

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Application of:	§	Trademark Law Office: 123
Neal Technologies, Inc.	§	
an Arizona corporation	§	
Serial No.: 88041096	§	Trademark Examining Attorney:
Mark: <b>BULLETPROOF</b>	§	Matthew Howell

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**RESPONSE TO OFFICE ACTION**

Applicant respectfully responds to the Office Action dated November 5, 2018.

**DESCRIPTION OF GOODS**

Please amend the description of goods as follows:

Delete: "Thermostats for diesel engines."

With this amendment, all goods in this application will be classified in International Class 7.

**ARGUMENT**

Applicant respectfully traverses the rejection raised by the Trademark Examining Attorney.

**1. THERE IS NO LIKELIHOOD OF CONFUSION**

Applicant seeks registration of **BULLETPROOF** in IC 007 for "Automotive components, namely, oil cooler and exhaust gas recirculation coolers for diesel engines; oil filtration systems comprised of filters for diesel engines; water pumps for diesel engines; and fuel injection control modules for diesel engines."

The Trademark Examining Attorney has reviewed the application for registration and has refused registration based on alleged likelihood of confusion with the mark of U.S. Registration No. 5573968 for the mark **BULLETPROOF** in International Class 12: "Molded polyurethane parts for engine mounts for land vehicles: Steering and suspension

systems and parts for steering and suspension systems for vehicles, namely, upper ball joints, lower ball joints, ball joints with control arms, bushing kits, inner tie rods ends, outer tie rod ends, sleeves, idler arms, center links, stabilizer kits, inner sockets and pitman arms.”

Applicant respectfully submits that a review of the *In re: E. I. du Pont de Nemours & Co.* factors do not support a finding of likelihood of confusion.

### A. THE DUPONT FACTORS

As set out in TMEP §1207.01:

In the seminal case involving §2(d), *In re E. I. du Pont de Nemours & Co.*, the U.S. Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). In setting forth the factors, the court cautioned that, with respect to determining likelihood of confusion, “[t]here is no litmus rule which can provide a ready guide to all cases.” *Id.* at 1361, 177 USPQ at 567. Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 1361-62, 177 USPQ at 567-68; see also *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). Furthermore, the significance of a particular factor may differ from case to case. See *du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533 (noting that “any one of the factors may control a particular case”).

### B. APPLICANT AND REGISTRANT HAVE ENTERED INTO A CONSENT AGREEMENT

An important factor in an ex parte likelihood-of-confusion determination and must be considered if there is pertinent evidence in the record:

- The existence of a valid consent agreement between the applicant and the owner of the previously registered mark (see TMEP §1207.01(d)(viii)). The agreement between Applicant and Registrant is attached as **Exhibit 1**.

As set out in TMEP §1207.01(d)(viii):

“In the *In re E. I. du Pont de Nemours & Co.* decision, the Court of Customs and Patent Appeals stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

476 F.2d at 1363, 177 USPQ at 568.

Accordingly, the Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion. See *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); see also *du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568;...

Thus, examining attorneys should give substantial weight to a proper consent agreement. When an applicant and registrant have entered into a credible consent agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely."

Based upon this Consent Agreement alone, in view of the above authority, it is respectfully submitted that the Section 2(d) rejection should be withdrawn.

### C. THE GOODS AND TRADE CHANNELS DIFFER

There are significant differences in the goods to such a degree that confusion is not likely. Registrant's specialty International Class 12 products differ markedly from Applicant's specialty International Class 7 goods. It should be noted that during the prosecution of the Registrant's International Class 12 Mark, no registrations of Applicant (see *Exhibit 1, paragraph 3*) were cited --- a further indication of the difference between the goods and the trade channels. Insofar as the Examining Attorney has selectively picked isolated businesses featuring both products -- such does not detract from the marketplace reality that this is not commonplace.

### D. THERE IS NO ACTUAL CONFUSION

Applicant's **BULLETPROOF** goods are markedly different than the specialized goods of Registrant's - - see also selected screenshots of Registrant's website at [www.hasport.com](http://www.hasport.com)., attached as **Exhibit 2**. Compare with Applicant's specimens. The fact that there has been no actual confusion given the almost 1.5 year coterminous use of Applicant's mark and Registrant's mark based in the same geographic area (greater Phoenix, AZ area) - - is strong evidence of no likelihood of confusion.

Applicant markets its goods via a U.S. network of reseller/installers and via its online store. As best understood Registrant markets its “Honda engine mounts” via its online store (**Exhibit 2**). These products are never sold side by side or in close proximity to one another. Despite the similarity of the marks themselves, given differences in the manner in which Applicant’s goods and Registrant’s goods are marketed, and the absence of any known actual confusion, there is little likelihood that consumers would be confused that Applicant’s aftermarket diesel engine component goods are associated with Registrant’s specialty goods. The likelihood of Applicant’s International Class 7 specialty goods being confused with that of the Registrant’s International Class 12 specialty goods is remote at best. This has been solidified as between Registrant and Applicant by virtue of their Consent Agreement.

### **E. THE 2(d) REJECTION SHOULD BE WITHDRAWN**

Accordingly, following the C.C.P.A.’s *duPont* cautionary note—that “there is no litmus rule which can provide a guide to all cases,” Applicant respectfully submits that there is no likelihood of confusion between Applicant’s mark and cited mark of Registrant. Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) rejection.

### **2. APPLICANT’S BULLETPROOF MARK IS NOT MERELY DESCRIPTIVE**

Applicant Neal Technologies, Inc. doing business as Bullet Proof Diesel (“BPD”) submits the Declaration of Gene Neal (“Neal Decl”) [**Exhibit 3**] in support of its position that BULLETPROOF as applied to the aftermarket EGR coolers, oil filtration systems, water pumps and fuel injection control modules—ALL specifically for diesel engines—is a distinctive designation. Specifically:

BPD is an Arizona-based manufacturer and a nationally renowned seller of aftermarket diesel engine parts and related services, including upgraded oil coolers and EGR kits for Ford Power Stroke® diesel engines, known as “BulletProof” Oil Coolers and “BulletProof” EGR Coolers. In about 2009, BPD’s founders invented an ingenious solution to the failing 6.0L Ford Power Stroke Diesel Engine. This solution, ultimately the subject of numerous U.S. Patents, included an improved EGR Cooler and an improved Oil Cooler System. BPD branded this specialized diesel engine aftermarket with its BulletProof Marks. This BPD fix for the Ford Power Stroke Diesel has become the “cure for the 6.0L cancer.” Since at least as early as 2009, BPD has marketed such goods and services under the

inherently distinctive common law BULLETPROOF, BULLET PROOF, BULLETPROOFDIESEL, and BULLET PROOF DIESEL trademarks. BPD has been using these word marks for at least nine years, resulting in BPD's common law priority ownership of these word marks. See **Exhibit A** depicting selected pages from BPD's [www.bulletproofdiesel.com](http://www.bulletproofdiesel.com) website as it appeared on November 29, 2017 (prior to the filing of this application). (Neal Decl ¶ 5)

In addition, since at least as early as June 1, 2009, BPD has continuously used in commerce its family of "BULLET PROOF" U.S. registered trademarks, including [BulletProofDiesel.com](http://BulletProofDiesel.com) (U.S. Registration No. 4,235,578), [BulletProofDiesel.com](http://BulletProofDiesel.com) and Design mark (U.S. Registration 4,262,825), "BULLET PROOF" (U.S. Registration 5,130,772 and 5,220,129), "BULLET PROOF DIESEL" (U.S. Registration 5,220,128) and "BULLETPROOFDIESEL" (U.S. Registration No. 5,220,127). A copy of these Registrations are attached hereto as **Exhibit B**. These registrations are valid and subsisting. (Neal Decl ¶ 6)

Similarly, and again since at least as early as June 1, 2009, BPD has continuously used in commerce its U.S. Registered LOGOS, including that of its U.S. Registration Numbers 5,181,668; 5,181,669 and 5,203,935, as shown below:



Copies of these Registrations are attached hereto as **Exhibit C**. These registrations are valid and subsisting. (Neal Decl ¶ 7)

Collectively, the marks alleged above in Paragraphs 5, 6, and 7 are referred to herein as the "BulletProof Marks." BPD is the owner of all right, title and interest in and to the BulletProof Marks. (Neal Decl ¶ 8)

BPD has invested hundreds of thousands of dollars in advertising, marketing, and promoting its goods and services under the BulletProof Marks. BPD's expenditures for such advertising, marketing and promotion beginning in 2009 of \$75,000 has grown to almost \$600,000 by the end of 2018. Also, BPD's gross sales have grown from \$700,000 in 2009 to in excess of \$12,500,000 by the end of 2018. (Neal Decl ¶ 9)

These marketing and promotional efforts include operating BPD's above-referenced website, [www.bulletproofdiesel.com](http://www.bulletproofdiesel.com), developed and owned by BPD, prominently participating in multiple active social media sites (ie Facebook) and specialized industry forums, and continuous and extensive nationwide advertisements in most of the leading truck magazines (such as *Diesel Power*, *Off Road*, *Diesel World*, *Four Wheeler*, *8-Lug*, and *Truckin*). Samples of early advertisements that were published nationally are shown in **Exhibit D**. Screenshots of BPD's website as it appeared in 2016 are shown in **Exhibit E**, and as it existed in March 2019 in **Exhibit F**. (Neal Decl ¶ 10)

To further advertise, market, and promote its BulletProof Marks and enhance its reputation, BPD has spent considerable sums to sponsor racing teams competing in both the Score International Racing Series, which has events in Mexico and California, and the Lucas Oil Off-Road Racing Series, which has events in California, Arizona, Utah, and Nevada. Events from both racing series are broadcast nationally on the CBS Sports Network. Further, BPD has sponsored multiple charity events throughout the United States. (Neal Decl ¶ 11)

BPD has also been the subject of numerous national magazine articles, including those appearing in *Four Wheeler* (9/2010, **Exhibit G**), *Diesel Power* (10/2010, **Exhibit H**), *Diesel World* (11/2010, **Exhibit I**), and *Off-Road* (12/2012, naming the Neal Brothers, the principals of Applicant, as the 2012 People of the Year, **Exhibit J**), magazines that have prominently featured the BulletProof Marks in association with its diesel engine parts and services. (Neal Decl ¶ 12)

Further BPD maintains its own channel on the YouTube website, under the name of BulletProofDiesel. A screenshot of the "About" page of this channel as it appeared on 3/11/2016 is attached as **Exhibit K**. It shows that this channel at that time had 3025 subscribers and 1,695,987 views. Since that time, the current subscribers have grown to more than 11,000. (Neal Decl ¶ 13)

In addition, BPD has built a successful network of over 250 preferred BULLET PROOF DIESEL parts installers across the United States and Canada, further enhancing brand recognition and consumer loyalty. (Neal Decl ¶ 14)

BPD's products and services do not make vehicles "bullet proof" in the original, literal sense of "impervious to bullets." Indeed, some businesses provide "bulletproofing" services and parts that can literally make the exterior of a vehicle impervious to bullets, by armor plating the doors and installing specialized window glass. But this "bulletproofing" protection is

not used with respect to the engine components, which are within the interior of the vehicle and shielded by the exterior of the vehicle. Rather, BPD's use is in the context of durability and increased reliability making the term "BULLETPROOF" at least suggestive, if not arbitrary, of BPD's products and services. (Neal Decl ¶¶ 15)

Out of an abundance of caution, BPD selected a conservative date of first use (7.16.2018) of the BULLETPROOF mark being used technically correctly, as a trademark for goods. Uses akin to trademark use (i.e. advertising-service mark uses) have their roots in BPD's very first advertising that occurred in 2009-2010, as detailed above. (Neal Decl ¶¶ 16)

As noted above, Applicant is the longtime holder of a family of BULLETPROOF marks for its aftermarket diesel engine components and related services (Neal Decl ¶¶ 5-8), which the Examining Attorney failed to recognize. All of Applicant's identified U.S. Registrations are on the Principal Register.

None of Applicant's products are "impervious to bullets" - - as is bulletproof glass or bulletproof armor plating (Neal Decl ¶¶15). Indeed, a search of the USPTO records for "Bulletproof" as shown in **Exhibit 4** reflects a number of Principal Register (i.e. distinctive) registrations for BULLETPROOF for a wide variety of goods and services, in areas as diverse as real estate services, health services, roofing services, screen protectors, food products, sunscreen, mops, financial services, educational services, lubricants, just to name a few. Many of these goods and services also appear in a search of the USPTO records for "Bullet Proof" as shown in **Exhibit 5**. None of these BULLETPROOF products are "impervious to bullets." All of these marks are distinctive.

For all the aforementioned reasons, Applicant respectfully submits that Applicant's BULLETPROOF mark as applied to its aftermarket diesel engine components is not descriptive, but rather is distinctive.

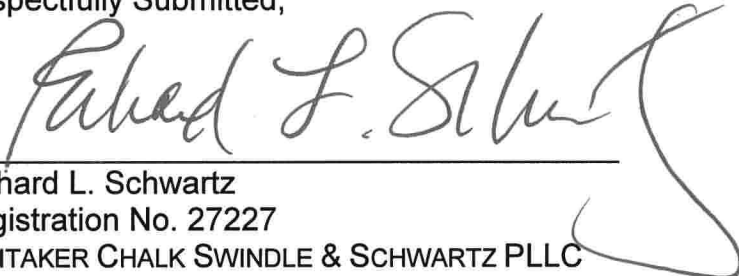
### **3. IDENTIFICATION OF GOODS**

As noted above, Applicant has deleted the references to "thermostats" in its Description of Goods. All remaining goods are properly in International Class 7.

### **CONCLUSION**

Applicant respectfully submits that all rejections of the Trademark Examining Attorney have been traversed. Applicant respectfully requests that this mark be promptly passed to publication.

Respectfully Submitted,

  
By: \_\_\_\_\_

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#### **Attachments:**

- 1. Consent Agreement**
- 2. Selected Screenshots of [www.hasport.com](http://www.hasport.com)**
- 3. Declaration of Gene Neal and referenced Exhibit A-~~KK~~**
- 4. USPTO search for BULLETPROOF**
- 5. USPTO search for BULLET PROOF**