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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ace Rip Industries Incorporated

Serial No. 78427817

Alina S. Morris of Knobbe, Martens, Olson & Bear, LLP for
Ace Rip Industries Incorporated.

Raul Cordova, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Rogers, Drost, and Zervas, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 1, 2004, applicant, Ace Rip Industries
Incorporated, filed an intent-to-use application to
register the mark GRIP ACE in standard character form for
goods ultimately identified as "automated grips for
motorcycles and mopeds" in Class 12. Serial No. 78427817.
Applicant has disclaimed the term "grip."

The examining attorney has refused to register
applicant's mark under Section 2(d) of the Trademark Act
(15 U.S.C. § 1052(d)) because of two registrations owned by

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one party. The first (No. 2948141 issued May 10, 2005) is for the mark ACE in typed or standard character form for:

motorcycle engine parts, namely, pistons, rods, bearings, bushings, crankshafts, crankcases, cowlings, valves, cam shafts, pumps, alternators, generators, ignition magnetos, mufflers, exhaust pipes, drive belts and carburetors (Class 7)

motorcycles, motorcycle engines and parts for motorcycles, namely, transmissions, structural parts, shock absorbers and suspension parts, windshields¹ seats, mirrors (Class 12).

The second (No. 2929085 issued March 1, 2005) is for the mark shown below:



for:

Motorcycles and structural parts therefor (Class 12)

Jewelry, namely, bracelets, necklaces, ankle bracelets, tie tacks, cuff links and watch bands (Class 14).

The examining attorney argues that in "the three marks, the dominant element, ACE, is ... identical." Brief at unnumbered p. 3. The examining attorney also argues that the "the fact that the goods of the parties differ is

¹ It is not clear if this is a typographical error and the apostrophe should instead be a comma.

not controlling in determining likelihood of confusion." Brief at 6.

Applicant argues that "'ACE' is a frequently chosen term for brand names and businesses in order to be listed higher in alphabetical business directories" (Brief at 5) and that the marks "differ in appearance and meaning." Brief at 6. Applicant also argues that the "fact that the goods are all used on motorcycle parts is not enough to indicate a likelihood of confusion." Brief at 7.

When the examining attorney made the refusal final, this appeal followed.

In cases involving a likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by comparing the similarities and dissimilarities of the marks. "The first *DuPont* factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567).

Applicant's mark is for the words GRIP ACE. Registrant's marks are for the word ACE in standard character form and with an eagle design. The only difference between the wording in the marks is the fact that applicant has taken registrant's entire ACE mark and added the word GRIP to it. Inasmuch as the applicant's goods are "grips," it is unlikely that prospective purchasers will place much significance on this term. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to ALE, the Board noted that the term is generic and that the registrant disclaimed it in its registration. Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under *DuPont*. As a generic term, ALE simply delineates a class of goods"). *See also Cunningham v.*

Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'").

While applicant argues that "Ace" is a frequently chosen brand and business name, it has not introduced any evidence on this point. In addition, applicant argues that the term ACE is laudatory, and the examining attorney acknowledges that the term has some laudatory significance to the extent that it means "top-notch; first rate" (Brief at 4). Again, there is no evidence that the registered marks are weak and entitled to only a very narrow scope of protection.

While the addition of the word "GRIP" is a difference between the marks, nonetheless the dominant part of the marks ACE is identical. When prospective purchasers encounter the marks ACE and GRIP ACE, the identical nature of the common terms results in marks that are similar despite the presence of the generic term "grip" in applicant's mark. Many customers who are familiar with registrant's ACE mark for various motorcycle parts are likely to simply assume that GRIP ACE is another motorcycle

part from the same source. The similarities in sound, appearance, meaning, and commercial impression between applicant's and registrant's marks outweigh the difference created by adding the word "GRIP."

Even the addition of the eagle design does not necessarily create marks that are dissimilar. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there was a likelihood of confusion). Purchasers are likely to rely on the word portion of the mark to order and refer to the goods. *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1376 (TTAB 1999) ("Likewise, it is the word CONTINENTAL, rather than the disclaimed globe design or the stylized letter 'C', which dominates registrant's mark, inasmuch as it is the spoken portion of the mark, which would be used by purchasers to call for the services"). When we compare registrant's ACE and eagle design mark with applicant's GRIP ACE mark, the word ACE remains a prominent feature of the mark. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("Moreover, in a composite mark comprising a design and words, the verbal portion of the

mark is the one most likely to indicate the origin of the goods to which it is affixed").

Next, we look at whether the goods of applicant and registrant are related. Applicant's goods are automated grips for motorcycles and mopeds. Applicant's evidence describes its goods as follows:

Grip Ace™ is a revolutionary new motorcycle grip with build-in buttons right under your fingertips and an electronic module which allow the rider to activate turn signals, headlights and accessories. Functions include: Self-cancelling Turn-signals, High-beam/Low-beam and Hazard lights, as well as turning on and off accessories, like radio, fog lights, etc.

www.gripace.com (parenthetical and emphasis omitted).

Applicant's goods are designed to interact with other components of a motorcycle such as the lights, turn signals, and accessories such as radios. "It can control nearly any electrical item." GizMag Article. Also, there is no limitation in registrant's or applicant's identified goods. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). In addition, we do not read limitations into an applicant's or registrant's identification of goods. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and

nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Some items such as mirrors are not necessarily inherently expensive. We must assume that automated grips for motorcycles and mopeds would include all types of automated grips including those that have fewer features and that are less expensive than applicant's. Therefore, we do not have to limit our consideration to grips that are priced similarly to applicant's (\$269 or more).

Our case law has recognized that various parts for vehicles may be related even if the goods themselves are different. "It has frequently been found that the marketing by different parties of different types of vehicular parts under the same or similar marks is likely to cause confusion." *In re Jeep Corp.*, 222 USPQ 333, 334 (TTAB 1984) (LAREDO for land vehicles and structural parts confusingly similar to LAREDO for pneumatic tires):

AP Parts Corp. v. Automotive Products Associated, 156 USPQ 254 (TTAB 1967) ["AP" for clutches, brakes, steering joints, tie-rod joints, and suspension joints for land vehicles, aircraft, or watercraft versus "AP" for mufflers for explosive engines]; *Seiberling Rubber Co. v. General Battery and Ceramic Corp.*, 167 USPQ 766 (TTAB 1964) ["HOLIDAY" for storage batteries versus "HOLIDAY" for pneumatic rubber tires and automobile floor mats-- opposer's motion for summary judgment

granted for the reason that "[I]t appears beyond question that the simultaneous use of the identical mark upon goods which are so closely related in their use as those of the parties would clearly cause the average purchaser to assume that they emanated from the same source"]; *In re Market Tire Co. of Maryland, Inc.*, 171 USPQ 636 (TTAB 1971) ["ADMIRAL" for vehicle tires versus "ADMIRAL" for radiator anti-freeze]; *In re Magic Muffler Service, Inc.*, 184 USPQ 125 (TTAB 1974) ["MAGIC" for vehicle parts, namely, mufflers, versus "MAGIC" for motors for motor vehicles]; *In re Trelleborgs Gummifabriks Aktiebolag*, 189 USPQ 106 (TTAB 1975) ["T" and design for, inter alia, hoses, namely, rubber hoses and rubber inner tubes for tires; and pneumatic semisolid and solid tires versus "T" and design for, inter alia, motor oil, oil additives, and fuel additives]; *In re Red Diamond Battery Co.*, 203 USPQ 472 (TTAB 1979) ["RED DIAMOND" for storage batteries versus "DIAMOND" for pneumatic rubber automobile and vehicle tires]; and *In re Delbar Products, Inc.*, 217 USPQ 859 (TTAB 1981) ["ULTRA" for outside mounted vehicle mirrors versus "ULTRA" and design for automobile parts, namely, pistons and pins, valves, water pumps, oil pumps, universal joints, gears, axle shafts, hydraulic brake parts, automatic transmission repair kits and parts, engine bearings, and jacks].

Here, purchasers who are modifying their motorcycles by adding applicant's automated grips could also be installing registrant's mirrors or structural parts on the same bikes. These purchasers could encounter both applicant's and registrant's goods in stores that carry motorcycle parts for those who choose to maintain their own bikes. Both the purchasers and channels of trade would overlap.

In addition, applicant argues (Brief at 8) that motorcycle "parts, accessories, and after-market additions

in particular would also be carefully purchased in order to maintain the safety of the motorcycle and comply with local laws." There is little evidence in the record that would support this assertion other than applicant's patent, its website printout, and a magazine article. The website and the article, which would be the information most likely read by purchasers, appear to be directed toward the average purchasers. While purchases of several hundred dollars are likely to be made with some care, "even careful purchasers are not immune from source confusion." *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). These purchasers, even if careful, are likely to assume that the sources of ACE and ACE and eagle design and GRIP ACE for the identified motorcycle parts are related or associated in some way.

Decision: The examining attorney's refusal to register applicant's mark GRIP ACE on the ground that it is likely to cause confusion with the cited registered marks used in connection with the identified goods under Section 2(d) of the Trademark Act is affirmed.