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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Onyx Motorbikes Inc.

Examining Attorney: John S. Yard

Serial Number: 88499821

Law Office: 115

Filed: July 3, 2019

Mark: ONYX

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Examining Attorney has objected to the registration of Applicant's mark, ONYX, due to a Section 2(d) likelihood of confusion with the registered trademark ONYX (Reg. No. 4893286). Applicant asserts that this refusal is inappropriate based on the differing goods related to the two marks, streams of commerce and sophisticated target audiences.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination.

The nature and scope of a party's goods or services must be determined on the basis of the goods or

services recited in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015). The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune to source confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). However, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

In this case, the Examining Attorney asserts that the following factors are the most relevant: similarity of the marks, and similarity and nature of the goods and/or services. However, there is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *Du Pont*, 476 F.2d at 1361, 177 USPQ at 567. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, or another established fact probative of the effect of use. *Id.*

In its Office action, the Examining Attorney states the following:

“Vehicles and their various accessories, parts, and attachments may be closely related goods such that the average person encountering the same or similar marks for such products is likely to be confused as to their source. *See, e.g., In re Gen. Motors Corp.*, 196 USPQ 574, 576 (TTAB 1977). It is well established in the marketplace that manufacturers of vehicles often produce accessories and attachments for such vehicles and market them under the same mark. *E.g., In re Gen. Motors Corp.*, 23 USPQ2d 1465, 1469 (TTAB 1992); *In re Sien Equip. Co.*, 190 USPQ 84, 85 (TTAB 1976). Tires and motorcycles, motorbikes and scooters are seen to be highly related, complimentary vehicles and vehicle goods.

The applicant's goods are electric bicycles, motorcycles and scooters. The registrant's goods are tires. The respective goods are seen to be highly related, complimentary goods which move in the same or similar channels of trade such that consumer source confusion is likely to result.”

A closer focus on the goods associated with the respective marks shows that they are quite unique and marketed in a way that does not cause consumer confusion. Exhibit A indicates that the cited conflicting mark is only used in association with commercial grade truck tires. The Registrant's use of ONYX is not associated with electric bicycles, motorcycles or scooters in any way. Similarly, Applicant does not sell trucks or any parts used in trucks. The respective goods associated with the two marks do not overlap - truck tire companies do not commonly sell electric bicycles and vice versa.

It is important to note that the target consumers who purchase the respective goods are extremely different. Applicant provides motorized two-wheel bikes that are predominantly used in urban settings. In stark contrast, Registrant sells its tires for use on commercial trucks that transport large quantities of goods. These two marks are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source because they have such different target audiences.

Furthermore, the price points of these products are quite high such that the purchases are made by sophisticated consumers who would fully research the respective brands and quickly realize they are not related. Applicant's goods, as shown in Exhibit B, is on sale for \$3,899. Registrant's goods range from \$238.99 to \$450.99 per tire, also shown in Exhibit B. The following [Wikipedia article](#) shows that commercial grade trucks commonly have 18 tires. This means that trucking companies who purchase a set of tires from Registrant spends at least \$4,301.82 when placing or replacing tires on one truck. That price increases exponentially when purchasing tires for an entire fleet of commercial trucks. This illustrates that the price point for both Applicant and Registrant's goods are quite high such that consumers are likely to make informed decisions after considerable research into the companies. Coupled with the fact that the goods do not overlap and are not marketed in a similar fashion, it is unlikely that consumers would be confused between the source of the trademarks considered in this likelihood of confusion analysis.

Conclusion

Applicant asserts that the goods associated with the two marks are sufficiently different such that there is no likelihood of confusion between the marks. The cited conflicting mark is used in association with commercial grade truck tires sold to trucking companies. Applicant provides two-wheel vehicles primarily for use in urban environments and marketed towards millennials. The goods themselves do not overlap, and they are not marketed in a way that would cause consumer confusion. Furthermore, the consumers of the products are sophisticated purchasers who would research the respective parties and make informed purchasing decisions. It is highly unlikely that they would be confused to think that the respective trademarks and their goods are related. Therefore, Applicant kindly requests that the Examining Attorney remove the 2(d) likelihood of confusion objection from the record and allow Applicant's mark to proceed towards registration.

EXHIBIT A



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ONYX

Commercial Medium Truck Tires



H0312



EXHIBIT B

PRICE

- POSITION
- APPLICATION
- BRAND
- MODEL
- TIRE TYPE
- TREADLIFE WARRANTY
- SPEED RATING
- LOAD INDEX
- LOAD RANGE
- SIDEWALL TYPES
- RUN FLAT
- SMARTWAY
- STUDDED / STUDDABLE

Have Questions?
We are here to assist & answer any questions you have about tire buying. Contact Us.

11 Tire Results Found

SORT BY Price: High to Low

Onyx X



Onyx
H0312
11/R-24.5
Part Number: **HFT0884** - Service Description: **149/146 L** - Sidewall: **BW** - Load Range: **H (16 Ply)** - Type: **Commercial Drive** - Application(s): **Mixed Service,Urban,Long Haul**

ONYPX
★★★★★ (0)

Log in to see Exclusive Member Benefits

Estimated Retail Value	Today's Price with FREE SHIPPING
\$609.99	\$450.99
\$1,803.96 for a set of 4	
You save \$159.00 per tire	



Onyx
HO126
11/R-22.5
Part Number: **HFTB8312** - Service Description: **146/143 L** - Sidewall: **TL** - Load Range: **H (16 Ply)** - Type: **Trailer**

ONYPX
★★★★★ (0)

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Estimated Retail Value	Today's Price with FREE SHIPPING
\$609.99	\$449.99
\$1,799.96 for a set of 4	
You save \$160.00 per tire	



Onyx
HO111
11/R-24.5
Part Number: **HFTB877** - Service Description: **149/146 L** - Sidewall: **BW** - Load Range: **H (16 Ply)** - Type: **Commercial Steer** - Application(s): **Long Haul,Mixed Service,Urban** - SmartWay Verified

ONYPX
★★★★★ (0)

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Estimated Retail Value	Today's Price with FREE SHIPPING
\$574.99	\$422.99
\$1,691.96 for a set of 4	
You save \$152.00 per tire	



Onyx
H0312
295/75R-22.5
Part Number: **HFTB876** - Service Description: **144/141 M** - Sidewall: **BW** - Load Range: **G (14 Ply)** - Type: **Commercial Drive** - Application(s): **Mixed Service,Urban,Long Haul**

ONYPX
★★★★★ (0)

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Estimated Retail Value	Today's Price with FREE SHIPPING
\$554.99	\$408.99
\$1,635.96 for a set of 4	
You save \$146.00 per tire	



Onyx
HO111
225/70R-19.5
Part Number: **HFTB868** - Service Description: **188/126 L** - Sidewall: **BW** - Load Range: **G (14 Ply)** - Type: **Commercial Steer** - Application(s): **Long Haul,Mixed Service,Urban** - SmartWay Verified

ONYPX
★★★★★ (0)

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Estimated Retail Value	Today's Price with FREE SHIPPING
\$369.99	\$243.99
\$975.96 for a set of 4	
You save \$126.00 per tire	



Onyx
HO111
245/70R-19.5
Part Number: **HFTB869** - Service Description: **135/133 L** - Sidewall: **BW** - Load Range: **H (16 Ply)** - Type: **Commercial Steer** - Application(s): **Long Haul,Mixed Service,Urban** - SmartWay Verified

ONYPX
★★★★★ (0)

Log in to see Exclusive Member Benefits

Estimated Retail Value	Today's Price with FREE SHIPPING
\$359.99	\$238.99
\$955.96 for a set of 4	
You save \$121.00 per tire	



Onyx
All Steel ST Radial
7.5R-16
Part Number: **HF5T58** - Sidewall: **TL** - Load Range: **G (14 Ply)** - Type: **Trailer**

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Estimated Retail Value	Today's Price with FREE SHIPPING
\$304.99	\$187.99



RCR - 72V 6000W

ONYX MOTORBIKES

\$3,899.00

Panels

STD

Accessories

None

Quantity

1

ADD TO CART

Shipping costs will be determined upon checkout.

This limited supply run will ship within 90 days of your order.

Delivery time can take from 1-2 weeks. We build our bikes in San Francisco, CA. Delivery time estimates from when the bikes leave our warehouse to your delivery address vary depending on your proximity to our warehouse.

Note all bikes are shipped with a specialized trucking company Haul Bikes for roll-on/roll-off ready to ride delivery. No extra packaging or pallet loading necessary.