

This Opinion Is Not a  
Precedent of the TTAB

Mailed: November 25, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Reach International, Inc.*  
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Serial No. 97335655  
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Zhi Dong, of Hamre, Schumann, Mueller & Larson, P.C., for Reach International,  
Inc.

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Kathryn E. Coward, Managing Attorney.

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Before Heasley, Thurmon and Allard, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Reach International, Inc. (“Applicant”) seeks registration on the Principal Register of the mark  for: “Radiators for vehicles; Air condensers for vehicles; Vehicle engine parts, namely, intercoolers; Air compressors for vehicles,” in International Class 7 and “Cooling evaporators for vehicles; Parts for heating and air conditioning systems, namely, heater cores for vehicles,” in International Class 11.<sup>1</sup>

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<sup>1</sup> Application Serial No. 97335655, filed on March 29, 2022, based on alleged use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The mark is described as follows: “The mark consists of the stylized blue-colored word ‘REACH’ with a red-colored triangle forming part of letter ‘A’ and letter ‘E’. The white in the mark represents background

The Examining Attorney finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), finding a likelihood of confusion with registered standard-character mark REACH for “Motor vehicles, namely, automobiles, trucks, vans, sport utility vehicles and structural parts therefor; trucks and structural parts therefor; vans and structural parts therefor,” in International Class 12.<sup>2</sup> Applicant and the Examining Attorney have filed briefs, and the appeal is ready for final decision. We affirm the refusal to register.

### **I. Applicable Law**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). When analyzing these factors, the overriding concerns are not only to prevent

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and is not claimed as a feature of the mark.” The colors blue and red are claimed as a feature of the mark.

<sup>2</sup> Registration No. 4110110 issued on March 6, 2012, and has been renewed.

buyer confusion as to the source of the goods or services, but also 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, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

“Each 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). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

## **II. Likelihood of Confusion – Analysis**

In this appeal, Applicant’s primary argument is that the thirteenth *DuPont* factor weighs heavily in favor of a reversal. This argument is based on the Board’s decision

in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012). We will begin our analysis with this issue.

**A. The Thirteenth Factor – *Strategic Partners***

The thirteenth *DuPont* factor examines “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. In *Strategic Partners*, the Board found “the present case involves the unique situation presented by the coexistence of applicant’s existing registration with the cited registration for over five years, when applicant’s applied-for mark is substantially similar to its existing registered mark, both for identical goods.” *Strategic Partners*, 102 USPQ2d at 1400. Applicant argues that the *Strategic Partners* holding should be applied in the present appeal.

In *Strategic Partners*, the applicant owned a registration for a mark (ANYWEARS) that was substantially similar to the mark the applicant sought to register (ANYWEAR), and the existing registration and new application identified identical goods. *Id.* at 1399. The cited registration in *Strategic Partners* issued after the applicant’s prior registration issued. In fact, applicant’s prior registration had coexisted on the Register with the cited mark for over five years. *Id.* Given this “unique situation,” the Board held the thirteenth *DuPont* factor outweighed all other factors and required reversal of the Section 2(d) refusal to register. *Id.* at 1400.

The Applicant in this case obtained a registration in 2005 for a different version of its mark, which is shown below.



This registration was not renewed, and as a result, was cancelled on May 6, 2016. The application that led to the registration of the cited mark was filed on February 14, 2011, and the registration issued on March 6, 2012. As Applicant points out, that means its prior registration was senior to the cited registration, and the two coexisted on the Register for about four years.<sup>4</sup>

The Examining Attorney rejected Applicant's *Strategic Partners* argument because the prior registration was cancelled and because the registrations did not coexist for at least five years on the Register.<sup>5</sup> Applicant responded by identifying Board decisions (nonprecedential) that have applied the *Strategic Partners* holding with coexistence periods shorter than five years.<sup>6</sup>

We agree with Applicant that the *Strategic Partners* holding does not strictly require five years or more of coexistence on the Register. But Applicant ignores the fact that its prior registration was cancelled over eight years ago. The *Strategic Partners* holding is based, in part, on the view that the owner of the cited registration in that case faced no new or different harm if a substantially similar mark was

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<sup>3</sup> Registration No. 3003974, issued October 4, 2005.

<sup>4</sup> 6 TTABVUE 10.

<sup>5</sup> 8 TTABVUE 5.

<sup>6</sup> 6 TTABVUE 10-11.

registered again for the same goods. The prior registration owned by the applicant in *Strategic Partners* had been registered for more than five years, which meant the owner of the cited registration could no longer petition to cancel the applicant's prior registration. See 15 U.S.C. § 1064 (limiting petitions brought under Section 2(d) to the first five years following registration).

In this case, Applicant owns no prior registration. The cited registration stands alone, at least with respect to any registrations owned by this Applicant. If the registration of Applicant's new version of its mark causes harm to the owner of the cited registration, that will be a new harm, not duplicative of any existing situation. These circumstances are entirely different from the "unique situation" the Board faced in *Strategic Partners*. While the Board has applied the *Strategic Partners* holding to time periods of less than five years, we have found no Board decision applying this holding to a case where the applicant's prior registration was cancelled, nor does Applicant cite to any. In at least three recent decisions (all nonprecedential), the Board distinguished *Strategic Partners* for the same reason we do here: because the prior registration was cancelled. *In re FWREF II Rochester, LLC*, 2024 TTAB LEXIS 230, at \*29 (TTAB 2024); *In re Pizza Inn, Inc.*, 2024 TTAB LEXIS 122, at \*22-23 (TTAB 2024); *In re GlobaConnect Inc.*, 2021 TTAB LEXIS 583, at \*15 (TTAB 2021). Applicant's prior registration is cancelled, and cancelled registrations are "not entitled to any of the presumptions of Section 7(b) of the Trademark Act." *In re Embiid*, 2021 USPQ2d 577, at \*35 n.48 (TTAB 2021); see also *In re Hunter Publ'g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)]

presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”).

There is another important distinction between the present appeal and the “unique situation” the Board faced in *Strategic Partners*. Applicant currently seeks registration in two classes (International Classes 7 and 11), but its cancelled registration identified goods solely in International Class 7. While some of the goods identified in the current application appear similar to those identified in the cancelled registration, the current application identifies some goods (e.g., “heater cores for vehicles”) that are not found in the prior registration. See *In re Country Oven, Inc.*, 2019 TTAB LEXIS 381, at \*23 (TTAB 2019) (“Applicant’s only prior registration that has been registered for over five years and thus impervious to a challenge under Section 2(d) is, as noted, for different services.”).

Applicant argues that applying *Strategic Partners* in this appeal “would simply put the parties into their *status quo* ....”<sup>7</sup> We disagree. Not only is the owner of the cited registration not a party to this *ex parte* appeal, but Applicant owns no prior registration for its mark.<sup>8</sup> Rather than simply restoring the *status quo*, Applicant is effectively asking us to “undo” its failure to renew its prior registration. This appeal is not another “unique situation” where the thirteenth *DuPont* factor weighs heavily.

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<sup>7</sup> 6 TTABVUE 6.

<sup>8</sup> It is worth noting that Applicant alleges it has been using the new version of its mark since 2008, but did not seek registration until 2022. Had Applicant not delayed, it might have avoided the current situation.

## B. Similarity of the Marks

To evaluate the similarity of the marks, we consider the marks in their entireties as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). “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 (Fed. Cir. 2019). *Accord, Krim-Ko Corp. v. Coca-Cola Bottling 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.”) (citation omitted).

“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.” *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018).

Applicant does not argue that the marks are dissimilar. Rather, Applicant argues it “has a right to exclude others, including the Registrant, from using of [sic] its



REACH mark on automotive cooling and HVAC goods, because of its long prior use and/or registration.”<sup>9</sup>

Applicant combines *DuPont* factors one and eleven. The argument quoted above appears to go to the eleventh factor, but Applicant owns no prior registration that would create a right to exclude others. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1205 (TTAB 2009). And considering whether Applicant has common law rights superior to the rights of the registrant is not before us, as such a challenge would be an improper collateral attack on the registration. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the validity of the registered mark”). Moreover, as we noted above, the cited registration is more than five years old and can no longer be challenged under Section 2(d), so even a cancellation proceeding would be pointless now. Though Applicant owns no prior registration, we take this argument as a concession that the marks are similar.

The marks are highly similar. Applicant’s mark is a stylized version of the word REACH, and the cited mark is the word REACH, registered in standard characters, which could be used in the same typeface as Applicant’s mark. *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983). The stylization of Applicant’s mark is not striking and merely accents the literal element REACH. We find these marks are similar in sight, sound, meaning and commercial impression. And, as we noted above, it does not appear Applicant contests this fact. The similarity of the marks increases the likelihood of confusion. The eleventh *DuPont* factor is neutral.

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<sup>9</sup> 6 TTABVUE 12.

### C. Similarity or Relatedness of the Goods

Our evaluation of the second *DuPont* factor is based on the goods identified in the Application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A likelihood of confusion may be found if any goods recited in the identification of goods in a particular class in an application are related to any of the goods identified in the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *see also Double Coin Holdings Ltd. v. Tru Dev.*, Pro. No. 92063808, 2019 TTAB LEXIS 347, at \*18 (TTAB 2019); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015). In addition, the goods need only be sufficiently related that a consumer would be likely to assume, upon encountering the goods marketed under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1492 (TTAB 2007).

Applicant did not address this *DuPont* factor and we find the evidence submitted by the Examining Attorney is sufficient to show the goods are related. This evidence shows a number of marks used with automobiles and with automobile parts, including parts of the kind identified in the Application.<sup>10</sup>

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<sup>10</sup> Office Action dated January 13, 2023, at 22-29 (Toyota automobile parts and automobiles); 34-44 (same for Subaru). Final Office Action dated August 18, 2023, at 11-16 (Volkswagen); 22-26 (Audi).

The evidence in the record is sufficient to show that consumers are accustomed to seeing automotive parts and automobiles, identified in the subject Application and the cited registration, respectively, sold under a single mark. *See, e.g., In re Charger Ventures*, 64 F.4th 1375, 1382 (Fed. Cir. 2023) (finding evidence showing that companies are known to offer both residential and commercial real estate services under the same mark supported Board’s finding that the services were relatedness under the second *DuPont* factor). We find the goods are related. This fact increases the likelihood of confusion.

#### **D. Similarity of Trade Channels**

The third *DuPont* factor is also based on the goods identified in the Application and cited registration. As there are no limitations in either identification, we presume the goods flow through all normal trade channels. *In re Viterra Inc.*, 671 F.3d 1358, 1366 (Fed. Cir. 2012).

Applicant argues it has priority and its “trade channels established by 2011 were evidently earlier and different than Registrant’s when Registrant’s REACH-branded automotives [sic] were not in existence yet.”<sup>11</sup> That is not the question here. The question is whether the goods identified in the Application and cited registration overlap today and whether such overlap is likely to continue. We find the trade channels overlap, and are indeed the same, and there is no evidence in the record to

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<sup>11</sup> 6 TTABVUE 13.

suggest this will change in the future. The third *DuPont* factor weighs in favor of a likelihood of confusion finding.

### **E. Actual Confusion or the Lack Thereof**

Applicant submitted a declaration from Xuanying Chen), a person who has worked in “marketing, branding and legal affairs” with Applicant since 2003.<sup>12</sup> The declarant stated that she is not aware of any actual confusion since 2011, the year the cited registration issued.<sup>13</sup> We have no information about the registrant’s scope of the business, geographically or otherwise, so we cannot determine whether there have been actual market conditions that might lead to actual confusion. “The absence of any reported instances of confusion therefore is not meaningful in this case.” *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, \*58 (TTAB 2022). Nor do we know if the registrant has received reports of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (“The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”). For these reasons, we cannot place any weight on Applicant’s assertion of “12 years of

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<sup>12</sup> Request for Reconsideration dated November 17, 2023, at 24-27 (Declaration of Xuanying Chen).

<sup>13</sup> *Id.* at 26.

concurrent use without a single instance of consumer confusion ....”<sup>14</sup> The *DuPont* actual confusion factors are neutral in this appeal, as is often the case.

**F. Conclusion: Weighing the Factors**

The marks are similar, the goods are related and move through the same trade channels. The thirteenth *DuPont* factor is neutral, as the *Strategic Partners* holding is not applicable to this appeal. The remaining factors are neutral. As all relevant factors point to a likelihood of confusion, we must affirm the Section 2(d) refusal.

**Decision:** The Section 2(d) refusal is **affirmed**.

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<sup>14</sup> *Id.*