

**RESPONSE TO OFFICE ACTION**  
**Issued February 10, 2020**

To Commissioner for Trademarks:

Mark: TRACE  
Serial No.: 88177732  
Applicant: Bell Sports, Inc.  
Our Ref. No.: T34686US00 (972852.00546)

The Examiner issued a first office action on February 10, 2020, objecting to registration based on Section 2(d) Refusal – A Likelihood of Confusion with a pre-existing registration for TRACE (RN 5848122) (the “Cited Mark”), which does not cover protective helmets.

Applicant Bell Sports, Inc. (“Applicant”) respectfully disagrees with the Examiner’s conclusion and submits that the goods of the Applicant’s Mark are distinguishable, that the Cited Mark is weak when used in connection with the goods in Class 28, the Applicant’s Mark is to be used in connection with goods in Class 9, not Class 28, and that the marks can coexist without a likelihood of confusion.

**Amendment to Identification of Goods**

As a preliminary matter, Applicant has amended its goods to cover “protective bicycle helmets” in International Class 9 (hereinafter referred to as “Applicant’s Goods”). This amendment and limitation to the filed-for goods serves to further distinguish Applicant’s goods from those of the goods covered by the Cited Mark.

**Summary of Arguments**

Applicant respectfully submits that no likelihood of confusion exists between Applicant’s Mark and the Cited Mark, and provides the following summary list of arguments supporting registration of the applied-for mark TRACE:

- The Examiner erred in concluding that a likelihood of confusion exists if the Applicant’s mark registers.
- The Cited Mark coexists with other TRACE-formative registrations for sporting goods in International Class 28 without consumer confusion, rendering the Cited Mark weak.
- Applicant’s Goods in International Class 9 are protective helmets, specifically those used for bicycling. Applicant believes bicycle helmets are distinguishable from the goods of the Cited Mark, which cover knee pads, elbow pads, and shin guards for soccer, baseball and softball.
- The Cited Mark’s ID is specifically limited to specific sports that are unrelated to bicycling and Applicant’s goods.
- The Examiner is required to evaluate the relatedness of the goods based on the goods in the respective filings, and not to expand beyond limitations inserted by the mark owner.

Given the foregoing arguments, which are set forth in detail below, Applicant respectfully requests that the Examiner withdraw the refusal and approve Applicant’s Mark for publication.

## LEGAL STANDARD

Under the Lanham Act, “no trademark by which the goods/services of the applicant may be distinguished from the goods/services of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...” TMEP §1207.01.

In the case *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the court provided the factors relevant to a finding likelihood of confusion. In setting forth the factors, the court cautioned that, with respect to determining likelihood of confusion:

- “[T]here is no litmus rule which can provide a ready guide to all cases.” *Id.* at 1361, 177 USPQ at 567.
- Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 1361-62, 177 USPQ at 567-68; see also: *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000).
- Furthermore, the significance of a particular factor may differ from case to case. See: *DuPont*, 476 F.2d at 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533 (noting that “any one of the factors may control a particular case”). There is no mechanical test for determining likelihood of confusion and “each case must be decided on its own facts.” *DuPont.*, 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 and services are related, because these factors are outweighed by other factors, such as number and nature of similar marks in use on similar goods. See TMEP §1207.01.

## Analysis

### **1. The Cited Registration Coexists with Other “TRACE” Marks for More Similar Goods**

The Cited Mark coexists with another TRACE-formative mark, TRACEFIT (RN 5400821), registered in International Class 28. The Cited Mark faced a 2(d) Refusal due to the previously registered mark TRACEFIT, which is registered in connection with:

“Body limb compression sleeves, namely, arm sleeves, leg sleeves, elbow sleeves, knee sleeves and ankle sleeves all for use in running and other sports; compression garments, namely, compression socks, leggings and tights; compression garments for athletic use, namely, compression leggings, body suits, pants, socks and stockings; athletic ankle, elbow and knee braces for medical use; orthopedic braces for knees, elbows and ankles; rehabilitation accessories, namely, shoulder stretcher using resistance cables; body rehabilitation apparatus for medical purposes; electrical stimulation apparatus for nerves, muscles, and skin, for physical therapy, rehabilitative and pain

management purposes; physical rehabilitation, physical therapy and sports medicine equipment and accessories, namely, shoulder stretcher using resistance cables; electromedical rehabilitative and pain management products for clinical and home use, namely, electrical nerve and muscle stimulators, ultrasonic stimulators, magnet therapy stimulators and laser therapy stimulators; force and motion testing apparatus for physical rehabilitation.”

The Cited Mark was applied for in connection with “athletic equipment, namely, protective guards for arms and legs, and athletic protective pads for playing soccer, baseball, and softball in the nature of a corset containing protective pads.” In the refusal, the Examiner held that the marks and the goods were too similar for the two marks to coexist in the marketplace, but the parties stated in the record that they were coexisting in the marketplace without confusion in part due to differences in goods and sophistication in consumers. The goods used in connection with TRACEFIT are more similar to the goods of the Cited Mark than the protective helmets covered by the Application. However, these two marks coexist on the register and in the marketplace without consumer confusion.

Thus, the Cited Mark is weak when used in connection with protective pads and compression sleeves in International Class 28. Because the Cited Mark can coexist without consumer confusion with other TRACE marks, including marks used in connection with goods that are more similar to the Cited Marks’ goods, the Applicant respectfully submits that there will be no likelihood of confusion should the Applicant’s mark register in connection with protective bicycle helmets.

## **2. Applicant’s Goods are Distinguishable from the Goods Covered by the Cited Mark**

The Applicant’s mark is used in connection with protective bicycling helmets in International Class 9, and is limited to protective bicycling helmets. The Cited Mark covers “athletic equipment, namely, protective guards for arms and legs, and athletic protective pads for playing soccer, baseball, and softball in the nature of a corset containing protective pads” in Class 28. Cycling helmets are different goods than protective guards for arms and legs. The features and functions differ greatly between the goods. Additionally, given that both are for the safety of consumers, greater care is given when making a purchase, which reduces likelihood of confusion in the marketplace.

The goods are also included in different International Classes. Applicant’s mark is only applied for in Class 9 and is used only in connection with a head safety item, protective bicycling helmets. The Cited Mark’s goods fall under International Class 28, whereas the Applicant’s Goods fall under International Class 9. The International Class system was created to group like goods and services together to determine the potential for consumer confusion. Here, the goods of the Cited Mark and the Applicant’s Mark are in different classes. Both may be considered protective gear, but bicycle helmets are a specialized subclass of protective gear, which is why the Applicant’s mark is applied for in Class 9.

Though these goods are not wholly unrelated, as the Examiner pointed out that some companies do sell all types of protective gear, the goods identifications in this instance are highly specific and distinguishable. The Cited Mark owner narrowed their identification to include protective guards for arms and legs, and further specified for which activities these pads are used: playing soccer, baseball and softball. The Cited Mark is actually used in connection with knee pads, shin guards, and elbow pads. The Applicant’s goods are specific to the head, protective helmets, and specifically bicycling helmets. Cycling helmets are not included in the narrow identification of the Cited Mark, nor are they used in the sports of baseball, soccer, or softball. The Cited Mark’s identification also specifically denotes which

body parts the protective guards were to be used for: arms and legs. Helmets are used to protect the head, and are not used for arms and legs.

In addition, Applicant draws the Examiner's attention to *In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. Cir. 2003), which is particularly insightful and analogous to the present case. In *Coors*, the Examiner "introduced evidence from several sources discussing the practice of some restaurants to offer private label or house brands of beer; evidence that brewpubs who brew their own beer often feature restaurant services; and copies of several third-party registrations showing that a single mark had been registered for both beer and restaurants services." 343 F.3d at 1345, 68 USPQ2d at 1063; TMEP 1207.01(a)(ii)(A). The Federal Circuit concluded that even if beer and wine are sometimes sold by the same party under the same mark, beer and wine are not sufficiently related that the use of similar marks on the products is likely to cause confusion as to source.

The Examiner is erroneously expanding the scope of the protection of the Cited Mark in Class 28 beyond the protection that it should be afforded. The Examiner ignores the information in the filing details and limitations included therein, which clearly state that the respective marks cover goods that serve a specific purpose, are narrowly construed and niche, and are distinguishable from each other. The Cited Mark is weak due to its coexistence with other TRACE-formative marks registered in connection with highly similar goods in Class 28, and its identification is very specific in which protective pads it covers and for which activities these pads are used. Consequently, the Applicant respectfully submits that there is no likelihood of confusion and the Application should proceed to registration.

### **Conclusion**

Based on the foregoing, there is no likelihood of confusion between Applicant's Mark and the Cited Mark. Applicant respectfully requests the Examiner withdraw the refusal and approve Applicant's Mark for publication.

Respectfully submitted on behalf of Applicant:

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