

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ford Motor Company
Serial No.: 88362589
Filed: March 29, 2019
Mark: MUSTANG MACH-E
Class: 12
Atty. Docket No.: 84145971
Examining Attorney: Ingrid C. Eulin/ Law Office 111

RESPONSE TO OFFICIAL ACTION

Applicant, Ford Motor Company, files this document in response to the Examiner's Official Action, dated May 1, 2019. Based upon Applicant's amendments and the information/arguments set forth below, Applicant respectfully requests that the Examiner withdraw her objections, and approve the amended application for publication.

A. **Request For Amendment to Insert a Claim of Ownership of Prior Registrations**

Applicant seeks an amendment of the application to insert a claim of ownership of multiple prior registrations for the mark MUSTANG:

The Applicant claims ownership of active prior U.S. Registration Nos. 1467208, 1995783, 5205106, and others.

B. Request for Amendment to the Designation of Goods

Applicant further seeks to amend the designation of goods as follows:

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

This amendment is a clarification, and not an expansion of the scope of the goods, and as such, it is proper under 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

C. Request for Withdrawal of the §2(d) Refusal

Ford respectfully requests removal of the §2(d) refusal, in view of its prior rights in the MUSTANG portion of the composite mark, and the amended goods of the application. Ford owns multiple registrations for MUSTANG, which the Trademark granted long prior to the issuance of the cited marks. Ford's mark MUSTANG MACH-E is different in sight, sound and meaning from the cited MUSTANG & DESIGN marks, and the goods are clearly distinguishable. In addition, the marks have coexisted on the Principal Register and in the marketplace for decades. With the amendment to clarify the nature of the goods, there is no basis for a likelihood of confusion here.



1. Ford's Prior Registrations Establish Its Right to Use and Register the Mark

Ford first used the mark MUSTANG in 1964, and obtained its first registration for the mark MUSTANG in Class 12 (Reg. No. 1467208) in 1987. Since that time, it has obtained many additional trademark registrations incorporating MUSTANG and MUSTANG DESIGNS, and developed rights in its famous, iconic mark in connection with its vehicles and additional goods.

This registration has been registered for over 55 years, is incontestable, valid and subsisting, uncancelled and unrevoked.

Ford lists below the particulars of this 1987 registration, in force for over 55 years, along with some of its additional current registrations:

TRADEMARK	Status	Goods/ Services
MUSTANG	Reg. No. 1467208 Issued 12/01/1987 Incontestable 2 nd Renewal filed	Class 12: Automobiles and their structural parts (First Use: 4/17/1964)
MUSTANG	Reg. No. 1995783 Issued 8/20/1996 Incontestable 2 nd Renewal filed	Class 12: Auto parts and accessories, namely license plate frames, sunshades, sun screens, exterior insignia badges, fitted and semi-fitted covers for vehicles, vehicle seat covers, fender covers. (First Use: 11/1/1985)
MUSTANG	Reg No. 4060306 Issued 11/22/2011 Incontestable	Class 12: Bicycles (First Use: 9/1/2011)
MUSTANG	Reg No. 5205106 Issued 5/16/2017	Class 12: Motorized golf carts (First use: 10/26/2015)
MUSTANG	Reg No. 1858362 Issued 10/18/1994 Incontestable 2 nd Renewal filed	Class 6: Metal goods; namely, decorative boxes, key tabs, key rings and non-luminous non-mechanical signs (First Use: 11/1/1986)
MUSTANG	Reg No. 2061634 Issued: 5/13/1997 Incontestable 2 nd Renewal filed	Class 6: Metal license plates (First Use: 1/1/1994)
MUSTANG	Reg No. 1858696 Issued: 10/18/1994 Incontestable 2 nd Renewal filed	Class 27: Floor mats for vehicles (First Use: 9/15/1992)

MUSTANG	Reg No. 1922186 Issued: 9/26/1995 Incontestable 2 nd Renewal filed	Class 28: Toy replicas of historic automobiles and hobby kits for the construction of such replicas (First use: 9/00/1963)
MUSTANG COBRA	Reg No. 2191112 Issued: 9/22/1998 Incontestable 2 nd Renewal filed	Class 28: Toy cars (First Use: 12/2/1997)
	Reg No. 2175903 Issued: 7/28/1998 Incontestable 2 nd Renewal filed	Class 25: Clothing, namely shirts, T-shirts, polo shirts, golf shirts, jackets, headwear, namely caps, hats; all for promotional use relating to automotive vehicles (First Use: 11/1/1978)
	Reg No. 2190167 Issued: 9/22/1998 Incontestable 2 nd Renewal filed	Class 25: Clothing, namely, shirts, T-shirts, jackets, all for promotional use relating to automotive vehicles (First Use: 11/1/1978)
FORD MUSTANG	Reg No. 2194488 Issued: 10/13/1998 Incontestable 2 nd Renewal filed	Class 25: Clothing, namely, shirts, sweatshirts, T-shirts, polo shirts, golf shirts, jackets, headwear, namely, caps, hats, all for promotional use relating to automotive vehicles (First Use: 11/1/1978)

(See Exhibit A, TESS Records)

Clearly, Ford has established its strong rights in MUSTANG over the past 55+ years, and uses that mark extensively in connection with its Class 12 goods and a wide variety of additional goods.

In addition, Ford owns the following Allowed applications for MACH E and MACH-E:

TRADEMARK	Status	Goods/ Services
MACH E	App. No. 88205023 Filed 11/26/2018 Allowed 6/4/2019	Class 12: 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

MACH-E	App. No. 88205681 Filed 11/26/2018 Allowed 6/4/2019	Class 12: 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
--------	---	---

(See Exhibit B, Tess Records.)

Ford submits its mark MUSTANG MACH-E, which combines these clearly distinctive marks, creates a registrable and distinguishable mark entitled to registration on the Principal Registration, and should not be blocked by the subsequent cited marks.

2. Ford’s MUSTANG MACH-E Builds on Ford’s Iconic Brand

MUSTANG is one of the most iconic vehicle brands in the world. Ford has established a strong commercial impression and association of the MUSTANG mark with Ford, through its multiple registrations and its extensive use the marketplace. In August of 2018, Ford celebrated the landmark 10 Millionth MUSTANG vehicle produced in the United States. See Exhibit C for independent coverage of this Milestone for the iconic vehicle <https://www.roadandtrack.com/car-culture/a22685772/10-millionth-ford-mustang-celebration/> . Ford’s sales of MUSTANG branded vehicle exceed the 10 Million vehicles mark. Exhibit C contains additional coverage of the history of the MUSTANG vehicle, including <https://www.cnbc.com/2018/08/08/ford-has-made-10-million-mustangs-a-history-of-the-iconic-sports-car.html> . Applicant submits further evidence that the vehicles have received substantial recognition and awards within the industry and the marketplace as summarized by the attached article discussing the many Mustang Awards <https://www.cjponyparts.com/resources/mustang-awards-through-years> . There is no likelihood of confusion here between Ford’s MUSTANG MACH-E mark and the cited marks.

3. The Applicant's Mark is Distinguishable from the Cited Marks, and is Not Likely to Cause Confusion as to the Source or Origin of the Goods

The Examiner has cited three registrations against Ford's instant application for MUSTANG MACH-E, namely the following non-identical single word design marks for non-identical goods:



- a. - Mustang Motorcycle Products, LLC's registration No. 2162359 for "Motorcycles and structural parts therefor, namely saddles, saddle covers, motorcycle saddlebags" in Class 12. This registration issued 6/2/1998, and is now incontestable. The applicant claimed first use as of 11/10/1982. This registration has coexisted with Ford's MUSTANG registrations for over 21 years.



- b. -- Mustang Motorcycle Products, LLC's Registration No. 4649647 for "Motorcycles and structural parts therefor, namely saddles, saddle covers, motorcycle saddlebags" in Class 12. This registration issued 12/2/2014. The applicant claimed first use as of 10/20/2014. This mark has coexisted with Ford's MUSTANG registrations for close to five years.



- c. -- Mustang Motorcycle Products, LLC's Registration No. 4664224 for "Motorcycles and structural parts therefor, namely saddles, saddle covers, motorcycle saddlebags" in Class 12. This registration issued 12/30/2014. The applicant claimed first use as of 10/27/2014. This mark has coexisted with Ford's MUSTANG registrations for close to five years.

Ford's prior incontestable registration for automobiles and other Class 12 goods did **not** block these design mark registrations for the different goods. In fact, Ford's rights peacefully coexisted with the cited trademarks for decades without confusion or damage to the public.

In view of Ford's prior rights in MUSTANG, the distinctiveness of the MUSTANG MACH-E mark, and the differences between the designated goods, the public would not be

confused as to the source or origin of Ford's electric automotive vehicles, passenger automobiles, trucks, sport utility vehicles, off-road vehicles and structural parts, fittings, and badges therefor; metal license plate frames. Likewise, the cited registrant would not be able to successfully argue that MUSTANG MACH-E on the designated goods would be confused with their design marks for its motorcycle goods.

C. Conclusion

Ford submits that the mark MUSTANG MACH-E has a distinct commercial impression and strong association as a source indicator for Ford, and is entitled to registration under the Lanham Act. Ford has clear priority in its use of the MUSTANG portion of the mark, and both this mark and the designated goods are distinguishable from the cited marks. Ford believe this mark is in a form suitable for publication for registration on the Principal Register and respectfully requests such action.

Respectfully submitted,

FORD MOTOR COMPANY

By: /Sharon C. Sorkin/

Chief Trademark Counsel
Ford Global Technologies, LLC
330 Town Center Drive
Suite 800, Fairlane Plaza South
Dearborn, Michigan 48126
313-248-8466
tmdocket@ford.com