

This Opinion is Not a
Precedent of the TTAB

Mailed: April 22, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Randakk's Cycle Shakk, LLC

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Serial No. 86128904

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Luke Brean of Breanlaw LLC,
for Randakk's Cycle Shakk, LLC.

Christopher Reams, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Bucher, Lykos, and Kuczma,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Randakk's Cycle Shakk, LLC ("Applicant") seeks registration on the Principal Register of the mark **RANDAKK'S CYCLE SHAKK** in standard character format for, as amended, "on-line retail store services featuring motorcycle parts and accessories, excluding electric motors for land vehicles" in International Class 35.¹ Applicant has disclaimed the word "Cycle" apart from the mark as shown.

¹ Application Serial No. 86128904, filed November 25, 2013, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging March 1, 2001 as the date of first use anywhere and in commerce.

Registration was refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the mark **RANDAX** (standard character format) on the Principal Register for "electric motors for land vehicles" in International Class 12² that, when used on or in connection with Applicant's identified services, it is likely to cause confusion or mistake or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration by amending the identification of services to exclude the sale of "electric motors for land vehicles." The Trademark Examining Attorney accepted and entered Applicant's amendment but denied the Request for Reconsideration, maintaining the final refusal. Thereafter, the appeal was resumed.

For the reasons explained below, we reverse the refusal to register.

Likelihood of Confusion Analysis

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir.

² Registration No. 4061972, registered on November 29, 2011 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a). The registration also includes goods identified in International Class 7; however, the refusal is not based upon goods in this class.

2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These two factors are discussed below.

Similarity of the Marks

The first *du Pont* likelihood of confusion factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “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) (citation omitted). Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their

entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 224 USPQ at 751.

Applicant’s and Registrant’s marks are comprised, either in whole or in part, of the phonetically equivalent terms **RANDAKK’S** and **RANDAX**. It is well established that there is no correct pronunciation of a trademark, and that marks which may be pronounced in a similar or identical manner may be confusingly similar. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (upholding the Board’s affirmance of a Section 2(d) refusal to register XCEED for agricultural seed based on a likelihood of confusion with the registered mark X-SEED and design, the word “Seed” disclaimed, for identical goods); *Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that “there is no correct pronunciation of a trademark” and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar); *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985) (holding SEYCOS and design for watches, and SEIKO for watches and clocks, likely to cause confusion). In comparing both marks, **RANDAX** is the sole element of Registrant’s mark. Because the term **RANDAKK’S** appears first in Applicant’s mark and, according to the record before us, is arbitrary when considered in relation to the identified services, it constitutes the dominant portion of Applicant’s mark. *See Palm Bay*, 73 USPQ2d at 1692 (internal citation omitted) (“the Board correctly weighed the relative importance of VEUVE and CLICQUOT. VEUVE is an arbitrary term as applied to champagne and sparkling wine, and thus

conceptually strong as a trademark.”). Furthermore, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See id.* *See also Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). The word “Cycle” is disclaimed and the term “Shakk” is suggestive of the services. Disclaimed matter generally will not constitute the dominant part of a mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). Given that Applicant’s mark commences with the arbitrary term **RANDAKK’S**, it is more likely that prospective consumers will pay less attention to the remainder of the mark and instead treat the first term as the dominant source identifying element.

Applicant contends that the shared phonetic similarity is an insufficient basis for finding a likelihood of confusion. The Board, however, has the discretion to place more weight on a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data*, 224 USPQ at 751. *See, e.g., In re Dixie Rests., Inc.*, 41 USPQ2d at 1533-34. As explained above, the dominant portion of Applicant’s mark may be pronounced in an identical manner as Registrant’s entire mark. The additional wording in Applicant’s mark

does little, if anything, to alter the connotation and commercial impression vis-à-vis the registered mark.

Hence, in comparing Applicant's mark as a whole to the registered mark, we find that Applicant's mark is similar in sound, connotation and commercial impression to the cited registered mark. This first *du Pont* factor weighs in favor of finding a likelihood of confusion.

Relatedness of the Goods and Services

We turn now to the second *du Pont* factor, a comparison of Applicant's and Registrant's respective goods and services as they are identified in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also, Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). In this case, we compare Applicant's services identified as "on-line retail store services featuring motorcycle parts and accessories, excluding electric motors for land vehicles" with Registrant's goods identified as "electric motors for land vehicles."

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods). Evidence of relatedness may include news articles and/or evidence from computer


databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods/services and the goods/services listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).


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 offering the sale of those goods, on the other. *See, e.g., In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and CREST CAREER IMAGES (stylized) for uniforms likely to cause confusion). Applicant argues that the involved goods and services are non-competitive insofar as Applicant does not offer for sale electric motors of any type. Indeed, this is reflected in Applicant's recitation of services which specifically excludes the sale of Registrant's type of goods. We further observe that Registrant's "motors for land vehicles" is modified by the term "electric" meaning that the Examining Attorney must show that Applicant's services are not just related to any type of "motors for land vehicles" but specifically to those electric in nature. In other words, the

Examining Attorney has the burden of demonstrating that Registrant's products are commonly sold in online retail stores offering "motorcycle parts and accessories."


To this end, the Examining Attorney highlights in his brief the following use-based third-party registrations:³

Registration No. 4244746 the mark **JAMMER CYCLE PRODUCTS** (standard character format) for services including "wholesale distributorships in the field of motorcycle parts and accessories" in International Class 35 and goods including "internal combustion engines for motorcycles" in International Class 12;

Registration No. 4106343 for the mark  for services including "wholesale and retail store services of a variety of goods, namely, vehicles, motorcycles... and parts and fittings of the aforesaid goods" in International Class 35;

Registration No. 3005777 for the mark  for "Retail store services featuring automobiles, automobile parts and accessories; on-line retail services featuring automobile parts and accessories" in International Class 35 and goods including "motorized land vehicle engines and transmissions" in International Class 12;

Registration No. 4112155 for the mark **PILOT ENGINES** (standard character format), for "Remanufactured engines for non-passenger, industrial land vehicles, namely, commercial trucks" in International Class 12 and "On-line retail store services featuring remanufactured engines for non-passenger, industrial land vehicles, namely, commercial trucks and engine components therefor" in International Class 35;

Registration No. 4234258 for the mark  for goods including "performance automobile and performance pick-ups parts, namely, body panels, spoilers, roof panels, hoods, fenders, seat covers, steering units for land vehicles and parts thereof, performance brakes for motor cars, performance suspension systems for automobiles and trucks, performance

³ We have not considered Registration No. 3885542 because it was registered under Section 66(a). We also have not considered Registration No. 3411758 which was cancelled on November 21, 2014, pursuant to Section 8. Examining attorneys are advised to check the status of registrations highlighted in appeal briefs prior to filing the brief.

clutch mechanisms for automobiles and trucks, performance differentials, performance engines, performance wheels, rear aerodynamic diffusers, body panels, namely, side splitters, and fuel caps” in International Class 12, and services including “online retail stores for performance automobile parts and performance pick-up truck parts” in International Class 35; and

Registration No. 4261592 for the mark **SHELBY PERFORMANCE PARTS** (standard character format) for goods including “automobile engines” in International Class 12 and services including “On-line retail store services featuring Shelby merchandise and collectibles, namely... components for automobile engine systems” in International Class 35.

See March 12, 2014 Office Action. The Examining Attorney maintains that these third-party registrations are probative to the extent that they serve to suggest that Applicant’s services and Registrant’s goods are of a kind that may emanate from a single source. See *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). We disagree, finding that these third-party registrations are of little, if any, probative value. The first registration cited by the Examining Attorney, Registration No. 4244746, is for an internal combustion, not electric, motorcycle engine. The next registration, Registration No. 4106343, does not include any relevant goods. Lastly, Registration Nos. 3005777, 4112155, 4234258, and 4261592 are for retail services featuring automobile, commercial truck and performance pick-up truck parts and accessories, as opposed to motorcycle parts and accessories.

The Examining Attorney also cites evidence from Applicant’s own website which shows that Applicant sells engine parts such as oil filter conversion kits. This again fails to pertain to the goods as identified in the cited mark.

The Examining Attorney then points to evidence regarding third-party use in the marketplace obtained from the Internet purporting to show that “on-line retail store services featuring motorcycle parts and accessories” and “electric motors for land vehicles” are commonly offered under the same mark. He cites websites from motorcycle manufacturers and retailers which include Harley-Davidson, Honda, and Cycle Trader. *See* March 12, 2014 Office Action. Upon close review, none of these websites appear to reference the sale of electric motors.

The Examining Attorney also made of record articles regarding the recent advent of electric motorcycles – a promising field still in its infancy in this country. Electricmotorsport.com’s online ad shows only a few discounted “kit vehicles” sold “as is” with scuffs and scratches, equipped with six to eight horsepower engines. D & D Motor Systems, Inc. offers motorcycle conversion kits having detailed, challenging instructions for the savvy DIY motorcycle builder. Brammo bikes show promise but do not yet appear to be for sale in the United States. *See* July 1, 2014 Denial of Request for Reconsideration. We find that this *de minimis* evidence of electric vehicle motor technology being available to the motorcycle buying public is insufficient to show that the involved goods and services are related. We can only glean from the aforementioned evidence that it is not yet common in 2015 for the same entity to offer both Applicant’s services and Registrant’s type of goods under the same mark. Therefore, on the record before us, we cannot find that consumers may expect Applicant’s retail services to offer the types of goods identified in the

cited registration. This second *du Pont* factor therefore does not favor a likelihood of confusion.

To the extent that there are any other *du Pont* factors which may be relevant, we treat them as neutral.

In conclusion, notwithstanding the strength of the cited **RANDAX** mark and our determination that the first *du Pont* factor weighs in favor of finding a likelihood of confusion, we find that the Examining Attorney has failed to establish on this record that Applicant's services and Registrant's goods are related. As such, we find that there is no likelihood of confusion between Applicant's applied-for and Registrant's registered mark.

Decision: The Section 2(d) refusal to register Applicant's mark is reversed.

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Mailed: July 28, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vision Wheel, Inc.

Serial Nos. 77498758 and 77498755¹

Frank M. Caprio, Jess R. Nix and Ling Guan of Bradley Arant
Boult Cummings LLP for Vision Wheel, Inc.

Judith M. Helfman, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Bucher, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Vision Wheel, Inc. seeks registration on the Principal
Register of the marks V-TEC in standard characters² and

¹ Inasmuch as the issues raised by these appeals are similar, the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 77498758, unless otherwise noted; however, we have of course, considered all arguments and evidence filed in each case.

² Application Serial No. 77498758, filed on June 13, 2008, based on an allegation of first use in commerce on January 31, 2004 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

~~V-TEC~~³ for goods identified as "custom wheels for vehicles" in International Class 12.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered mark VTEC in typed form for "vehicles, namely, automobiles, motorcycles, motorized wheelbarrows and motorized land vehicles; engines for automobiles; engines for motorcycles; engines for other motorized land vehicles" in International Class 12,⁴ as to be likely to cause confusion, mistake or deception.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See

³ Application Serial No. 77498755, filed on June 13, 2008, based on an allegation of first use in commerce on January 31, 2004 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

⁴ Registration No. 2784942, issued on November 18, 2003, Section 8 and 15 declaration accepted and acknowledged.

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Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in terms of their appearance, sound, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In terms of sound, applicant's marks and registrant's mark are identical. Further, the marks consist of the same lettering in the same order V T E C, and, as such, are similar in appearance. The differences in appearance occasioned by the hyphen and, in the case of the mark in Serial No. 77498755, the stylization, are not sufficient to outweigh the similarities. The hyphen does not affect the pronunciation or overall commercial impression of applicant's marks, and is therefore not a basis on which to distinguish the marks. See Goodyear Tire & Rubber Co. v. Dayco Corp., 201 USPQ 485, 488 n.4 (TTAB 1978) (FAST-FINDER with hyphen is in legal contemplation substantially identical to FASTFINDER without hyphen). See also Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040, 2042 (TTAB 1989) (marks PRO-PRINT and PROPRINT identical but for hyphen and confusion likely).

Thus, the marks are very similar in sound, appearance and commercial impression.

With regard to connotation, applicant argues that the:

Examining Attorney's own evidence shows the Cited Registration is not an arbitrary term, but rather, is an abbreviation and acronym used by the Registrant to stand for the descriptive wording 'Variable Valve Timing and Lift Electronic Control' -a valvetrain system to improve the volumetric efficiency of a four-stroke internal combustion engine. ... the Registrant's specimen of record shows that VTEC as used by Registrant refers to the valvetrain system used in the engines and stands for "Variable Valve Timing and Lift Electronic Control."

Br. p. 20.

In addition, applicant argues that registrant's specimens of record "intentionally communicated to and educated the purchasing public about the functional advantage and technology embedded in its VTEC engine system as a marketing strategy to attract the purchasing public to certain Honda and Acura vehicles [and] the term VTEC is always used in a secondary manner together with the house marks of Honda..." Br. p. 21. Applicant relies on *In re Hershey*, 6 USPQ2d 170, 1472 (TTAB 1988) for its position that it is appropriate to look to the specimens of use to determine connotation or meaning of a mark. We first note, that *Hershey* involved a Section 2(a) refusal that the applied-for term was offensive. The Board needed to

determine how the term would be perceived by consumers in view of the fact that the term had more than one meaning. Here, VTEC by itself has no meaning, and while we acknowledge the record shows that registrant associates VTEC with the meaning "variable valve timing and lift electronic control," we must consider the marks as they appear on the drawing pages, and, based on the drawing pages the marks do not have a particular connotation distinct from each other.

Applicant also argues that registrant's mark is weak because it stands for descriptive wording. Assertions that the mark in a cited registration is descriptive constitute an impermissible collateral attack. Moreover, acronyms or initialisms are deemed to be merely descriptive of goods or services only if the wording it stands for is merely descriptive of the goods or services and the acronym or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents or stands for. See, e.g., *Modern Optics, Inc. v. The Univis Lens Co.*, 43 CCPA 970, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956) ("[A]s a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous

therewith"). While there is evidence in the record that VTEC is an abbreviation for a "variable valve timing and lift electronic," we do not find this sufficient to deem this term so weak that the mere addition of a hyphen or minor stylization distinguishes the marks enough to obviate likely confusion. Thus, due to the points of similarities in sound, appearance and commercial impression, we find they outweigh any possible dissimilarity in connotation that may be perceived.

We turn then to consider the respective goods. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. *Safety-Kleen Corp. v. Dresser Indus. Inc.*, 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975). It is sufficient to find goods to be related where the circumstances surrounding their marketing are such that they would be encountered by the same potential purchasers under circumstances that would give rise to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). Finally, we must make our determination based on the goods as they are identified in the application and registration and not based on evidence of their actual use. *Hewlett-Packard Co. v. Packard Press*

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Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

The examining attorney argues that:

In the field of land vehicles and related automotive accessories and parts, the Board has consistently upheld relatedness analysis determinations and has found that purchasers who would encounter same or similar marks for such products would likely be confused as to the source. . . . Board decisions also reflect the marketplace reality that manufacturers of vehicles often produce parts and accessories for vehicles marketed under the same mark, as the original equipment manufacturer ("OEM"), and thus, marketing by different parties of various automotive parts under the same or similar marks would be likely to cause confusion as to the source.

Br. p. 6.

In support of her position that the goods are related and travel in the same channels of trade, the examining attorney submitted excerpts from various websites. She highlights websites that show that Honda (the registrant) manufactures wheels for its vehicles and argues that:

[A]n Internet search will enable a potential purchaser to locate a replacement wheel, customized to fit a specific model also manufactured by applicant. . . . Specifically, the evidence demonstrates that any potential purchasers browsing the Internet can locate the webpages of both car dealerships and retailers of replacement parts for land vehicles, and these websites clearly show detailed photos of the respective goods offered for purchase. The evidence shows that, for example, the identical

Honda trademark on the wheels of a new car ... and on replacement wheels. ... Similarly, consumers who would encounter the V-TEC mark on wheels would likely be confused as to the source, given that these consumers would also encounter the VTEC mark on automobiles, especially factoring that car manufacturers produce and market many parts of new automobiles, including wheels, under the same or similar marks. Based on the application and registration, it is presumed that the respective goods identified by Applicant and Registrant would be commercially distributed and marketed without limitation, and would be available to purchasers at the retail stores, distributorships, ordering services, online retail stores, and specialty stores and outlets.

Br. pp. 7-8.

In response, applicant argues that the examining attorney primarily relies on several prior Board decisions and has not provided sufficient evidence to establish, *prima facie*, a relatedness between the involved goods.⁵

⁵ With its brief in Application Serial No. 77498758, applicant submitted several exhibits consisting of either reprints of the evidence already submitted by the examining attorney or printouts of additional pages from the same website from which the examining attorney submitted pages. These additional pages simply serve to provide the context of the examining attorney's information and we overrule the examining attorney's objection. Cf. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 829 (Fed. Cir. 1986) ("Let it be clear that by citing only a portion of an article, that portion is not thereby insulated from the context from whence it came"). This is distinguished from the circumstances presented in *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1598 fn. 3 (TTAB 1999) wherein the applicant was attempting to introduce full-text excerpts of additional articles that were not part of the record on appeal. We note that had we not considered this evidence, it would not change the result as applicant showed through its brief in Application Serial No. 77498755 the web pages already made of record by the examining attorney are sufficient to support applicant's assertions.

Quoting Federated Foods, 192 USPQ at 26, applicant asserts that "the fact that disparate goods in the same general field may be sold by a retailer will not necessarily support a finding that confusion is likely." Br. p. 5. Applicant contends that "the fact that certain general retailers in automobile parts and accessory industry have websites listing 'engine' and 'wheels' as products for sell [sic] under different categories" is not sufficient proof that applicant's custom wheels under the mark V-TEC would cause source confusion with registrant's VTEC mark on engines or vehicles. Applicant asserts that in the actual relevant market a consumer cannot "as a practical matter, purchase wheels or any parts of a vehicle without first identifying the proper year, maker and model of the specific vehicle on which the wheels or parts will be used." Br. p. 6.

Applicant and the examining attorney seem to agree that the record herein supports the conclusion that automobile makers are original equipment manufacturers [OEM] of wheels, engines, engine components, and completely assembled new automobiles. However, as applicant noted, there is no *per se* rule regarding this relationship, as each case presents its own specific set of facts and commercial realities, some of which may change over the

decades. Hence, the physical relationship and use of a house mark on an array of automobile components alone is not sufficient for the examining attorney to establish a *prima facie* case that wheels are related to automobiles, auto engines or their parts.

Applicant argues that the automobile owner wanting to purchase aftermarket, custom wheels will be sophisticated enough to know the source of such wheels, or would not be able to purchase such custom wheels without the assistance of expert, trained store personnel, or without computerized matrices, to ensure proper fitment based upon the make, model, and year of the involved vehicle.

We are not convinced by the limited evidence of record that automobiles and/or vehicle engines from the OEM are sufficiently commercially related to custom, aftermarket wheels such that confusion is likely. While the evidence shows that car manufacturers use their house marks on various parts of their automobiles and their factory replacement parts, it does not show that they use various product or secondary marks in such a ubiquitous fashion and there is no evidence to establish that VTEC is a house mark. The fact that one website may offer refurbished OEM wheels along with custom wheels does not establish that custom wheels and factory replacement wheels regularly

travel in the same channels of trade.⁶ More importantly, this does not establish that automobiles and engines travel in the same channel of trade as custom wheels, and, in fact, the evidence shows that automobiles are sold through authorized dealer networks.

Thus, this record does not support a finding that automobiles and engines are related to custom wheels or marketed in such a way as to be likely to cause confusion. Further, we find that the conditions of sale minimize any potential confusion. As the record shows each purchase of a wheel necessarily involves a careful process wherein a consumer must identify the year, manufacturer and model of a specific vehicle. In addition, automobiles and engines are very expensive items and custom wheels cannot be characterized as inexpensive general consumer items. In view thereof, we conclude that, despite the similarity of

⁶ The one example in the record is the excerpt from the website LW&T Lakeshore Wheel & Tire. It contains the following statement:

Welcome to Lakeshore Wheel & Tire! We are your online resource for quality refinished OEM (factory original) aluminum alloy and chrome wheels (i.e. rims). We offer many services including alloy wheel replacement and repair, chrome upgrading, match painting, and a wonderful alloy rim exchange program. Now offering top of the line Custom Wheels, including Rozzi, HPD, Mazzi, ION Alloys, and More! We are committed to excellence and customer service.

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the marks, the examining attorney has not established a *prima facie* case of likelihood of confusion.

Decision: The refusals to register under Section 2(d) of the Trademark Act are reversed.

Hearing:
June 3, 2009

Mailed:
September 14, 2009
Bucher

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hyundai Motor America

Serial No. 78889340

Howard N. Aronson, Nancy Dwyer Chapman, Cathy E. Shore-Sirotin and Renee L. Duff of Lackenbach Siegel LLP for Hyundai Motor America.

David H. Stine, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Bucher, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Hyundai Motor America seeks registration on the Principal Register of the mark **ECHELON** (*in standard character format*) for "automobiles" in International Class 12.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to

¹ Application Serial No. 78889340 was filed on May 22, 2006 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The application initially identified the goods as "automobiles and structural parts therefor."

register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark **ECHELON** (*in standard character format*) for "automotive tires"² in International Class 12, as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the issues involved in this case and an oral hearing was held on June 3, 2009. We reverse the refusal to register.

In support of its position, applicant cites the admonition from *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973) [*emphasis in original*]:

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.

Applicant stresses that the Board should recognize and acknowledge present realities "from those on the firing line." Given that twenty-five pairs of substantially

² Registration No. 1745163 issued to Treadways Corporation on January 5, 1993, renewed.

identical marks for automobiles and for automotive tires currently exist on the federal Trademark Register, applicant implores us to respect the boundaries of use in these industries:

... In this sense, the registrations tend to define fields of use and, conversely, the boundaries of use and protection surrounding the marks and marks comprising the same word ... for their various products. The mutual respect and restraint exhibited toward each other by the owners of the plethora of marks, evidenced by their coexistence on the Register, are akin to the opinion manifested by knowledgeable businessmen

Keebler Company v. Associated Biscuits Limited, 207 USPQ 1034, 1038 (TTAB 1980).

The Trademark Examining Attorney assigned to this case made, and then maintained, his Final refusal with substantial reliance on the holding of *In re Jeep Corporation*, 222 USPQ 333 (TTAB 1984). However, he also subsequently made of record websites offering evidence supporting the position of applicant. The Trademark Examining Attorney argues that although the refusal is supported, if not mandated, by case law such as *In re Jeep Corp.*, all the evidence of record supports the position taken by applicant.³ Notably, at the oral hearing, the

³ While TMEP § 710.01 (5th ed. 2007) provides that "the examining attorney may also present evidence that may appear contrary to the USPTO's position, with an appropriate explanation as to why this evidence was not considered controlling," this case is unusual because the Trademark Examining Attorney

Trademark Examining Attorney and applicant both argued that this mark should be registered inasmuch as the evidence supports our reversing this refusal to register.

Our likelihood of confusion determination must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Each of these factors may, from case to case, play a dominant role. *Id* at 567.

We should point out initially that we agree with the concurring opinion that to the extent *In re Jeep Corp.* has been interpreted as presenting a *per se* rule - e.g., that automobiles and automotive tires are *per se* related, such that there must be a likelihood of confusion from the use of the same or similar marks in relation to this pairing of goods - this is an incorrect reading of the *In re Jeep Corp.* case and its progeny. Rather, we need to look at the factual evidence of record to determine whether these goods are related as closely under trademark law as tires are when securely mounted on auto wheels.

presented evidence contrary to the USPTO's position and argued that such evidence is, in fact, controlling.

Inasmuch as the marks herein are identical, this factor supports a finding of likelihood of confusion. Nonetheless, that is clearly not the end of our determination in a case such as this. Specifically, we should not overlook the critical role played by well known/famous marks for automobiles in reported decisions⁴ -- such as PACKARD,⁵ CADILLAC,⁶ COBRA,⁷ MERCEDES-BENZ and FORD,⁸ where likelihood

⁴ In *General Motors Corporation v. Pacific Tire & Rubber Company*, 132 USPQ 562, 564 (TTAB 1962) [Opposer's BEL-AIR automotive vehicles versus applicant's BEL-AIR tires and tubes], the Board cited, *inter alia*, to two pre-Lanham Act cases from the 1920's. *Akron-Overland Tire Co. v. Willys-Overland Co.*, 273 F. 674, 676 (3rd Cir. 1921); and *Wall v. Rolls Royce of America*, 4 F.2d 333 (3rd Cir. 1925). Yet, in a 1978 decision citing to these same two auto/auto parts decisions, the Third Circuit discussed these as examples where it had earlier found that a well-known mark provided protection against goods in "non-competing" markets. See *Scott Paper Company v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 200 USPQ 421, 424 (3rd Cir. 1978).

⁵ *Nash-Kelvinator Corporation v. Imperial Tire Company*, 45 USPQ 587, 588-89 (Com'r. 1940).

⁶ *General Motors Corporation v. Aluminum Products, Inc.*, 120 USPQ 502 (TTAB 1959) [GM's long and extensive use and promotion of its CADILLAC mark means it is "exceedingly well-known" in the automotive trade. Moreover, applicant has chosen to display its CADILLAC mark using "an exact simulation of a style of lettering long used by opposer" in displaying its CADILLAC mark!].

⁷ *Ford Motor Company v. Hi-Performance Motors, Inc.*, 186 USPQ 64 (TTAB 1975) [Applicant's use of visual representation of a coiled snake for automobile wheels, and opposer's use of the word COBRA and coiled snake design for automobiles and automobile components was likely to cause confusion]. As to the fame of the COBRA mark, a reported decision almost forty years later noted the continuing fame of Ford's COBRA mark. *Ford Motor Co. v. A.C. Car Group Ltd.*, 62 USPQ2d 1701 (E.D.Mi. 2002).

⁸ *Jetzon Tire & Rubber Corporation v. General Motors Corporation*, 177 USPQ 467 (TTAB 1973) [In a case where "GM" was

of confusion was found. Granted, the renown of a registered mark is often difficult to determine in the *ex parte* context. And while the record in this case does not contain any information on this factor, it is significant to our understanding of the continuing reach of cases such as *In re Jeep Corp.* That is, a registration for a mark of some renown registered in connection with automobiles should remain a good *ex parte* citation against the manufacturer or merchant with the temerity to adopt and use an identical mark for tires. In the event that the Trademark Examining Attorney cannot demonstrate such renown, then certainly the automobile manufacturer *qua* opposer or cancellation petitioner should be permitted to make such a showing in an *inter partes* proceeding. By contrast, where the Trademark Examining Attorney, like trademark tribunals, is faced with less well-known marks like IMPERIAL⁹ or GRAND PRIX,¹⁰ presumably no likelihood of confusion would be found.

part of one of applicant's marks, opposer made of record two third-party registrations to show that the marks MERCEDES-BENZ and FORD have been registered in the United States Patent and Trademark Office by a single party for both automobiles and tires].

⁹ *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910 (TTAB 1988) [Due to weakness of IMPERIAL marks, no likelihood of confusion between registered mark for automobiles and structural parts, and applicant identical mark for automotive products.

¹⁰ *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992) [Applicant was applying for GRAND PRIX for "motor vehicles; namely,

While we could well go back through a century of history, and focus at length on conclusory statements made over the years by various tribunals as to the relationship of automotive tires to automobiles, we are much more interested in the relevant evidence (or lack thereof) on that relationship contained within this record.

Clearly, tires are included on virtually every new automobile sold, and are absolutely necessary for the operation of such vehicles throughout their useful life. These are clearly not "competitive" goods, but neither do we believe they should be considered to be "complementary goods" as that term is used in likelihood of confusion decisions." Some goods will be regarded as related because they are complementary in the sense that they might be used together (e.g., skirts and blouses, pancakes and syrup, camera and film). Generally, the focus is on products that the consumer might well purchase separately but routinely use together. With such products, when faced with identical or highly similar marks, consumers will have the expectation of some connection or sponsorship. "Complementary goods" continues to be a useful category of related goods, whether

automobiles, engines therefor, and structural parts thereof" versus a variety of GRAND PRIX marks for automotive tires; no likelihood of confusion found where during a thirty year interval of contemporaneous usage and "sustained success," there were reportedly no instances of actual confusion].

from the standpoint of current and prospective trademark owners and their counsel, or as a rationale for intellectual property tribunals in determining the relatedness of goods. However, merely because two products are attached or used together does not necessarily mean they are closely related. Consumers do not purchase an automobile without tires, and then later go looking for tires. Nothing in this record points to a single source for automobiles and tires. Accordingly, there is no reason to presume such a perception on the part of consumers of automobiles. We find nothing in the record to support a conclusion that automobiles and their tires are "closely related," as that term is used in the jurisprudence developed around likelihood of confusion.

We now turn to trade channels, another critical factor when dealing with the nexus of the automobile and tire industries. As to the respective channels of trade employed by the automotive industry and the tire industry, the file contains evidence of the virtual separation of these trade channels. For example, according to "Market Profile," a 2007 annual report put out by *Tire Review Online*, a global website that covers the tire industry, it appears that at present, only two to four percent of aftermarket automobile

tires in the United States are sold through automotive dealerships.¹¹

Furthermore, each automobile is an expensive item (e.g., generally, from thousands to tens-of-thousands of dollars), presumably purchased with a great deal of care. See *In re General Motors Corp.*, 23 USPQ2d at 1471 [the purchase of an automobile is "typically a major and expensive purchase"]. One cannot assume quite the same level of purchaser care for tires - even when multiple tires are marketed for hundreds of dollars. However, according to this record, the motorist in need of new tires will go to the local tire dealer located in a traditional brick-and-mortar establishment, or may order tires online to be shipped, and then mounted and balanced locally. To make this point more clearly, the Trademark Examining Attorney submitted evidence from an online tire retailer which explained in detail the online purchasing process facing the hypothetical owner of a 2006 Camry.¹² Hence, unsophisticated

¹¹ We have considered the evidence from "Market Profile," at 16 <http://www.tirereview.com/files/PDF/marketprof07revA.pdf>, although there may well be an element of hearsay to this evidence. Inasmuch as this is a website that covers the tire industry, we detect no bias in the evidence. The Board generally takes a somewhat more permissive stance with respect to the introduction and evaluation of evidence in an *ex parte* proceeding than it does in an *inter partes* proceeding. See *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996); and *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996).

¹² <http://www.tirerack.com/tires/>

tire purchasers would not be able to purchase tires without the assistance of expert, trained store personnel, or without computerized matrices, to ensure proper fitment based upon the make, model, year, rim size, etc., of their vehicles. This hypothetical automobile owner in need of replacement tires (who assumes a separate source for the tires) checks carefully the specifications for the tire but is not concerned about matching the brand of tires to the automobile.

Another hypothetical consumer, one so ill-informed that he mistakenly assumes source connection of tires based merely upon a coincidence that they bear the same mark as his car, would be disabused quickly of this notion. Practically, the Trademark Examining Attorney has shown from his TireRack example that (1) the pull-down matrices prevent the selection of a tire with an incorrect fitment, and (2) the chance that one would find a brand of tires that fits a car of the same name appears to be infinitesimally small. In the local brick-and-mortar location, a capable sales person would not agree to sell and mount tires that do not fit the auto's wheels. Hence, despite themselves, such consumers are forced to exercise a high degree of care when purchasing tires.

Similarly, applicant has demonstrated from examples of real-world, online sources that some of the largest auto manufacturers and the most well-known tire manufacturers readily permit the same mark to coexist for automobiles and automobile tires.

CHARGER tire/auto pairing as seen in the marketplace:

Applicant demonstrates that the Charger performance radial tire by Kelly/Springfield is available online in 14", 15" and 16" tires.

<http://www.kellytires.com/auto/products/csr.html>



Charger® By Kelly Performance Radial



By contrast, the 2008 Dodge Charger is a muscle car available with 17", 18" and 20" wheels.

<http://www.dodge.com/en/2008/charger/>

EXPLORER tire/auto pairing as seen in the marketplace:

Applicant demonstrates that the Explorer radial tire by Kelly/Springfield is available online in 13", 14" and 15" tires.

<http://www.kellytires.com/auto/products/exp.html>



Explorer® All-Season Steel-Belted Radial





By contrast, the 2008 Ford Explorer is a sports utility vehicle available with 18" and 20" wheels. <http://www.fordvehicles.com/suvs/explorer/>

NAVIGATOR tire/auto pairing as seen in the marketplace:



A Good Deal On A Great Tire™

[SITE MAP](#) | [CONTACT US](#) | [SEARCH](#)

[AUTO & LIGHT TRUCK](#) | [COMMERCIAL TRUCK](#)

[Tire Catalog](#) | [Tire School](#) | [Tire Registration](#) | [30 Day Test Drive](#) | [Find A Retailer](#) | [The Kelly Tire Card](#)



A GOOD DEAL ON A GREAT TIRE™

Auto & Light Truck
[Search Results Detail](#)



Navigator Touring Gold

Premium Ride Comfort And Dependable All-Season Performance

Applicant demonstrates that the Navigator tire by Kelly/Springfield is available in 15", 16" and 17" tires.¹³ By contrast, the 2008 Lincoln Navigator is the largest luxury SUV made by Ford Motor Company, with 18" and 20" tires.



PILOT tire/auto pairing as seen in the marketplace:

Finally, **PILOT** includes Michelin's line of ultra-high performance tires (ranging from 17" to 22") for exotic sports cars, "Y" rated for speeds up to 186 miles per hour. By contrast, although Honda's **PILOT** registration lists "all

¹³ http://www.kellytires.com/kellytires/display_tire.jsp?prodline=Navigator+Touring+Gold&mrktarea=Passenger

terrain vehicles," applicant has submitted for the record online ads showing that the 2008 Honda **PILOT** is a somewhat-bulky, midsized, crossover SUV.

We emphasize that even twenty-five pairs of substantially identical marks for automobiles and for automotive tires currently existing on the federal Trademark Register does not have persuasive value of a written, mutual consent between an applicant and senior user/registrant. There is simply no way of knowing whether the owners of a particular pair of registrations actually had any dealings whatsoever. As such, our decision herein is not meant to imply that third-party registrations should be given such evidentiary weight. On the other hand, the fact that there are numerous third-party registrations for similar marks owned by different entities for tires and automobiles is consistent with the conclusion that trademark owners in these respective industries do not believe that there is a likelihood of confusion between these marks for the listed goods.

The U. S. Patent and Trademark Office itself seems to be of two minds on how best to handle applications such as the present one. While some Trademark Examining Attorneys take the position that the holding of cases like *In re Jeep Corp.* mandates this refusal, others have over the years repeatedly registered identical, arbitrary marks for

automobiles and for auto tires. The junior users/registrants in many of the following pairs were issued federal trademark registrations in the years since *In re Jeep Corp.* was decided. This provides additional evidence corroborating contemporary marketplace realities, namely, that the automobile and tire industries permit co-terminus use and open coexistence on the federal Trademark Register of substantially identical marks for vehicles and tires without any evidence anyone has been confused thereby. Here are some of the examples placed into the record:

<i>AUTOMOBILES / LAND VEHICLES</i>	<i>TIRES</i>
ASTRA¹⁴	ASTRA¹⁵
AVALANCHE¹⁶	AVALANCHE¹⁷
CHARGER¹⁸	CHARGER¹⁹


¹⁴ Registration No. 3403244 for "motor land vehicles" (Owned by Saturn Corporation) issued on March 25, 2008.

¹⁵ Registration No. 1216617 for "tires" (owned by Continental Tire North America, Inc.) issued on November 16, 1982, renewed.

¹⁶ Registration No. 2866966 for "motor land vehicles, namely automobiles, trucks, sport utility vehicles, vans, engines therefor and structural parts thereof excluding railcars or parts thereof" (owned by General Motors Corporation) issued on July 27, 2004.

¹⁷ Registration No. 2289115 for "tires for motor vehicles" (owned by Hercules Tire Company of Canada, Inc.) issued on October 26, 1999, renewed.

¹⁸ Registration No. 2985653 for "motor vehicles, namely automobiles and structural parts therefore" (owned by Chrysler Group LLC) issued on August 16, 2005.

AUTOMOBILES / LAND VEHICLES	TIRES
<i>Continental</i> ²⁰	Continental ²¹
EXPLORER ²²	EXPLORER ²³
GENESIS ²⁴	GENESIS ²⁵
GRAND PRIX ²⁶	BRAND  PRIX ²⁷

¹⁹ Registration No. 0833697 for "tires" (owned by the Kelly-Springfield Tire Company) issued on August 15, 1967, second renewal.

²⁰ Registration No. 0591601 for "motor cars" issued on June 22, 1954, third renewal; and Registration No. 2908822 for the mark CONTINENTAL for "vehicles, namely cars, trucks, vans and sport utility vehicles" issued on December 7, 2004 (both owned by Ford Motor Company).

²¹ Registration No. 0622300 for "pneumatic tires and solid rubber tires for bicycles, passenger cars, trucks, tractors, lorries, wheel barrows, and motor cars" (owned by Continental Aktiengesellschaft) issued on February 28, 1956, third renewal.

²² Registration No. 1193137 for "pick up trucks and their structural parts" (owned by Ford Motor Company) issued on April 6, 1982, renewed.

²³ Registration No. 0607305 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on June 14, 1955.

²⁴ Registration No. 3531628 for "automobiles" (owned by Hyundai Motor America) issued on November 11, 2008.

²⁵ Registration No. 2934609 for "vehicle tires" (owned by Treadways Corporation) issued on March 22, 2005.

²⁶ Registration No. 1889797 for "motor vehicles; namely, automobiles, engines therefor, and structural parts thereof" (owned by General Motors Corporation) issued on April 18, 1995, renewed. Board found no likelihood of confusion with tires, *In re General Motors Corp.*, 23 USPQ2d 1465, (TTAB 1992).

<i>AUTOMOBILES / LAND VEHICLES</i>	<i>TIRES</i>
HIGHLANDER²⁸	HI-LANDER²⁹
LARAMIE³⁰	LARAMIE³¹
LEGACY³²	LEGACY³³
LEGEND³⁴	LEGEND³⁵
MAXIMA³⁶	MAXIMA³⁷

²⁷ Registration No. 0690249 for "automobile tire[s]" issued on December 22, 1959, second renewal; and Registration No. 1164594 for GRAND PRIX RADIAL G/T (with the term "Radial G/T" disclaimed, shown in a special form drawing, as shown at right for "automotive vehicle tires" issued on August 11, 1981, renewed (owned by TBC Corporation).



²⁸ Registration No. 2249838 for "automobiles and structural parts thereof" issued on June 1, 1999, renewed; and Registration No. 2339104 for "land motor vehicles, namely, sport utility vehicles, and structural parts thereof" issued on April 4, 2000, (both owned by Toyota Jidosha Kabushiki Kaisha).

²⁹ Registration No. 0696074 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on April 12, 1960, second renewal.

³⁰ Registration No. 1973148 for "motor vehicles and structural parts therefore" (owned by Chrysler LLC) issued on May 7, 1996, renewed.

³¹ Registration No. 1088647 for "vehicle tires" (owned by Treadways Corporation) issued on April 4, 1978, second renewal.

³² Registration No. 1721734 for "automobiles and structural parts thereof (excluding tires)" (owned by Fuji Jukogyo Kabushiki Kaisha) issued on October 6, 1992, renewed.

³³ Registration No. 1393967 for "vehicle tires" (owned by Big O Tires, Inc.) issued on May 20, 1986, renewed.

³⁴ Registration No. 1574715 for "automobiles and structural parts thereof" (owned by Honda Giken Kogyo Kabushiki Kaisha) issued on January 2, 1990, renewed.

³⁵ Registration No. 3039122 for "vehicle tires" (owned by Treadways Corporation) issued on January 10, 2006.

³⁶ Registration No. 1432854 for "automobiles and structural parts therefor, excluding tires" (owned by Nissan Jidosha Kabushiki Kaisha) issued on March 17, 1987, renewed.

<i>AUTOMOBILES / LAND VEHICLES</i>	<i>TIRES</i>
NAVIGATOR³⁸	NAVIGATOR³⁹
ODYSSEY⁴⁰	ODYSSEY⁴¹
PATRIOT⁴²	PATRIOT⁴³
PILOT⁴⁴	PILOT⁴⁵

³⁷ Registration No. 0926329 on the Supplemental Register for "non-metallic tires" (owned by Continental Tire North America, Inc.) issued on December 28, 1971, second renewal.

³⁸ Registration No. 1749362 for "vehicles; namely, motor homes" (owned by International Truck Intellectual Property Company, LLC.) issued on January 26, 1993, renewed; also Registration No. 2111095 for "motor vehicles, namely trucks and their structural parts" (owned by Ford Motor Company) issued on November 4, 1997, renewed.

³⁹ Registration No. 0812177 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on August 2, 1966, second renewal.

⁴⁰ Registration No. 2039315 for "passenger land motor vehicles, namely, minivans, and structural parts thereof" (Owned by Honda Giken Kogyo Kabushiki Kaisha) issued on February 18, 1997, renewed.

⁴¹ Registration No. 1687087 for "automotive tires" (owned by Treadways Corporation) issued on May 12, 1992, renewed.

⁴² Registration No. 2841486 for "motor vehicles, namely, automobiles and structural parts and engines therefor, sold exclusively through authorized dealerships to its retail customers and excluding buses" (owned by Chrysler LLC) issued on May 11, 2004.

⁴³ Registration No. 3320224 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on October 23, 2007.

⁴⁴ Registration No. 1596280 for "all terrain vehicles and structural parts thereof" (owned by Honda Giken Kogyo Kabushiki Kaisha) issued on May 15, 1990, renewed.

⁴⁵ Registration No. 1342457 for "tires" (owned by Michelin North America, Inc.) issued on June 18, 1985, renewed.

<i>AUTOMOBILES / LAND VEHICLES</i>	<i>TIRES</i>
<i>Le Sabre</i> ⁴⁶	SABRE ⁴⁷
TRACKER ⁴⁸	TRACKER ⁴⁹
VIPER ⁵⁰	VIPER ⁵¹
WRANGLER ⁵²	WRANGLER ⁵³

Although we often remind litigants that the federal Trademark Register may not actually reflect what is happening in the real world, applicant has shown in detail how many of these respective pairs are currently used in the marketplace using Internet evidence of contemporary usage.

⁴⁶ Registration No. 0573739 for "automobiles and parts thereof" (owned by General Motors Corporation) issued on April 28, 1953, third renewal.

⁴⁷ Registration No. 0926463 for "pneumatic tires" (owned by Treadways Corporation) issued on January 4, 1972, second renewal.

⁴⁸ Registration No. 1520766 (owned by General Motors Corporation) issued on January 17, 1989; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁴⁹ Registration No. 1074959 (owned by The Goodyear Tire & Rubber Company) issued on October 11, 1977; second renewal.

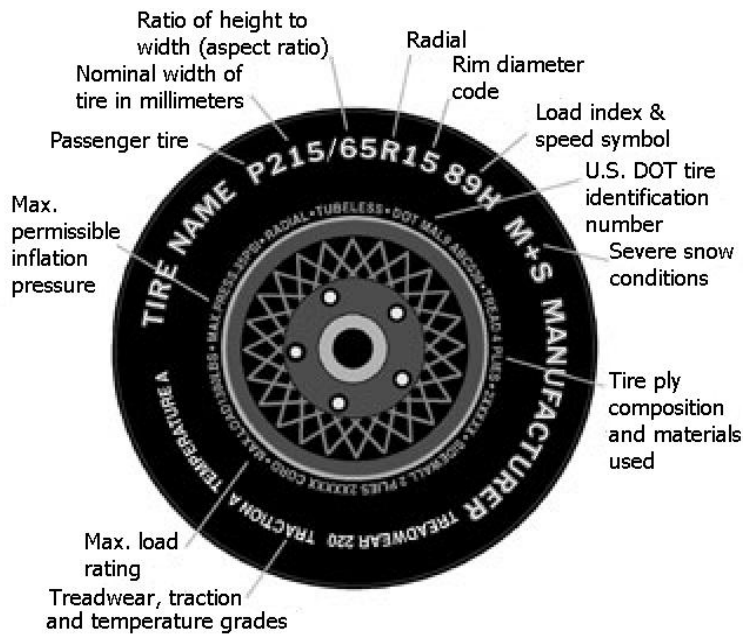
⁵⁰ Registration No. 1800654 for "automobiles and structural parts therefore" (owned by Chrysler LLC) issued on October 26, 1993; renewed.

⁵¹ Registration No. 2153975 for "tires for automobiles" (owned by Cooper Tire & Rubber Company) issued on April 28, 1998; renewed.

⁵² Registration No. 1557843 for "automobiles" (owned by Chrysler Group LLC) issued on September 26, 1989.

⁵³ Registration No. 0811711 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on July 26, 1966, second renewal.

Finally, applicant points to the current tire industry practice for sidewall markings based upon federal regulations. Although the regulations do not explicitly require that the ultimate corporate source of the tires be listed on the sidewall, this reality reduces even further any chance of inadvertent confusion, i.e., with both the manufacturer's name and the product/tire name appearing prominently on the tire sidewall.



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Accordingly, the *du Pont* factor focusing on the conditions under which sales are made favors reversal.

⁵⁴ <http://www.safercar.gov/portal/site/safercar/menuitem.13dd5c887c7e1358fefe0a2f35a67789/?vgnnextoid=8e1c4507fe526110VgnVCM1000002fd17898RCRD>; 49 CFR Part 575, 575.6(a); 46 FR 13193, 02/17/1981; 64 FR 51920, 09/27/1999; Uniform Tire Quality Grading Standards (UTQGS) of the Consumer Information Regulations at 49 CFR 575.104, and the tire labeling sections of the Federal Motor Vehicle Safety Standards (FMVSS) at 49 CFR 571.109, 117, and 119).

We thus find that automobiles and automobile tires are not closely-related goods given the current marketing conditions for the replacement tire industry and the totally disparate channels of trade between tires and automobiles. With the possible exception of automobile marks of demonstrated renown - a fact pattern not shown to be the case herein - the chances for likelihood of confusion in the real world are *de minimis* under these circumstances. After all, as our reviewing court has stated, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

The cumulative evidence in this case, assembled between 2006 and 2008, is substantial and overwhelming, and supports a reversal herein. When it comes to likelihood of confusion, trademark practitioners and jurists know that there are no *per se* rules as to the relatedness of goods. Therefore, contrary to the positions of both applicant and the Trademark Examining Attorney, we cannot discern a rule of law from *In re Jeep Corp.* in need of being overturned. Furthermore, although the briefing and oral arguments urge

us to do so, we do not find it necessary to take a position herein on whether precedential cases decided decades ago were then supported by the realities of the marketplace or their respective factual records.

We do emphasize that this is not simply a case where the Trademark Examining Attorney relied solely upon the results of a previous decision, thereby losing the appeal because of a failure to gather evidence. To the contrary, it is apparent that the Trademark Examining Attorney sought mightily to support the Office's refusal with evidence, but after a most thorough investigation, found only evidence supporting applicant's position that automobiles and automobile tires are *not* closely-related goods.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby reversed.

CONCURRING OPINION

Zervas, Administrative Trademark Judge:

In my view, the refusal must be reversed, not for the reasons stated by the majority, but rather because the examining attorney has not made out a *prima facie* case of likelihood of confusion.

The examining attorney did not introduce any evidence regarding the *du Pont* factors in his first Office action or in his final Office action. It was only in his denial of his request for reconsideration that he introduced any evidence; this evidence, however, favored applicant's position.⁵⁵

The Federal Circuit, our primary reviewing Court, requires that the Office make out a prima facie case of likelihood of confusion supported by evidence. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) ("we look only for substantial evidence, or more than a scintilla of evidence, in support of the PTO's prima facie case"). The Trademark Manual of Examining Procedure ("TMEP") requires an examining attorney to "always support

⁵⁵ The examining attorney explains at unnumbered p. 4 of his brief:

As the arguments and supporting evidence featured at pp. 11-14 of applicant's Appeal Brief were raised for the first time therein, a remand of the file was requested to permit further review of this material, and to supplement the record. This remand was granted, and extensive further research pertaining to applicable marketplace conditions was conducted. Additional evidence resulting from this research was made of record by Office Action issued October 27, 2008. It is noted that the results of additional research conducted by the undersigned clearly support and further buttress applicant's arguments at pp. 11-14 of the Appeal Brief ... Accordingly, it is respectfully suggested that a considered review of the specific holding of *In re Jeep Corp*, 222 USPQ 333 (TTAB 1984), along with its predecessors and progeny, is clearly warranted.

his or her action with relevant evidence." TMEP Section 710.01.⁵⁶

In lieu of evidence and in the context of the *du Pont* factors regarding the goods and the trade channels, the examining attorney relied on several Board decisions which found the use of identical or similar marks on automobiles and on tires likely to cause confusion. One problem with the examining attorney's reliance on these decisions is succinctly stated in TMEP §1207.01(a)(iv); because "[t]he facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances ... there can be no rule that certain goods ... are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto (citations omitted)." A second problem is that we cannot take judicial notice of facts in a prior case where the Board found goods or trade channels to be related under the facts presented in the prior case:

In the instant case, although it may be said that the opinions of the U.S. District Court for the Northern District of California and the U.S. Court of Appeals for the Ninth Circuit may be relevant under the broad definition of "relevant evidence" in Rule 401, the Board remains of the opinion that

⁵⁶ TMEP Section 710.01 adds that when an examining attorney introduces evidence contrary to the USPTO's position "[i]n appropriate cases," he or she should provide "an appropriate explanation as to why this evidence was not considered controlling."

such "evidence" is not competent evidence in a proceeding before it to prove uniqueness, notoriety or market power of opposer's mark in the marketplace today. For it is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto. See: *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 146 (TT&A Bd., 1970), and cases cited therein.

Chicken Delight, Inc. v. Delight Wholesale Co., 193 USPQ 175, 177 (TTAB 1976).

In the context of the goods, the TMEP could not be clearer:

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.

Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods/services and the goods/services listed in the cited registration.

TMEP § 1207.01(a)(vi) (emphasis added). Prior Board

decisions are not listed as factual evidence in support of a refusal.⁵⁷

⁵⁷ I view it unlikely that the Federal Circuit, if given an opportunity to consider an appeal in this case, would consider itself bound by the Board decisions cited by the examining attorney or find that the Board decisions alone are "substantial evidence" of the similarity of particular goods.

Thus, I too would reverse, but on the basis that the examining attorney has not made out a prima facie case in support of his likelihood of confusion refusal. I believe that if it is the position of the examining attorney's law office that a likelihood of confusion does not exist between a registered mark and an applicant's mark, and the evidence does not support such a refusal, the examining attorney should not refuse to register the applicant's mark. As stated above, "there can be no rule that certain goods ... are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto." TMEP §1207.01(a)(iv).

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
January 7, 2009

Mailed:
February 17, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Boler Company

Serial No. 77059048

Rodney L. Skoglund of Renner, Kenner, Grieve, Bobak, Taylor & Weber for The Boler Company.

Dannean J. Hetzel, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Cataldo, Walsh and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The Boler Company ("applicant") filed an intent-to-use application on the Principal Register for the mark QUAANTUM, in standard character form, for "trailer suspension systems, incorporating wheel end systems," in Class 12.

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the registered mark

QUANTUM, in standard character form, for "tires," in Class 12.¹

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See 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").

A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound,

¹ Registration No. 3042761, issued January 10, 2006.

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connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988).

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than a specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The applicant's mark QUAANTUM is virtually indistinguishable from the registered mark QUANTUM. The only difference between the two marks is applicant's use of the double letter "A" in the middle of its mark. If a consumer even noticed the use of the double "A," he/she would likely recognize it as a mere variation of the word "Quantum," or as a typographical error.

Applicant contends that its use of the double letter "A" is significant because applicant owns three other registrations that include a double letter "A":

1. Registration No. 1898081 for the mark INTRAAX for "axle suspension assemblies for heavy duty land vehicles";
2. Registration No. 2134996 for the mark VanTraax for "suspension systems for land vehicles"; and,
3. Registration No. 2925975 for the mark TIREMAAX for a "tire inflation system."²

Accordingly, applicant asserts that consumers will associate applicant's QUAANTUM mark with its previously registered marks.

[A]n average purchaser of a trailer suspension system is familiar and knowledgeable with the industry and the types of suspension systems available

² Copies of the registrations were made of record in applicant's August 2, 2007 response.

for tractor trailers.³ Thus, given that Applicant already has marks for its other suspension systems or assemblies that employ a "AA" construct in the marks INTRAAX and VANTRAAX, an average purchaser will be aware of those trademarks and will know that the QUAANTUM trademark is from the same source as the INTRAAX and VANTRAAX goods. To say otherwise, would be to assert that average purchasers are not aware of the other types of suspension systems they would put on tractor trailers.⁴

There are two problems with applicant's argument. First, absent evidence of actual use of applicant's previously registered marks, they are entitled to little weight in our analysis. Copies of applicant's previously registered marks are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Second, applicant is essentially asking us to find that it has a family of marks incorporating the double letter "A." In essence, applicant contends that it is the

³ Applicant's description of goods is not limited to "tractor trailers." The import of this fact is discussed in our analysis of the similarity or dissimilarity and nature of the goods.

⁴ Applicant's Brief, pp. 11-12.

owner of a group of different marks that incorporate the double letter "A" that have been used in such a way that consumers would recognize all the different double letter "A" marks used in connection with trailer suspension systems as emanating from a single source. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). However, applicant did not submit any evidence to support its theory.

In view of the foregoing, we find that the marks are similar in terms of appearance, sound, connotation and commercial impression.

B. The similarity or dissimilarity and nature of the goods described in the application and registration.

Applicant is seeking to register its mark for "trailer suspension systems, incorporating wheel end systems." However, in its brief, applicant asserted that it sells suspension systems for tractor trailers.⁵ In this regard, the likelihood of confusion is determined on the basis of

⁵ Applicant's Brief, p. 6. At oral argument, applicant's counsel confirmed that the QUAANTUM suspension system is proposed for use in connection with a tractor trailer. A "tractor trailer" is defined as "a combination trucking unit consisting of a tractor ["a short truck with a driver's cab but no body, designed for hauling a trailer or semitrailer"] hooked up to a full trailer or semitrailer." Random House Dictionary of the English Language (Unabridged), p. 2005 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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the goods and services as they are identified in the application at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

As the Court of Customs and Patent Appeals, the predecessor of our primary reviewing court, explained in *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981):

Here, appellant seeks to register the word MONOPOLY as its mark without any restrictions reflecting the facts in its actual use which it argues on this appeal prevent likelihood of confusion. We cannot take such facts into consideration unless set forth in its application.

Likewise, in this case, we must also analyze the similarity or dissimilarity and nature of the goods based on the description of the goods set forth in the

application. In other words, we may not limit applicant's trailer suspension systems to tractor trailer suspension systems. By the same token, we cannot limit or restrict the tires listed in the cited registration. Therefore, we must construe registrant's tires as encompassing tires for trailers.

The Examining Attorney contends that "the goods are similar in nature in that both are related automotive parts. Registrant's tires are used on land vehicles, as are applicant's goods."⁶ To properly analyze the relationship of the goods, we must first discuss what they are. The relevant products are defined below:

1. "Automotive" means "pertaining to the design, operation, manufacture or sale of automobiles." "Automobiles" are "passenger vehicles designed for operation on ordinary roads and typically having four wheels and a gasoline or diesel internal-combustion engine."⁷ Because applicant is seeking to register its mark for a trailer suspension system, automotive parts are not relevant to the issue before us.⁸

⁶ Examining Attorney's Brief, unnumbered page

⁷ Random House Dictionary of the English Language (Unabridged), p. 141.

⁸ The Examining Attorney did not submit any evidence showing a connection or relationship between trailer parts and automotive parts.

2. A "trailer" is defined as "a large van or wagon drawn by an automobile, truck, or tractor, used esp. in hauling freight by road."⁹

3. A "suspension system" is defined as "the arrangement of springs, shock absorbers, hangers, etc. in an automobile, railway car, etc. connecting the wheel-suspension units or axles to the chassis frame."¹⁰

4. A "vehicle" is defined as "any means in or by which someone travels or something is carried or conveyed; a means of conveyance or transport . . . a conveyance moving on wheels, runners, tracks of the like, as a cart, sled, automobile, or tractor."¹¹ Accordingly, a trailer is a vehicle.

5. Neither the Examining Attorney, nor the applicant, defined or explained the meaning of a "wheel end system."¹² In its request for reconsideration, applicant

⁹ Random House Dictionary of the English Language (Unabridged), p. 2007.

¹⁰ Random House Dictionary of the English Language (Unabridged), p. 1917. See also the WIKIPEDIA entry attached to the October 3, 2007 Office Action.

¹¹ Random House Dictionary of the English Language (Unabridged), p. 2109.

¹² At oral argument, applicant's counsel explained that a "wheel end system" comprises all the components for attaching the wheel to the suspension system. However, arguments made at oral hearing must be based on the evidence of record at the time the appeal was filed. An oral hearing may not be used to introduce evidence. TBMP §1216 (2nd ed. rev. 2004). See also *In re Caterpillar*, 43 USPQ2d 1335, 1337 (TTAB 1997) (exhibits proffered at the oral hearing were not considered). Accordingly,

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attached an advertisement published in the December 2007 issue of *Heavy Duty Trucking* magazine for "Hendrickson Quaantum FX For Vocational Trailers."¹³ The advertisement provides the following information:

The Quaantum FX melds suspension components, including extended service brakes and wheel ends, air springs and shock absorbers to work as part of a cohesive, long-life unit.

We find this description of applicant's products sufficient to corroborate applicant's explanation at the oral hearing that a wheel end system comprises all of the components for attaching the wheel to the suspension system.

The Examining Attorney submitted 11 third-party registrations that cover, *inter alia*, both tires and suspension systems as evidence that such products are a type that may emanate from a single source. *In re Infinity Broadcasting Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001). However, only two of the registrations include trailer suspension systems and tires:

1. Registration No. 3116346 for the mark BUILT FOR OFF-ROAD; and,

applicant's explanation is not evidence, and it was not considered.

¹³ Applicant claimed ownership of the house mark HENDRICKSON. (Applicant's March 27, 2008 request for reconsideration, p. 2).

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2. Registration No. 3032748 for the mark
TRAILER PRO.

One other registration was for "land vehicle parts," including tires and suspension systems: Registration No. 2696675 for the mark GRABATRAK. The remaining registrations were for automotive suspension systems and one for bike and motorcycle suspension systems. Because there was no evidence that the marketing of trailer suspension systems and tires is similar to the marketing of automotive suspension systems and tires, the registrations involving automobiles, bikes and motorcycles do not have any probative value.¹⁴

The Examining Attorney also submitted excerpts from a number of websites purportedly "demonstrating these goods

¹⁴ Applicant contends that the TRAILER PRO registration does not have any probative value because the specimen of use submitted in that application did not show the mark used with either tires or suspension systems. (Applicant's August 2, 2007 Response). TRAILER PRO was registered for numerous products in Class 12. If more than one item of goods is specified in an application in one class, it is not necessary to have a specimen for each product. TMEP §904.01(a) (5th ed. 2007). Accordingly, we cannot draw any negative inference from the specimens filed in that application.

Applicant also asserts that the registrations for the TRAILER PRO and BUILT FOR OFF-ROAD marks do not have any probative value because "Applicant was unable to find any evidence that the cited marks . . . are actually used on either tires or suspension systems." (Applicant's August 2, 2007 Response). However, applicant did not provide any corroborating evidence such as copies of the relevant websites.

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marketed and/or sold through the same retail outlets.”¹⁵ In fact, there were only two websites that showed trailer suspension systems and tires sold by the same retailer (wholesaletrailersupplies.com and centrevilletrailer.com). However, these websites do not show any trailer parts, including suspension systems, and tires sold under the same mark. Moreover, even if the websites for the automotive retailers were relevant, they do not show suspension systems and tires being sold under the same mark.

Based on this evidentiary showing (*i.e.*, three third-party registrations covering both trailer or vehicle suspension systems and tires and two websites for retail sales services, including trailer suspension systems and tires), we do not find that the Examining Attorney met her burden of proving that purchasers encountering trailer suspension systems and tires under the same or similar marks would conclude that they originate from the same source.

C. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

The Examining Attorney relies on the third-party registrations and websites discussed in the previous section to support her argument that trailer suspension

¹⁵ October 3, 2007 and April 27, 2008 Office Actions.

systems and tires move in the same channels of trade and are sold to the same classes of consumers. Applicant, however, argues that the evidence is insufficient to prove that the products move in the same channels of trade and are sold to the same classes of consumers. Because this factor deals with how and to whom the products are sold, we find that the two websites for retail sales services, including trailer suspension systems and tires, demonstrate that trailer suspension systems and tires are sold through the same channels of trade and are sold to the same consumers.

D. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.

Applicant contends that purchasers of trailer suspension systems are knowledgeable purchasers, and that the Examining Attorney has provided no evidence to the contrary. Applicant argues that relevant purchasers exercise a high degree of care for the following reasons:

Trailer suspension systems are custom designed and carefully crafted for various trailer models and applications. They must be purchased by those knowledgeable in the field of trailer construction and repair. The typical consumer is primarily a purchasing agent for trailer manufacturers. The suspension system must be carefully selected based upon a number of factors, including the make,

model, and intended use of the trailer. Thus, the consumer must be sophisticated and exercise a high degree of care in making the purchase.¹⁶

Applicant's argument is corroborated in part by the information in the *Trailer411.com* website.¹⁷

When choosing your [trailer] suspension system you are going to need to make a few considerations.

1. Trailer Size . . .
2. Capacity Options . . .
3. Number of Axles . . . You also need to consider the type of cargo you will be hauling. . . .

* * *

The key is that you match the right trailer suspension with your specific application.

This *du Pont* factor focuses on the degree of care consumers use in purchasing the products at issue. For our purposes, the issue of consumer care relates to the degree to which consumers consider the marks, as well as any other information regarding source. Thus, we analyze consumer care based on the role trademarks play in the decision making process and how relevant consumers react to the QUAANTUM and QUANTUM trademarks. In considering the role

¹⁶ Applicant's Brief, p. 18.

¹⁷ October 3, 2007 Office Action.

of consumer care in the likelihood of confusion analysis, we must determine whether the products at issue are sold under circumstances to insure care in discerning the source of the goods. *Industrial Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 UPQ 386, 387 (CCPA 1973).

In this regard, applicant did not explain how trademarks affect the purchasing decision. However, we are convinced that purchasers of trailer suspension systems, as well as trailer suspension systems incorporating wheel end systems, will exercise a high degree of care before purchasing applicant's products. A trailer suspension system is an unusual and complex product. Therefore, the purchase thereof involves considerable planning and a reasonably focused need for the product. It will be bought and sold by knowledgeable people. Undoubtedly, it will be a relatively expensive purchase. Accordingly, we believe that consumers will exercise a high degree of care in selecting a trailer suspension system, and consequently pay attention to the source of the product.

While any trailer owner may purchase tires for the trailer, the only overlap in customers would be the careful, sophisticated purchasers of applicant's products. Only the purchasers of trailer suspension systems would be exposed to both marks. Therefore, we find that the degree

of care likely to be exercised by purchasers of trailer suspension systems and tires does not support a finding of likelihood of confusion.

E. The number and nature of similar marks in use on similar goods.

Applicant argues that QUANTUM is a weak mark entitled to only a narrow scope of protection. In this regard, application points out that the word "Quantum" is the subject of over 1,000 marks in the Trademark Office database and that "there are 136 current marks in which "QUANTUM" is the full mark, and 116 of these are live registrations."¹⁸ In addition, applicant submitted copies of four third-party registrations for the mark QUANTUM for wheelchairs, boats, truck accessories, and bicycles.¹⁹

¹⁸ Applicant's Brief, p. 19. Applicant submitted the hit list from the searches in its August 2, 2007 Response. The hit lists are not proper evidence of third-party registrations. To make registrations of record, soft copies of the registrations or the electronic equivalent thereof (*i.e.*, printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Moreover, third-party use is relevant only to the extent that it establishes that the consuming public is exposed to similar marks on similar goods. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Because the hit lists do not display the goods and services, they do not have any probative value.

¹⁹ Applicant's March 27, 2008 request for reconsideration.

As indicated in Section A, absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 177 USPQ at 463. See also *In re Hub Distributing, Inc.*, 218 USPQ at 285.

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286.

In view of the foregoing, applicant's argument that the mark QUANTUM is a weak mark entitled to only a narrow scope of protection is not well taken.

F. Balancing the factors.

Because the record fails to show that the goods on which the marks will be used are similar, and because the relevant consumers will exercise a high degree of care in purchasing the products at issue, we find that the marks and the goods would not be encountered under circumstances likely to give rise to the mistaken belief that they

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originate from the same source. Accordingly, we find that applicant's registration of the mark QUAANTUM for "trailer suspension systems, incorporating wheel end systems" is not likely to cause confusion with the registered mark QUANTUM for tires. We hasten to point, however, that on a different and more complete record, we might arrive at a different result.

Decision: The refusal to register is reversed.