

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

Applicant: Jaguar Land Rover Limited

Serial No.: 88267199

Filed: January 18, 2019

Mark: DEFENDER

Class: 12

Atty. Docket No.: LAND10497TIX-US

Examining Attorney: Andrea Koyner Nadelman / Law Office 110

**RESPONSE TO OFFICE ACTION**

This document is filed in response to the Examining Attorney's Office Action mailed April 14, 2020. Applicant respectfully requests that the Examining Attorney withdraw her refusal to register the mark. Applicant submits that the mark is properly registrable in accordance with the Trademark Act.

**A. Amendment to Identification of Goods**

Applicant requests that the identification of goods be amended as follows:

Class 12

Motor vehicles, namely, automobiles, trucks, sport utility vehicles and structural parts therefor, excluding side-by-side vehicles and structural parts therefor

**B. Claim of Prior Ownership**

Applicant owns four registrations on the Principal Register of the United States Patent and Trademark Office for the identical DEFENDER mark and hereby requests that the following statement be entered into the record, in accordance with Section 812 of the TMEP:

Applicant is the owner of prior registration numbers 1803707, 4958204, 5494546, and 5837261.

### **C. No Likelihood of Confusion**

The Examining Attorney has refused registration of Applicant's DEFENDER mark because of a perceived likelihood of confusion with the mark in cited registration number 5944336. For the reasons below, Applicant believes there is no likelihood of confusion with the cited registration and, accordingly, respectfully requests withdrawal of the refusal to register Applicant's mark.

#### **1. Registration No. 5944336**

The Examining Attorney has refused registration of the applied-for mark on the asserted basis that it is likely to be confused with the mark in Registration No. 5944336, which covers "recreational vehicles, namely, side-by-side vehicles and structural parts therefor." Specifically, the Examining Attorney stated that "the application use(s) broad wording to describe land vehicles and motor land vehicles, which presumably encompasses all goods and/or services of the type described, including registrant's more narrow identification of side-by-side vehicles."

As noted above, Applicant has amended the identification of goods to narrowly tailor its goods to automobiles, trucks, and sport utility vehicles, and structural parts therefor. Additionally, Applicant has specifically excluded "side-by-side vehicles and structural parts therefor." The amended and exclusionary language obviate any likelihood of confusion and, accordingly, registration of Applicant's mark should be allowed.

#### **2. Applicant Already Owns Four DEFENDER Registrations**

Applicant is the owner of four registrations on the Principal Register for its DEFENDER mark, as follows:

Reg. No. 1803707 for DEFENDER for "motor land vehicles; namely, station wagons," which issued November 9, 1993;

Reg. No. 4958204 for DEFENDER for “toys, games and playthings, namely, model cars, scale model vehicles, model toy vehicles, toy vehicles, radio controlled toy vehicles, rideable toy vehicles and accessories therefor, toy model kit cars, all sold complete or in kit form, stuffed toy animals, puzzles, playing cards; sporting articles, namely, golf clubs, golf bags, golf bag covers, golf club covers, golf balls, golf divot repair kits comprised of divot repair tools, golf ball dispensers, decorations for Christmas trees, namely, Christmas tree ornaments,” which issued May 17, 2016;

Reg. No. 5494546 for “computer hardware; on-board computers for vehicles; computers for autonomous-driving; on board electronic systems for providing driving and parking assistance; cruise controls for motor vehicles; vehicle speed control apparatus; automotive computer hardware and software for use in or in connection with motor land vehicles to make restaurant reservations, locate and reserve parking, make travel arrangements, request valet service, order transport and delivery of parcels, order chauffeur and concierge services, locate vehicle charging stations, order taxi transportation, book tickets for sporting, cultural and entertainment events, book rental or lease of cars, set up ride shares, request and obtain car history, participate in car rental club, obtain information about public and mass transit, manage business travel, track driver behavior to collect and transmit results with recommendation for vehicle selection, plan routes and modes of transportation with possibility to earn points that can be used to acquire work benefits and vouchers for goods and services of others, coordinate and engage transportation services, provide communications and entertainment connectivity in connection with the use of motor land vehicles, provide connectivity within the vehicle, between vehicles, with cell phones, and with data centers; telemetry devices for motor vehicle and engine applications; downloadable mobile applications for remote and in-vehicle access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation; global positioning system (GPS); navigational systems comprising electronic transmitters, receivers, circuitry, microprocessors, cellular telephone and computer software all for use in navigation and all integrated into a motor vehicle; downloadable electronic maps; electric control panels; electronic control apparatus, namely, electrical controllers; LCD large screen displays; sensors, namely, pressure sensors; integrated electronic safety systems for land vehicles, namely, electronic proximity sensors and switches; safety and driving assistant system for mobile vehicles and vessels comprised of electronic proximity sensors and switches, high-resolution cameras, integrated circuits for the purpose of imaging processing, and display monitors; lasers for use in relation to vehicles, namely, laser object detectors for use on vehicles; cameras for vehicles; onboard cameras; action cameras; parking sensors and rear-view cameras for vehicles; automotive measuring, namely, water temperature gauges, air fuel-ratio gauges, boost gauges, vacuum gauges and exhaust gas temperature gauges; electronic apparatus for collecting measurements and receiving data, namely, temperature sensors; computer software, mobile applications and wireless transmission and receiving equipment for use in controlling autonomous and hands-free driving, automobile safety features and warning or alarm functions, accident prevention and traffic alerts; anti-theft warning devices, namely, vehicle monitoring and anti-theft vehicle alarms; wireless transmission

and receiving equipment, namely, sensors, computers, and data wireless transceivers to provide connectivity within a vehicle, between vehicles, with cell phones, and with data centers; interactive multimedia software; electric connections; anti-theft warning devices, namely, vehicle monitoring and anti-theft vehicle alarms; alarm sensors; level gauges; namely, panels containing odometers, speedometers, and tachometers; odometers; speedometers; tachometers; temperature sensors; voltmeters; ammeters; testing apparatus, namely, voltmeters; proximity meters, namely, proximity sensors; electric circuit breakers; instrument panels and clusters, namely, panels containing odometers, speedometers, and tachometers; commutators; electric condensers; electric connections; electric cables; electric fuses; electric fuse boxes; electric control apparatus and instruments for motor vehicles and engines, namely, vehicle climate controls, cruise controls for motor vehicles, etc.; electrical sensors; fire extinguishing apparatus; level gauges; lenses for lamps, namely, magnifying lenses; printed electrical circuits; electric relays; electric switches; electric wiring harnesses; semiconductor testing apparatus; apparatus for recording, transmission or reproduction of sound and images; mechanical remote controls for motors; remote control starters for vehicles; emergency warning lights; emergency notification system comprising data processor and a user input device for connecting the data processor to an emergency response entity through a communication network and allowing audio and data communication between the processor and the entity; wireless controllers to remotely monitor and control the function and status of other electrical, electronic, signaling systems and mechanical devices for use in connection with vehicles and engines for vehicles; computer software, mobile applications and wireless transmission and receiving equipment for controlling autonomous and hands-free driving, automobile safety features and warning or alarm functions, accident prevention and traffic alerts, all for use in vehicles; communications apparatus to transmit and receive communications via vehicles; charging stations for charging electric vehicles; apparatus and cables for use in charging electric vehicles; batteries for vehicles; electric accumulators, voltage regulators, aerials, electric batteries and mountings; computer hardware and software for tracking driver behaviour; temperature sensors, computers and wireless transceivers to provide connectivity within the vehicle, between vehicles, with cell phones, and with data centers; computer hardware, software and electrical apparatus to provide tactile, audible and visual interfaces to interact with occupants of the vehicle; wireless transmission and receiving equipment for use in connection with remote computers for use in automobiles for tracking, monitoring and diagnosing maintenance for vehicles and for providing information to drivers; computer application software for use by drivers and passengers of vehicles for accessing, viewing, and interacting with and downloading information and entertainment content; downloadable software and on-board computer software that provides users with remote and in-vehicle access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation; diagnostic apparatus consisting of sensors for use in testing vehicle function and in diagnosing vehicle electrical and mechanical problems; software and software applications for allowing users to track and locate stolen vehicles, charge electronics, and store and synchronize collected personalized user and vehicle information; electronic interface modules sold as an integral part of a vehicle, namely, electronic interface modules for wired and wireless interface of mobile phones and electronic media players with an automotive electrical system; display

panels for vehicles namely, electronic control panels and touchscreens for use in land vehicles; electronic interface modules for wired and wireless interface of mobile phones and electronic media players with an automotive electrical system; audio, audiovisual or telecommunications equipment, namely, Personal Digital Assistants; tablet computers; jukeboxes; multimedia devices, namely, portable handheld electronic digital video messengers for recording, storage, transmission or reproduction of visual, audio and data content; radio apparatus, namely, radios; in-car entertainment systems in the nature of car stereos; sound reproducing apparatus; televisions; radios; CD players; loud speakers; personal digital assistants; tablet computers; multimedia devices, namely, portable handheld electronic digital video messengers for recording, storage, transmission or reproduction of visual, audio and data content; mp3 and mp4 players; telephones; mobile telephones; straps for telephone handsets; screen savers for phones and tablets; car telephone installations, namely, in car telephone handset cradles; computer game cartridges, computer games software; highway emergency warning lights; thermometers; compasses; calculators; electronic instructional and teaching apparatus and instruments, namely, simulators for driving or control of vehicles; electrical and scientific apparatus for use in the repair and servicing of vehicles, namely, handheld diagnostic scanners for automobiles; magnets; tape measures; eyewear, namely, eyeglasses, sunglasses, driving eyeglasses and skiing goggles; cases for eyeglasses, sunglasses or skiing goggles; racing driver protective clothing, in the nature of racing safety apparel, namely, flame retardant balaclavas; parts for any of the aforesaid goods; all of the foregoing accessory to or directly related to motor vehicles; none of the foregoing including installation or maintenance of residential and commercial security systems and home automation systems” in Class 9 and “Maintenance, servicing, repair, striping, restoration, cleaning, washing, painting, respraying and polishing of motor vehicles, bicycles, scooters, prams or strollers or of parts and accessories therefor; finishing and tuning of motor vehicles; wheel balancing, alignment and repair; vehicle breakdown repair services; garage services, namely, vehicle repair and maintenance; information, advice and consultancy relating to any of the aforesaid services; none of the foregoing including installation or maintenance of residential and commercial security systems and home automation systems” in Class 37, which issued June 19, 2018;

Reg. No. 5837261 for “Clothing, namely, footwear and headwear; outerwear, namely, jackets and coats; leisurewear, namely, leisure suits; T-shirts, tops as clothing, polo shirts, sweatshirts, hooded tops as clothing, hooded pullovers, shirts, fleece pullovers, fleece jackets, sweaters; suits, coats, dresses, skirts, jackets, vests, blazers, anoraks; sweatpants, trousers, shorts; overalls, coveralls, uniforms, smocks; underclothing, pajamas, sleep masks, pocket squares, swimwear, bathing suits, bathing trunks; scarves, bandanas, sashes for wear; hosiery, socks, stockings; cloth bibs; Halloween and masquerade costumes; fancy dress masquerade costumes; aprons; belts; gloves, mittens, driving gloves; ties as clothing; headwear, namely, hats, caps, head scarves, head wraps, headbands, visors, ear muffs, and knitted beanies; footwear, namely, shoes, boots, slippers, shoes for drivers, sandals; children's clothes, namely, pants, shirts, socks, shoes, jackets, mittens, scarves, hats, and sweaters; babies clothes, namely, infant wear; sports teams club shirts; sports teams scarves; sports teams supporters clothing, namely, headwear and footwear; none of the

foregoing for use in connection with motorcycle clubs,” which issued August 20, 2019.

Registration No. 1803707 for DEFENDER covering “motor land vehicles; namely, station wagons” is based on use by Applicant of the DEFENDER mark since at least as early as August 7, 1992 and, accordingly, the DEFENDER mark has long been associated with Applicant. Indeed, for over 28 years, Applicant has been using its DEFENDER mark in commerce and has owned Reg. No. 1803707 for its DEFENDER mark. Furthermore, in 1991, the year that Applicant filed its application that matured into Registration No. 1803707, “station wagons” described the category of vehicles that, now thirty years later, includes sport utility vehicles, minivans, and cross-over vehicle. That is, the vehicles in the instant application are covered by this prior registration.

Accordingly, due to this long association in the minds of consumers of the DEFENDER Mark with Applicant, including the long association of the mark for motor land vehicles, namely, station wagons, and in view of Applicant’s prior registration covering these goods (albeit under a now outdated name), confusion as to source of Applicant’s goods is not likely.

### **3. Conclusion – No Likelihood of Confusion**

The fundamental inquiry of likelihood of confusion goes to the cumulative effect of the differences in the marks and the goods or services at issue. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (C.C.P.A. 1976). Given Applicant’s long use of DEFENDER since at least 1992 and its long association in the minds of consumers with Applicant, principally for motor land vehicles, Applicant’s four registrations for DEFENDER, and Applicant’s amendments and restriction to its identification of goods further differentiating its goods from the goods in the cited registration, it remains clear that Applicant’s mark is distinguishable as a source indicator for Applicant’s goods and is not likely to be confused with the cited mark under the factors set forth

in *In re E.I. DuPont De Nemours & Co.*, 476 F.2d 1356, 177 USPQ 563 (CCPA 1973). As such, Applicant's mark is entitled to registration under 15 U.S.C. § 1052.

**D. Response Conclusion**

Applicant submits that its mark is in a form suitable for registration on the Principal Register and respectfully requests such action. Should the Examining Attorney have further questions or require additional information, she is requested to contact undersigned counsel.

Respectfully submitted,

**JAGUAR LAND ROVER LIMITED**

By   
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*Attorney/Agent for Applicant*

Date: October 14, 2020

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