filed this Petition for Cancellation.” (56 TTABVUE 18). And Mr. Ghila, Respondent’s owner, testified that there have been no instances of actual confusion between LUXE and LUXE RV. (31 TTABVUE 8 ¶ 49).

Petitioner, however, makes a strong case for the existence of actual confusion based on the evidence of record. According to Petitioner’s managing member, Brian Shea, there have been several instances of actual consumer confusion since Petitioner and Respondent have coexisted in the marketplace.

In September 2020, while he was attending an RV demonstration in Pennsylvania, a customer approached Mr. Shea and expressed his reluctance to purchase a LUXE-brand recreational vehicle because of Petitioner’s supposed “F” grade with the Better Business Bureau (BBB). (34 TTABVUE 3 ¶¶ 5-6). Petitioner’s actual BBB rating was an “A+” in 2020. (34 TTABVUE 3 ¶ 8; 18-21). In contrast, Respondent’s BBB rating was an “F” in 2020. (34 TTABVUE 6-16). After further discussion, Mr. Shea learned that the customer confused The RV Factory with Luxe RV. (34 TTABVUE 3 ¶¶ 7, 9).

Mr. Shea also testified that he received a cease and desist letter on behalf of The RV Factory on October 26, 2020. (34 TTABVUE 4 ¶ 11; 25-34). The letter, written by an attorney at a law firm, alleges that Respondent infringed copyrights in photos that were posted on its website. (34 TTABVUE 4 ¶ 11; 25-34). Notably, the letter was addressed to Respondent at Petitioner’s mailing address in Indiana (as well as at Respondent’s mailing address in California). (34 TTABVUE 4 ¶ 11; 25).

Finally, Mr. Shea testified that in an undated text message to his mobile phone, his realtor asked him whether the recreational vehicle his realtor saw on the road belonged to Petitioner. (34 TTABVUE 3 ¶ 10).

Petitioner has proffered at least two instances of actual confusion that occurred in September and October 2020. Even though the text message sent to Mr. Shea is undated and more questionable, based on the record, we find that Petitioner has satisfied its burden for proving at least some actual confusion. This *DuPont* factor weighs heavily in favor of inevitable confusion.

### **B. The Similarity or Dissimilarity and Nature of the Goods and Services**

Next, we consider the relatedness of the goods offered under Petitioner's LUXE mark and the services offered under Registrant's LUXE RV mark. In this regard, we look to the identification of services in Respondent's registration, as well as any goods for which Petitioner has established prior use. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The issue is not whether the goods and services will be confused with each other, but rather whether the public will be confused as to the source of the goods and services. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 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. It is this sense of relatedness that matters in the likelihood of confusion analysis.”).

It is well recognized that confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the

other. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1307 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (finding clothing and sports apparel retail services related as “confusion is likely where one party engages in retail services that sell goods of the type produced by the other party”); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (finding BIGGS for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (finding catering food services related to smoked and cured meats); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*13-14 (TTAB 2019) (finding bread buns and retail bakery shops related); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (finding skin cream and distributorship services in the field of health and beauty aids related); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986) (finding clothing and restaurant services related); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (finding retail women’s clothing store services and uniforms related); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (finding refinishing of furniture, office furniture, and machinery related to office furniture and accessories); *Corinthian Broad. Corp. v. Nippon Elec. Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (finding transmitters and receivers of still television pictures related to television broadcasting services).

Petitioner uses its LUXE mark in connection with “Recreational vehicles, namely, fifth wheel travel trailers.” Respondent’s LUXE RV mark is registered for “Rental of vehicles; Rental of motor vehicles; Rental of traction vehicle and trailers; Vehicle rental; Providing a website featuring information about RV parking; Rental of motor homes.” Respondent argues that the goods and services at issue do not overlap and that they are dissimilar in

nature, pointing to evidence demonstrating that “Respondent *rents* drivable Mercedes Sprinter vans, while Petitioner *sells* towable recreational vehicles, namely fifth wheel travel trailers.” (56 TTABVUE 14) (italics in original). Petitioner argues “there is a high probability of a likelihood of confusion” due to, in part, the relatedness of the goods and services. (57 TTABVUE 8-9).

As previously discussed, when determining relatedness of the goods and services, we look to the language in the identification of services in Respondent’s registration, as well as to any goods for which Petitioner has established prior use. Petitioner’s “recreational vehicles” are a type of vehicle or motor home.<sup>26</sup> Respondent’s identification of services specifically recites “rental of motor vehicles” and “rental of motor homes,” and therefore encompasses rental of “recreational vehicles,” which Petitioner offers. Respondent’s services of “Providing a website featuring information about RV parking” are also commercially related to Petitioner’s “recreational vehicles.” In addition, Respondent proffered third-party evidence from Yelp! showing that RV rentals and sales may emanate from the same source. (See 29 TTABVUE 47). So while Petitioner’s and Respondent’s respective goods and services are not identical, they are definitely related. This *DuPont* factor weighs in favor of inevitable confusion.

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<sup>26</sup> A “motor home” is defined as “a large motor vehicle equipped as living quarters.” MERRIAM-WEBSTER DICTIONARY (2022) (<https://www.merriam-webster.com/dictionary/motor%20home>) (last accessed Nov. 2, 2022). A synonym for “motor home” is “recreational vehicle,” or “RV.” *Id.* The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re tapio GmbH*, 2020 USPQ2d 11387, at \*3 n.10 (TTAB 2020).



### **C. Channels of Trade**

There are no limitations as to trade channels or classes of purchasers in Respondent's registration, so it is presumed that Respondent's Mark encompasses all services of the types described, that the services move in all normal trade channels for them, and that services are available to all classes of purchasers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018). Evidence proffered by Petitioner (see 37 TTABVUE 5-57, 70-89) and Respondent (see 31 TTABVUE 4 ¶ 12; see, e.g., 30 TTABVUE 49) demonstrates that recreational vehicles can be offered for sale or rental through the Internet. As discussed above, Respondent also proffered third-party evidence from Yelp! showing RV rentals and sales emanating from the same source, "El Monte RV Rentals & Sales." (See 29 TTABVUE 47). This *DuPont* factor weighs in favor of inevitable confusion as well.

### **D. The Similarity or Dissimilarity of the Marks**

Also, we consider the *DuPont* factor relating to the similarity of the marks. In comparing the marks, we must consider their appearance, sound, connotation, and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Similarity as to any one of these factors may be sufficient to support a finding that the marks are confusingly similar. See *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) ("Similarity in any one of these elements may be sufficient to find the marks

confusingly similar.”) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019)).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)).

We must focus our analysis on the recollection of the average purchaser — here, consumers of recreational vehicles and vehicle rental services — who normally retain a general, rather than specific, impression of trademarks. We remain mindful that “marks must be considered in light of the fallibility of memory.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).

Respondent does not deny that its LUXE RV mark and Petitioner’s LUXE mark, both in standard characters, are “similar.” (56 TTABVUE 13). We find the marks virtually identical in appearance with the generic or descriptive and disclaimed element “RV”<sup>27</sup> in Registrant’s Mark being the only difference between them. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (descriptive terms may be given little weight in reaching a conclusion on likelihood of confusion); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (descriptive or disclaimed matter is often “less significant in creating the mark’s commercial impression”).

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<sup>27</sup> “RV” is the abbreviation for “recreational vehicle.” *See* March 31, 2016 Office Action for LUXE RV, Serial No. 86850349, at TSDR 2.

With respect to sound, we “keep in mind the penchant of consumers to shorten marks.” *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: “the users of language have a universal habit of shortening full names — from haste or laziness or just economy of words.”)). This penchant makes it reasonable to presume that some consumers may shorten Respondent’s Mark by dropping the generic or descriptive and disclaimed term “RV.” Dropping that term makes Petitioner’s Mark and Respondent’s Mark identical in sound when verbalized.

With respect to connotation, Respondent argues that consumers likely to encounter the marks would not be likely to assume a connection between them, inasmuch as Respondent rents Mercedes Sprinter vans that it has converted into luxury recreational vehicles, whereas Petitioner sells recreational vehicles, namely towable fifth-wheel travel trailers. (56 TTABVUE 13-14). However, Respondent’s argument is irrelevant to connotation and overall commercial impression. As previously discussed in Section VII.B., we have already found the services identified in Respondent’s registration to be related to Petitioner’s goods. As to connotation, “luxe,” which is found in both marks, is an adjective defined as “luxurious” or “sumptuous.”<sup>28</sup>

We find that Petitioner’s and Respondent’s marks are nearly identical in appearance, sound, and connotation, thus creating a highly similar overall commercial impression. Accordingly, this *DuPont* factor, the similarity of the marks, weighs heavily in favor of inevitable confusion.

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<sup>28</sup>See dictionary definitions of record, *supra* note 20, at 26.

### **E. Degree of Consumer Care**

Finally, we consider the conditions under which the goods and services are likely to be purchased, e.g., whether on impulse or after careful consideration (i.e., consumer purchasing care). “Purchaser sophistication or degree of care when encountering marks may minimize likelihood of confusion.” *Palm Bay Imps.*, 73 USPQ2d at 1695. “Conversely, impulse purchases of inexpensive items where consumers pay little attention to the source of the products may tend to have the opposite effect.” *Id.* (citing *Recot*, 54 USPQ2d at 1899).

Respondent argues that the purchasers of Petitioner’s goods and Respondent’s services are sophisticated, inasmuch as the price of Petitioner’s goods easily exceeds \$100,000, and the cost of renting Respondent’s vehicles ranges from \$5,000 to over \$25,000. (56 TTABVUE 15-16).

The evidence of record demonstrates that Petitioner’s and Respondent’s respective goods and services are expensive (*see* 37 TTABVUE 5-57, 70-86; 24 TTABVUE 7-40; 31 TTABVUE 3 ¶ 8; 11-58), so we accept that the purchasers of both parties’ offerings exercise a high degree of care. Despite this evidence, “even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the [trade]marks at issue, and therefore immune from source confusion.” *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). The marks are nearly identical in appearance, and the goods and services of both parties here involve recreational vehicles. Thus, potential purchasers of Petitioner’s goods could mistakenly believe that Petitioner also rents recreational vehicles or motor homes. Moreover, Petitioner’s goods and Respondent’s services are not limited to professional purchasers. Where purchasers consist of both professionals and the public, the standard of care for purchasing the goods or services is

that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion*, 110 USPQ2d at 1163). This *DuPont* factor weighs in favor of inevitable confusion as well.

### **VIII. Conclusion**

We have carefully considered the parties' arguments and all of the evidence of record, even if not specifically discussed herein. Petitioner's Mark, LUXE, as used in connection with "Recreational vehicles, namely, fifth wheel travel trailers," has acquired distinctiveness. As a result of the highly similar marks, relatedness of goods and services, overlapping trade channels and consumers, and actual confusion in the marketplace, we find confusion between Petitioner's LUXE mark and Respondent's LUXE RV for "Rental of vehicles; Rental of motor vehicles; Rental of traction vehicle and trailers; Vehicle rental; Providing a website featuring information about RV parking; Rental of motor homes," to be inevitable, despite any heightened purchaser care or any acquiescence which may have occurred. Again, when confusion is inevitable, any possible injury to the respondent is outweighed by preventing confusion in the interest of the public. *TPI Holdings*, 126 USPQ2d at 1418-19 (citations omitted).

**Decision:** The Petition for Cancellation is granted. Supplemental Registration No. 5252621 will be cancelled in due course.