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*Decision Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Iron Horse Bicycle Company LLC

Serial No. 76621584

Myron Amer of Myron Amer, P.C. for Iron Horse Bicycle Company LLC.

Sani Philippe Khouri, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Iron Horse Bicycle Company LLC has filed an application to register on the Principal Register in standard character form the mark "MAVERICK" for, as originally filed, "bicycles" and, as currently amended, "bicycle structural parts, namely, bicycle frames, bicycle handlebars, bicycle rims and tire tubes" in International Class 12.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 76621584, filed on November 22, 2004, which alleges a date of first use anywhere and in commerce of January 1, 1994.

applicant's mark, when applied to its goods, so resembles the marks "MAVERICK SKATEBOARDS"² and "MAVERICK GIRLS,"³ which are registered, by the same registrant, on the Principal Register in standard character form for, in each instance, "skateboards; [and] skateboard accessories, namely, skateboard trucks, skateboard wheels and skateboard decks" in International Class 28, as to be likely to cause confusion, or to cause mistake, or to deceive. Registration has also been finally refused in light of Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c), on the basis that the identification of applicant's goods, as amended, is not within the scope of the identification of applicant's goods, as originally filed.

Applicant has appealed and briefs have been filed.⁴ We affirm the refusals to register.

² Reg. No. 2,894,587, issued on October 19, 2004, which sets forth a date of first use anywhere and in commerce of February 1995; the word "SKATEBOARDS" is disclaimed.

³ Reg. No. 2,907,697, issued on December 7, 2004, which sets forth a date of first use anywhere and in commerce of April 2001; the word "GIRLS" is disclaimed.

⁴ The Board, in an interlocutory order in which, *inter alia*, it "noted that the applicant and the Examining Attorney disagree about the acceptability of an amendment to the identification of goods proposed by applicant," pointed out as to any brief filed by the Examining Attorney with respect to the briefing of the issues herein that:

The Examining Attorney has stated, in two Office actions, that the prosecution of the application will continue with the original identification, but i[t] should be noted that the question of whether applicant's proposed amendment to the identification is one of the issues on appeal, and that, should this proposed amendment have any impact on other refusals or requirements, the Examining Attorney should address in his [or her] brief the other refusals/requirements based on both the original and the proposed identification.

However, notwithstanding that the Examining Attorney has briefed the likelihood of confusion refusal solely with respect to the original

Because of its obvious bearing on the issue of likelihood of confusion, we turn first to the refusal on the basis that the amended identification of applicant's goods exceeds the scope of the goods as originally identified. Applicant, relying upon a declaration which it has made of record from its vice president, Stewart Barnett, asserts in its supplemental appeal brief that it "has established that, in accordance with trade practice, the amended goods are within the scope of bicycles, and the Examining Attorney has not controverted this." Mr. Barnett's declaration provides, in particular, that "in the retail trade in which applicant's ... products are sold, it is the custom ... to sell not only a completely assembled product, namely, a bicycle, but also the product's components, such as a bicycle frame, ... bicycle handle bars, a bicycle wheel rim and tire tubes"; that "the reason for providing the components noted is that during use of the bicycle, a component typically is damaged, and good customer relations requires making available for purchase a replacement for the damaged component" because "[o]therwise, the customer has the significant expense of replacing the entire bicycle"; that "[t]he trade practice noted is well known both to retailers and retailers' customers, and it would not be considered that a bicycle structural part is not within the scope of the business

identification of applicant's goods instead of also briefing such issue with respect to the amended identification thereof, we will not treat such failure as a waiver of the likelihood of confusion refusal with respect to the amended identification of goods inasmuch as we would reach the same result even if the amended identification were considered the governing identification rather than the original one.

of selling a fully assembled bicycle"; and that, "[i]n fact, if structural parts were not part of the product line of a retailer selling a bicycle, it would adversely effect [sic] the retailer's business."

We concur with the Examining Attorney, however, that the amended identification of applicant's goods exceeds the scope of the goods as set forth in the application as originally filed. In this regard, the Examining Attorney explains that:

Trademark Act §7(c), 15 U.S.C. §1057(c), provides that the filing of an application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration. Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for [registration on] the Principal Register. For that reason, the applicant may not expand those rights through amendment of the identification of goods and services.

In this case, the appellant has proposed to amend the identification of goods from an acceptable, definite listing, "bicycles," to completely different goods, namely, "bicycle structural parts, namely, bicycle frames, bicycle handle bars, bicycle rims and tire tubes." Although these are structural parts of bicycles, the [goods] are not the bicycles themselves and therefore go beyond the scope of the original identification. A bicycle tire tube may be a structural part of a bicycle but it is not a bicycle. Appellant's proposal is akin to a proposed amendment from "automobiles" to "automobile bumpers." Bumpers may be structural parts of automobiles, but they are far different goods from automobiles themselves.

While we fully realize, as stated by Mr. Barnett in his declaration, that "it would not be considered that a bicycle structural part is not within the scope of the **business** of

selling a fully assembled bicycle" and that, "[i]n fact, if structural parts were not part of the product line of a retailer selling a bicycle, it would adversely effect [sic] the retailer's **business**" (emphasis added), the issue herein is whether "bicycle structural parts, namely, bicycle frames, bicycle handlebars, bicycle rims and tire tubes" are a kind or type of "bicycles" and therefore are within the scope of the original identification of applicant's goods. Clearly, unlike, for instance, hybrid bicycles, road bicycles and touring bicycles, which are different categories of bicycles, any bicycle structural parts, whether such be bicycle frames, bicycle handlebars, bicycle rims, and/or bicycle tire tubes, simply are not bicycles and thus are not encompassed by an identification of goods which is limited to the term "bicycles." In view thereof, applicant's amendment of its application from "bicycles" to "bicycle structural parts, namely, bicycle frames, bicycle handlebars, bicycle rims and tire tubes" is improper as beyond the scope of the original identification of goods and the refusal on the basis of Section 7(c) of the Trademark Act is well taken.

However, irrespective of whether applicant (on further appeal) ultimately prevails on the refusal under Section 7(c), such that it would be the amended identification of applicant's goods which is controlling for purposes of whether there is a likelihood of confusion rather than the original identification thereof, we now turn to the refusal under Section 2(d) in order to render a more complete opinion. In this regard, we note that our determination under Section 2(d) is based on an analysis of

all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Nonetheless, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁵ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Turning first to the similarity or dissimilarity in the goods at issue, the Examining Attorney notes that "[i]n order to support his contention that the goods [herein] are similar, the Examining Attorney submitted evidence of third[-]party U.S. registrations of marks [to be] used in connection with the same or similar goods ... as those of appellant and registrant in this case." In particular, the record contains copies of seven use-based third-party registrations for marks which are variously registered for "bicycles," including "racing bikes, mountain bikes, [and] trekking bikes," on the one hand, and "skateboards" or "skate boards," on the other. Four of such registrations additionally list various bicycle structural parts, specifically:

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

"bicycle's steel rims"; "accessories for ... bicycles, ..., namely, ... handle bars"; "bicycle wheels"; and "bicycle parts, components and accessories, namely frames, forks, seat posts, handlebars, ... frames, and wheels," respectively. Although it is the case that such registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, the Examining Attorney is nonetheless correct that the registrations have some probative value to the extent that they serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. Nov. 14, 1988).⁶

As additional support for his position, the Examining Attorney points out that:

In the Office action of March 14, 2006, the ... Examining Attorney submitted copies of Internet websites of businesses which specifically featured both bicycles and skateboards. These businesses were identified by names such as "Mama's

⁶ We observe that the Examining Attorney has also made of record two use-based, third-party registrations for marks for services which include the retail sale of both bicycles and skateboards. Such registrations cover "retail store services for the sale of goods, namely, bicycles, namely, mountain bikes, juvenile bikes, BMX bikes, road bikes, hybrid bikes, comfort bikes ... ; skateboards, namely, skateboards, [and] skateboards with handlebars" and "retail store [services] featuring skateboards, ... bicycles as well as ... accessories related to these products." However, because third-party registrations are not evidence of use, such evidence does not suffice to show that the listed goods are indeed sold in the same retail store channels of trade and thus will not be considered further.

boardnbike.com, Momentum Bikes & Boards, Shaka Bikes and Boards, Bikes-N-Boards, and Bikes'n'Boards of Humble." These examples establish a complementary relationship between bicycles and skateboards. For instance, in the website for bikepartsforsale.com, it states: "We have been in business for nearly 18 years selling new and used bikes, skateboards, as well as a large selection of parts and accessories." In the website for Momentum Bikes & Boards, it states that they are "Southwest Wisconsin's Leader in bicycle and skateboard equipment, service, advocacy, information and education." In the Website for J & P Bike Shop there is a heading identified as "Bikes & Boards" under which is a listing of its products for sale.

The Examining Attorney accurately maintains that applicant "has submitted no evidence to controvert the ... Examining Attorney's findings" as to the similarity or relatedness of applicant's and the cited registrant's goods.

Applicant, stressing that the Examining Attorney "erroneously refers to applicant's goods in issue as 'bicycles' when [the identification of] applicant's goods by amendment is 'bicycle structural parts, namely, bicycle frames, bicycle handle bars, bicycle rims and tire tubes,'" asserts as its sole argument in its initial appeal brief with respect thereto that the Examining Attorney "has not established that the amended goods of the applicant travel in the same channels of trade as the goods of the [cited registrant]" (underlining in original) and thus that the respective goods have not been shown to be similar or otherwise related. However, as indicated previously, in view of our affirmance of the refusal under Section 7(c), it is presently the original identification of applicant's goods, namely, bicycles, which must be considered controlling for purposes of

the issue of likelihood of confusion, although we would reach the same result even if the amended identification of goods governed such refusal. In any event, it is well established that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Contrary to applicant's assertion, the record contains sufficient evidence to establish that "bicycles," as well as "bicycle structural parts, namely, bicycle frames, bicycle handlebars, bicycle rims and tire tubes," are closely related to "skateboards; [and] skateboard accessories, namely, skateboard trucks, skateboard wheels and skateboard decks." As noted previously, four of the use-based third-party registrations list various bicycle structural parts, such as bicycle steel rims, wheels, frames, forks, seat posts and handlebars, in addition to both bicycles and skateboards.

Furthermore, the website excerpts of record confirm that at least certain retailers of both bicycles and skateboards also offer structural parts and/or accessories for such products.

For instance, a printout from "Moma's boardnbike.com. shows a dropdown menu listing "Frame and forks" for bicycles along with "Skateboard stuff," while a printout from "PAUL'S BICYCLE SHOP INC." states, at the website "bikepartsforsale.com," that such shop has "been in business for nearly 18 years selling new and used bikes, skateboards, as well as a large selection of parts and accessories." Similarly, a printout from "BikeMania.biz" includes among the product categories listed such items as bicycle "Forks," Frames," "Handlebars," "Rims" and "Wheels" in addition to the availability of "Bicycles" and "Skateboards," while a printout from "MOMENTUM BIKES & BOARDS" proclaims that such firm is "Southwest Wisconsin's Leader in bicycle and skateboard equipment." In the same vein, a printout from "SHAKA BIKES AND BOARDS" advertises the availability of "Bikes & Accessories" as well as skate "Boards & Accessories," while the printout for "Bikes 'n' Boards of Humble" lists, *inter alia*, "Accessories" under the product heading "Bicycles" and sets forth "Decks, Wheels, Trucks, and Risers" under the product category "Skateboards."

Finally, if there could be any doubt that dealers of both bicycles and skateboards also typically offer bicycle structural parts, the declaration furnished by applicant's vice president puts such doubt to rest. Specifically, as indicated previously, Mr. Barnett states among other things that "in the retail trade in which applicant's ... products are sold, it is the custom ... to sell not only a completely assembled product, namely, a bicycle, but also the product's components, such as a

bicycle frame, ... bicycle handle bars, a bicycle wheel rim and tire tubes"; that such a "trade practice ... is well known both to retailers and retailers' customers, and it would not be considered that a bicycle structural part is not within the scope of the business of selling a fully assembled bicycle"; and that, "[i]n fact, if structural parts were not part of the product line of a retailer selling a bicycle, it would adversely effect [sic] the retailer's business." Accordingly, the record is sufficient to establish that retailers of such recreational equipment as bicycles and skateboards generally would also be expected by consumers to sell bicycle structural parts, including bicycle frames, bicycle handlebars, bicycle rims and tire tubes. We conclude, therefore, that irrespective of whether applicant's goods are regarded as bicycles, as set forth in the original identification of its goods, or are considered to be bicycle structural parts, as set forth in the amended identification of its goods, in either instance applicant's goods are closely related in a commercial sense to the registrant's skateboards and skateboard accessories, namely, trucks, wheels and decks, and that the *du Pont* factor as to the similarity or dissimilarity of the respective goods favors a finding of a likelihood of confusion.

Turning now to the *du Pont* factor concerning the similarity or dissimilarity of the respective marks in their entirety, applicant argues in its initial brief that such marks are distinguishable because the registrant's marks, rather than being dominated by the word "MAVERICK" as contended by the

Examining Attorney, additionally contain the words "SKATEBOARDS" and "GIRLS," respectively. According to applicant, "the disclaimer [in the cited registrations] of GIRLS and SKATEBOARDS is not known to the public and, in legal effect[,], the disclaimers circumscribe the scope of ... [such] registrations, and not the reverse as contended by the Examining Attorney." Applicant urges that when applicant's "MAVERICK" mark and the registrant's "MAVERICK SKATEBOARDS" and "MAVERICK GIRLS" marks "are compared ... with each other[, there] are significant dissimilarities in appearance, pronunciations and connotation [so as] to obviate any likelihood of confusion."

We agree with the Examining Attorney, however, that the marks at issue, when considered in their entirety, are so substantially similar that confusion as to the source or sponsorship of the respective goods is likely to occur. Although applicant is correct that differences are apparent from a side-by-side comparison of the respective marks,⁷ it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, our principal reviewing court has indicated that "there is nothing improper in stating

⁷ Such a comparison, of course, is not the proper test to be used in determining the issue of likelihood of confusion since it is not the ordinary way that consumers will be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks. See, e.g., *In re United Service Distributors, Inc.*, 229 USPQ 237, 239 (TTAB 1986); and *In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983).

that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "[t]hat a particular feature is descriptive or generic with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark" and that, "[i]ndeed, this type of analysis appears to be unavoidable." 224 USPQ at 751. See also In re Dixie Restaurants Inc., supra.

While there is no doubt that consumers, as asserted by applicant, are unaware that the terms "SKATEBOARDS" and "GIRLS" have been disclaimed in the cited registrations, consumers are undeniably aware that such terms, when used in connection with skateboards and skateboard accessories, namely, skateboard trucks, skateboard wheels and skateboard decks, are generic in the case of the term "SKATEBOARDS" and merely descriptive in the case of the term "GIRLS." Because, in view thereof, such terms respectively have no or little source indicative significance, the dominant and distinguishing portion of registrant's "MAVERICK SKATEBOARDS" and "MAVERICK GIRLS" marks, as contended by the Examining Attorney, is the word "MAVERICK," which is identical in all respects to applicant's "MAVERICK" mark. Overall, applicant's mark and registrant's marks are substantially similar in sound, appearance and connotation, and project substantially similar commercial impressions. The *du Pont* factor as to the

similarity or dissimilarity of the respective marks in their entireties thus favors a finding of a likelihood of confusion.

Accordingly, weighing all the relevant *du Pont* factors, we conclude that consumers who are familiar or otherwise acquainted with registrant's "MAVERICK SKATEBOARDS" and "MAVERICK GIRLS" marks for, in each instance, "skateboards; [and] skateboard accessories, namely, skateboard trucks, skateboard wheels and skateboard decks" would be likely to believe, upon encountering applicant's substantially similar "MAVERICK" mark for either "bicycles" or "bicycle structural parts, namely, bicycle frames, bicycle handlebars, bicycle rims and tire tubes," that such commercially related goods emanate from, or are sponsored by or affiliated with, the same source. Consumers, for example, could readily regard the bicycles or the bicycle structural parts sold by applicant under its "MAVERICK" mark as a new line of products from the same source as the skateboards and skateboard accessories marketed by registrant under its "MAVERICK SKATEBOARDS" and "MAVERICK GIRLS" marks.

Decision: The refusals under Section 7(c) and 2(d) are affirmed.