

This document is filed in response to the non-final Office Action mailed February 28, 2019.

I. INTRODUCTION

The Examining Attorney has refused registration of Applicant's mark THUNDER because of a likelihood of confusion with the mark in U.S. Registration No. 5472001, THUNDER WHEELER and Design, for "land vehicles; electric land vehicles" in Class 12 in the name of an Icelandic individual, Valgeir Tomas Sigurdsson ("Registrant").

For the reasons set forth below, Applicant respectfully disagrees.

II. Limitation to the Identification of Goods

In an effort to overcome the refusal, Applicant hereby amends the identification of goods as follows:

Motor vehicles, namely, ~~electric vehicles~~, passenger automobiles, trucks, sport utility vehicles, off-road vehicles, and structural parts, fittings, and badges therefor; metal license plate frames

III. ARGUMENT

1. Ownership of Prior Applications/Registrations

Applicant has prior rights in THUNDERBIRD, which contains the applied-for mark THUNDER in its entirety:

THUNDERBIRD (Stylized) RN: 618942 SN: 71690079	Renewed January 10, 2006 Int'l Class: 019 First Use: February 20, 1954 Filed: June 23, 1955 Registered: January 10, 1956	(Int'l Class: 019) automobiles	Ford Motor Company (Delaware Corp.) One American Road Dearborn Michigan 48126
THUNDERBIRD RN: 1866910 SN: 74459526	Renewed December 13, 2014 Int'l Class: 12 First Use: March 6, 1986 Filed: November 18, 1993 Registered: December 13, 1994	(Int'l Class: 12) metal license plate frames	Ford Motor Company (Delaware Corp.) The American Road Dearborn Michigan 48126
THUNDERBIRD SN: 87032503	Allowed - Intent to Use 3rd Extension of Time Granted July 9, 2019 Filed: May 11, 2016	(Int'l Class: 12) motor vehicles, namely, passenger automobiles, their structural parts, engines, trims, badges, and accessories, namely, fitted motor vehicle covers, vehicle rooftop carriers, bug deflectors for motor vehicles, mud flaps for motor vehicles, trailer hitch receiver plugs for motor vehicles, sunshades and license plate frames for motor vehicles	Ford Motor Company (Delaware Corp.) One American Road Dearborn Michigan 48126

Applicant submits that there is not a likelihood of confusion between THUNDER and THUNDER WHEELER, where Applicant has a long history of use of the THUNDERBIRD trademark in association with passenger automobiles, and Registrant's THUNDER WHEELER already coexists in a crowded field of THUNDER-formative marks in Class 12 (see below).

3. Widespread Use of THUNDER-formative Marks in Class 12

In addition to Applicant's prior THUNDERBIRD mark, the registered mark, THUNDER WHEELR, already coexists with a number of THUNDER-formative marks for vehicles in Class 12. Consumers are accustomed to distinguishing between various marks incorporating THUNDER, such that Applicant's use of THUNDER to identify a trim level for Applicant's FORD branded vehicles will not create any potential for confusion:

TM	Status	Goods/Services	Owner
THUNDER POWER RN: 5700078 SN: 86814766	Registered March 19, 2019 Filed: November 10, 2015	(Int'l Class: 06) ... (Int'l Class: 07) ... (Int'l Class: 09) ... (Int'l Class: 12) ... cars; electric vehicles, namely, cars, suvs, trucks; motors, electric, for land vehicles; motor racing cars; sports cars; cars, namely, station wagons... (Int'l Class: 37) ...	Thunder Power Hong Kong Limited (Hong Kong Special Administrative Region of the People's Republic of China, the Limited Company (Ltd.)) Rm 901, 1 Lyndhurst Terrace Central Hong Kong Special Administrative Region of the People's Republic of China, The
THUNDERCAT RN: 3915903 SN: 77917257	Registered 8 & 15 April 8, 2017 Int'l Class: 12 First Use: June, 2007 Filed: January 21, 2010 Registered: February 8, 2011	(Int'l Class: 12) all-terrain vehicles and parts thereof	Arctic Cat Inc. (Minnesota Corp.) 500 North 3rd Street Minneapolis Minnesota 55401
THUNDERCAT RN: 1762029 SN: 74207132	Renewed March 30, 2013 Int'l Class: 12 First Use: November 6, 1992 Filed: September 26, 1991 Registered: March 30, 1993	(Int'l Class: 12) motorized vehicles; namely, snowmobiles and structural parts thereof	Arctic Cat Inc. (Minnesota Corp.) P.O. Box 810, 600 South Brooks Avenue Thief River Falls Minnesota 56701
THUNDERHAWK RN: 3363780 SN: 78928944	Renewed January 1, 2018 Int'l Class: 12 First Use: October 22, 2007	(Int'l Class: 12) automobiles, namely, refurbished, restored and modified automobiles	Rhyne, Delonzo (United States Citizen) One Indiana Square Suite 3500 C/O Taft Stettinius & Hollister

TM	Status	Goods/Services	Owner
	Filed: July 13, 2006 Registered: January 1, 2008		LLP Indianapolis Indiana 46204
THUNDERBOLT RN: 4552633 SN: 85832952	Registered June 17, 2014 Int'l Class: 12 First Use: September 25, 2013 Filed: January 25, 2013	(Int'l Class: 12) bicycles and bicycle frames	Industries Rad Inc. (Canada Corp.) 9095 - 25th Avenue, Saint-Georges Quebec G6a1a1 Canada
THUNDER EDITION SN: 86916991 Disclaimer: "EDITION"	Allowed - Intent to Use 4th Extension of Time Granted March 8, 2019 Filed: February 23, 2016	(Int'l Class: 12) automotive accessories kits to make aesthetic and structural changes to an automobile comprising hydraulic shock absorbers, side steps, bumpers, lights, speedometer calibrators, rock rails with steps, spare tire carriers, winches, badges, leather interiors, fender flares, hoods, fitted floor liners, air snorkels, wheels and tires	Gust, Mike (United States Citizen) 11350 Northwest Freeway Houston Texas 77092
THUNDER FIRE RN: 2848122 SN: 76308413	Renewed June 1, 2014 Int'l Class: 12 First Use: October 18, 2001 Filed: September 4, 2001 Registered: June 1, 2004	(Int'l Class: 12) motorcycles and structural parts thereof	Midwest Motorcycle Supply Distributors Corp. (Missouri Corp.) 2100 State Road Z Pevely Missouri 63070
THUNDER HORSE RN: 2719944 SN: 76308491	Renewed May 27, 2013 Int'l Class: 12 First Use: August 13, 2001 Filed: September 4, 2001 Registered: May 27, 2003	(Int'l Class: 12) motorcycles and structural parts therefor	Midwest Motorcycle Supply Distributors Corp. (Missouri Corp.) P.O. Box 669 2100 State Road Z Pevely Missouri 63070
THUNDER MONSTER RN: 2826209 SN: 76486547	Renewed March 23, 2014 Int'l Class: 12 First Use: October 15, 2002 Filed: January 31, 2003 Registered: March 23, 2004	(Int'l Class: 12) structural parts for motorcycles	Maybeck, James C. (United States Citizen) 2910 Polo View Ln Matthews North Carolina 28105

These registrations establish that the consuming public is exposed to third-party use of marks containing THUNDER for motor vehicles related to, if not identical to, those in the Cited Mark. As stated in TMEP 1207.01(d)(iii), this evidence is relevant to show that the Cited Mark is relatively weak and entitled to only a narrow scope of protection. Indeed, "third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services." TMEP 1207.01(d)(iii).

Applicant asserts that the number and nature of marks similar to THUNDER WHEELS coexisting in Class 12 establishes that the Examiner should grant the cited registration only a narrow scope of protection. As demonstrated above, the consuming public is accustomed to seeing and distinguishing between these brands for highly-related and identical goods. The commercial context thus illustrates that consumers will readily distinguish between the products sold under Applicant's mark and those sold under the non-identical cited mark.

Finally, Applicant respectfully requests consistency in examination and notes that should the parties have any issue, they have the opportunity to oppose one another's applications or seek cancellation.

IV. CONCLUSION

If there is any doubt as to Applicant's mark, that doubt must be resolved in favor of the Applicant. *In re Shutts*, 217 USPQ 363 (TTAB 1983); see also *In re Bel Paese Sales Co.*, 1 USPQ2d 1233 (TTAB 1986). Doubt is properly resolved by publishing the mark and allowing any party that believes it would be damaged by the registration of the mark to file an opposition.

In light of the foregoing arguments, the Applicant respectfully requests the Examiner to reverse the refusal to register and pass the application to publication.

Should the Examiner have any remaining concerns, they are invited to contact the undersigned counsel.