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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Polaris Industries

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Serial No. 78652190

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Before Hairston, Holtzman and Mermelstein, Administrative  
Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Polaris Industries  
(applicant) to register the mark BLACKHAWK (in standard character  
format) for "all terrain vehicles and structural parts therefor"  
in Class 12.<sup>1</sup>

The trademark examining attorney has refused registration

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<sup>1</sup> Application Serial No. 78652190, filed June 16, 2005, based on an  
allegation of a bona fide intent to use the mark in commerce.

Serial No. 78652190

under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the registered mark shown below for "motor vehicle accessories, namely, shock absorbers" in Class 12 as to be likely to cause confusion.<sup>2</sup>



When the refusal was made final, applicant appealed. Briefs have been filed.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the

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<sup>2</sup> Registration No. 2995279; issued September 13, 2005. The registration includes a statement that "The mark consists of stylized words "BLACK HAWK" in which the word "HAWK" is printed over a stylized hawk's head profile, and the stylized feathers of the hawk's head profile extend over the word "BLACK."

The examining attorney also initially cited Registration No. 2931254 for BLACKHAWK MOTOR WORKS, INC. (and design) and referenced as a potential cite application Serial No. 78605811 for BLACKHAWK MOTOR WORKS," both for "manufacture of custom motorcycles to the order and specification of others." The cite and the reference were subsequently withdrawn.

Serial No. 78652190

goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the marks. Applicant argues that the two marks are "quite distinctive" in that registrant's mark is in plain text and applicant's mark includes a design consisting of a hawk's head profile and stylized feathers. Applicant further argues that registrant actually uses its mark with the company name BILSTEIN as shown in registrant's product literature.

In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *du Pont*, supra. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In addition, we must determine the question of whether the marks are similar or dissimilar based on the mark as it appears in the registration, and registrant's company name BILSTEIN is not part of the registered mark and will not be considered in the analysis.

Applicant's mark BLACKHAWK and registrant's mark BLACK HAWK and design are identical in sound. The two marks are also identical in meaning and commercial impression. There are certain visual differences in the marks. Registrant's mark includes the design of a hawk head and "stylized feathers" and

Serial No. 78652190

applicant's mark omits the space between the two words. However, these differences are insignificant when compared with the similarities in the marks, and they are insufficient to distinguish one mark from the other. The strongest impression of the marks is conveyed by the wording, and the wording in the marks is identical. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987) ("if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods"). Furthermore, the image of a hawk's head, in registrant's mark, to the extent that it would even be recognized as such considering its highly stylized form, simply serves to reinforce the image conveyed by the wording "BLACK HAWK."

Applicant argues that the terms HAWK and BLACK HAWK are used and registered by a number of different entities for various forms of transportation and related parts and accessories, and that as a result, according to applicant, the cited mark is weak and entitled only to a narrow scope of protection in the field. To support this position, applicant has submitted a number of third-party registrations that include the term HAWK, several registrations that consist entirely of stylized bird designs, and four registrations, including the cited registration, for marks consisting of or including "BLACK HAWK," all of which are for goods in the transportation field. The three registrations of

Serial No. 78652190

"BLACK HAWK" are BLACKHAWK and design for trailers (Registration No. 2951805); BLACKHAWK for power boats (Registration No. 1437219); and BLACK HAWK for military helicopters (Registration No. 0995600). In arguing that the third-party registrations for "HAWK" other than "BLACK HAWK" are relevant, applicant reasons that the term "HAWK" is the most dominant part of the mark in creating the commercial impression; and that the word "BLACK" is not significant because it merely describes the color of the hawk.

It is well settled that third-party registrations are not evidence of the use of the marks therein. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). They may, however, be used to indicate that a commonly registered term has a suggestive meaning for particular goods or services such that differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). Considering the third-party registrations for that purpose, we first point out that applicant in its analysis has improperly dissected the mark in the cited registration. Although there is nothing in the record to indicate that "black hawk" is a type of bird, and not just a hawk that is black in color, we view the term as a unitary phrase and

Serial No. 78652190

to that extent, the commercial impression of BLACK HAWK as shown in the cited registration is conveyed by the phrase as a whole, not by the individual words. Further, we do not view the third-party marks consisting of stylized bird designs as the equivalent of the word "hawk," or for that matter "black hawk," and those marks are not relevant to the question of whether the wording BLACK HAWK is suggestive. We find that the term "BLACK HAWK" has, at most, a somewhat suggestive meaning in relation to the goods. A hawk is a "bird of prey"<sup>3</sup> and to that extent the term may vaguely suggest the strength or power of vehicles and vehicle parts. In any event, the protection to be accorded the cited registration would still extend to prevent the registration of applicant's highly similar mark for related goods.

Thus, we turn to the goods. Applicant argues that its all terrain vehicles are "significantly dissimilar" and unrelated to registrant's motor vehicle accessories, namely shock absorbers; that registrant uses its mark exclusively on shock absorbers for cars and trucks, and in particular racing cars and trucks; and that applicant's vehicles are intended for off-road recreational purposes whereas registrant's goods are intended for use primarily on racing cars and trucks. Applicant also contends

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<sup>3</sup> *Microsoft Encarta College Dictionary* (2001). The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Serial No. 78652190

that the goods are not sold through the same trade channels to the same consumers. According to applicant, registrant only offers its products "in the automobile industry through select distributors" and applicant's all terrain vehicles and structural parts, would only be sold through exclusive dealerships.

Applicant further contends that the goods are not directed to the same purchasers. As described by applicant, its all terrain vehicles are targeted to individuals seeking a nonstrenuous recreational outdoor experience whereas registrant's shock absorbers are targeted to race car and race truck drivers "looking to upgrade the speed and suspension of their vehicles." In support of its arguments, applicant has submitted a printout of a page from its website (*polarisindustries.com*) and copies of registrant's product literature.

Applicant's goods are "all terrain vehicles and structural parts therefor" (ATVs) and registrant's goods are "motor vehicle accessories, namely, shock absorbers." The goods are obviously different in kind. However, the cases are legion that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that

Serial No. 78652190

could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

The respective goods are closely related. Shock absorbers are integral parts or components of motor vehicles, and the category of "motor vehicles" in registrant's identification would include all terrain vehicles. Applicant itself is seeking registration for vehicle parts as well as the vehicle. We also note that the Board in the past has held vehicles and vehicle replacement parts to be commercially related products. See, e.g., *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992) and cases cited therein. The examining attorney has submitted printouts of pages from third-party websites showing that ATVs in fact use shock absorbers. See, for example, *polarisdiscountparts.com*;<sup>4</sup> *zilmachinery.en.alibaba.com*; *off-road.com*; and *atving.com*.

Applicant, by attempting to limit the market for the goods, the purchasers and intended use of the goods, and the channels of trade for the goods, has read impermissible limitations into the application and registration. Our primary reviewing court has repeatedly stated that the question of likelihood of confusion

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<sup>4</sup> Applicant's website is *polarisindustries.com*. It is not clear whether there is any connection between applicant and the website *polarisdiscountparts.com*.

Serial No. 78652190

must be determined on the basis of the identification of goods set forth in the application and registration, rather than on what any extrinsic evidence might show the actual use of the goods or their channels of trade or purchasers to be. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Absent any limitation in the respective identifications of goods we must presume that the goods are used for all the intended purposes, and that they are sold in all the normal channels of trade to all the usual customers. There is nothing in the registration that restricts the shock absorbers to a particular type of motor vehicle. Therefore, we must presume that registrant's shock absorbers are compatible with all types of motor vehicles, including applicant's all terrain vehicles. Furthermore, the examining attorney submitted printouts of additional pages from applicant's website showing that applicant's all terrain vehicles are not only used for off-road "recreational" purposes but are also used as racing vehicles, as well. In addition, registrant's product literature indicates that registrant produces shock absorbers that are designed for off-road racing vehicles, as well as cars and trucks.

Serial No. 78652190

As to the channels of trade, it is true that ATVs would be sold through vehicle dealerships. However, while registrant's own shock absorbers may only be sold through distributors, the evidence shows that distributors are not the only normal channels of trade for such goods. The Internet evidence submitted by the examining attorney shows that vehicle parts suppliers, such as *polarisdiscountparts.com*, *off-road.com*, *elkasuspension.com* and *pao-jih.com*, sell shock absorbers for ATVs, for replacement or upgrading current parts, directly to the public. In fact, *polarisdiscountparts.com* sells shock absorbers specifically for use with applicant's all terrain vehicles. The examining attorney has also submitted a third-party registration for online retail sales of "parts and repair equipment" for vehicles, including all terrain vehicles. We also note that while ATVs and shock absorbers are not purchased at the same outlets, some of the Internet printouts submitted by the examining attorney show that ATVs are advertised and displayed together on the same websites. See, e.g., *elkasuspension.com* and *polarisdiscountparts.com*.

Thus, the fact that applicant's and registrant's goods may not be purchased through the same channels of trade is not particularly significant since both goods would ultimately reach the same consumers. Those consumers who had previously purchased applicant's BLACKHAWK ATVs, upon encountering registrant's shock

Serial No. 78652190

absorbers, as a replacement part or upgrade for the ATV, under the highly similar mark BLACK HAWK and design, regardless of where they purchased the ATV, are likely to believe that the respective goods come from or are in some way connected with the same company.

Applicant argues that the Office has "consistently allowed the coexistence of identical and similar marks for various different vehicle types and related accessories when owned by different entitles." Applicant has submitted a number of third-party registrations in the transportation-related field for the "BLACK HAWK" marks mentioned earlier as well as for numerous marks which may be arguably similar to each other, but not to the marks herein.

The coexistence of marks on the register which are completely dissimilar to the marks in this case have no bearing on the question of whether the marks and goods herein are likely to cause confusion. Further, to the extent that applicant is arguing that in view of the coexistence of other "BLACK HAWK" marks on the register, applicant's mark should be entitled to register as well, this argument is not persuasive. The Board has often noted that each application must be decided on its own merits. We are not privy to the records of the third-party registration files and, moreover, the determination of registrability of those particular marks by the examining

Serial No. 78652190

attorneys cannot control our decision in the case now before us. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court."). We would also point out that the mere coexistence of any of these third-party marks on the register, including the third-party "BLACK HAWK" marks, does not prove that such marks coexist without confusion in the marketplace.

It is reasonable to assume that the purchasers of all terrain vehicles and the parts for those vehicles would to some extent be knowledgeable about such products and would exercise some degree of care in their purchasing decisions. However, even knowledgeable and careful purchasers of goods can be confused as to source under circumstances where, as here, highly similar marks are used on closely related goods. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible.").

In view of the foregoing, and because highly similar marks are used in connection with closely related goods, we find that confusion is likely.

Serial No. 78652190

**Decision:** The refusal to register on the ground of Section 2(d) of the Trademark Act is affirmed.