

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: February 19, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re XCaliber, LLC

Serial No. 78742284

Douglas J. McEvoy of Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski for XCaliber, LLC.

Tina L. Snapp, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Quinn, Walters and Kuhlke, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

XCaliber, LLC has filed an application to register the
standard character mark XCALIBER on the Principal Register
for "automotive tires and wheels," in International Class
12, and "wholesale distributorships and retail store
services for tires and wheels," in International Class 35.¹

The examining attorney has issued a final refusal to
register under Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Serial No. 78742284, filed October 28, 2005, based on an allegation of
a bona fide intention to use the mark in commerce.

Serial No. 78742284

1052(d), on the ground that applicant's mark so resembles the previously registered marks shown below, and owned by the same registrant, that, if used on or in connection with applicant's goods and services, it would be likely to cause confusion or mistake or to deceive.

Registration No. 0596332 [registered October 5, 1954; renewed for a period of ten years from October 5, 2004; Section 15 affidavit acknowledged]

Mark: **EXCALIBUR**

Goods: "automobiles," in International Class 12

Owner: Camelot Classic Cars Inc.

Registration No. 1300467 [registered October 16, 1984; renewed for a period of ten years from October 16, 2004; Section 15 affidavit acknowledged]

Mark:



Goods: "automobiles," in International Class 12

Owner: Camelot Classic Cars Inc.

Registration No. 1514523 [registered November 29, 1988; Sections 8 and 15 affidavits accepted and acknowledged, respectively]

Mark:

Excalibur

Goods: "automobiles," in International Class 12

Owner: Camelot Classic Cars Inc.

The appeal is fully briefed. After careful consideration of the evidence and arguments of record, we affirm the refusal to register.

As a preliminary matter, applicant submitted new evidence with its appeal brief and the examining attorney has objected thereto. Applicant did not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal or with a request for reconsideration filed during the period for filing an appeal. See, 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). We sustain the objection and will not further consider the exhibits attached to applicant's brief.

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. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by

Section 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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re*

Serial No. 78742284

National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Considering, first, the registered marks, the mark in Registration No. 0596332 consists solely of the word, in standard character form, EXCALIBUR. The mark in Registration No. 1514523 consists of the word EXCALIBUR in a slightly stylized script that is of little significance in determining the overall commercial impression of the mark. Clearly, the word EXCALIBUR is the dominant portion of this mark. Moreover, applicant seeks to register its mark in standard character format and, thus, applicant could conceivably display its mark in any lettering style, including that of the word EXCALIBUR in the registered mark. 37 C.F.R. § 2.52(a); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (when registering mark in block letters, now characterized as standard character form, registrant remains free to change the display of its mark at any time).

The design mark in Registration No. 1300467 consists of a drawing of a sword in a double oval border. The oval border contains the word EXCALIBUR repeated twice in an undistinguished font style. We take judicial notice of the definition submitted with the examining attorney's brief from the *American Heritage Dictionary of the English Language*, 4th ed. 2000 (downloaded from Bartleby.com), of

"Excalibur" as "in Arthurian legend, the sword belonging to King Arthur." We find that the sword design simply reinforces the dominant wording, EXCALIBUR, in this mark. Moreover, it is the wording EXCALIBUR that would be used by purchasers asking for registrant's goods. Thus, the wording would make a greater impression on purchasers and is the portion that is more likely to be remembered as the dominant and source-signifying portion of the registered mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ("words are normally accorded greater weight because they would be used by purchasers to request the goods"). See also, e.g., *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (1987).

We find that applicant's mark, XCALIBER, is substantially similar in sound and appearance to the registered marks. While there is no correct pronunciation for trademarks, *In re Teradata Corporation*, 223 USPQ 361, 362 (TTAB 1984), the "X" portion of applicant's mark and the "EX" portion of the registered marks are likely to be pronounced exactly the same, as are the "ER" and "UR" endings of the respective marks. Thus, the marks are likely to sound the same. Further, these minor differences in spelling do not distinguish the marks visually. Applicant's mark is virtually identical to the registered word marks and to the dominant portion of the registered design mark. There is also no indication in the record that the

connotations of the respective marks would not be the same. Further, we find that the overall commercial impressions of the marks are substantially similar. We do not find applicant's arguments to the contrary persuasive.

Additionally, in view of the definition of "Excalibur," we find this to be an arbitrary mark in connection with both applicant's and registrant's identified goods and services. In the absence of evidence of any third-party use or registration of this mark in connection with the identified goods, it would appear to be a strong mark. Applicant essentially admits this point, stating that "no other marks other than applicant's and registrant's are noted having to do with vehicles or tires" (brief, p. 5).

We turn now to the similarities or dissimilarities in the goods and services, trade channels and classes of purchasers involved in this case. Concerning the goods and services, the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16

USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

In support of her position that the respective goods and services are related, the examining attorney submitted four third-party registrations that include, in the identification of goods, both automobiles or vehicles and wheels and tires therefor.² Three of these registrations, for the marks TOM'S, IAC INTERNATIONAL and ASIASONIC, respectively, appear to identify aftermarket and/or

² A fifth third-party registration does not include vehicles, only motor vehicle parts, in the identification of goods and, thus, is not probative.

customized vehicles and parts. The fourth registration, owned by Honda Motor Co., Ltd., for the mark A-SPEC for "automobiles with, and custom packages of, such premium structural parts as ... alloy wheels, tires ..." also appears to identify customized and/or aftermarket vehicles and parts.

The examining attorney submitted excerpts from Internet websites for several major automotive manufacturers, Ford.com, GM.com, Toyota.com, and Dodge.com, as evidence that these companies offer automobiles and automotive parts for sale, and that automobiles contain wheels and tires. She also submitted excerpts from a Ford racing parts website and a GM performance parts website, both offering "wheels."³ An excerpt from the Toyota website includes the following language:

Your Toyota's tires are a specifically engineered component of your vehicle, helping to provide its unique driving and safety characteristics. That's why it's important to use tires that are exactly matched to your Toyota.

And getting your tires from the Toyota Tire Center at many Toyota Dealerships is your assurance that you'll get those tires - and only those tires.

We take judicial notice of the definitions submitted by the examining attorney with her brief from *American Heritage Dictionary of the English Language*, 4th ed. 2000

³ The examining attorney submitted an excerpt from mopar.com showing the Dodge logo and offering tires for sale under the brands Goodyear, Dunlop, Michelin and Continental. This evidence is not probative of the examining attorney's position that autos and tires may be identified by the same mark.

(www.Bartleby.com), of "tire" as "a covering for a wheel, usually made of rubber reinforced with cords of nylon, fiberglass, or other material and filled with compressed air"; and from the *Cambridge Advanced Learner's Dictionary* (www.dictionary.Cambridge.com) of "wheel" as "a circular object connected at the centre to a bar, which is used for making vehicles or parts of machines move."

There is no question that wheels and tires are structural parts of automobiles; although, this fact alone is insufficient to establish a relationship between and among the goods and services for the purpose of determining likelihood of confusion. The examining attorney cites several cases finding likelihood of confusion involving automobiles and tires; however, we note that there is no per se rule in this regard as each case must be decided on its own facts.

Applicant makes the following argument that the goods and services are not substantially similar such that confusion is likely (brief, p. 4-5):

[T]he present mark is directed to tire sales and services, for all vehicles, whereas the prior marks identify only custom vehicles and parts. Confusion on this point is, for all practical purposes, impossible considering that, and in order to be confused, a prospective purchaser of the registrant's classic car products would have to confuse applicant's general tire sales and services (i.e., to clarify being the name of applicant's store and not the names of the tires it sells) as originating from registrant's custom vehicle products (unlikely at best).

. . .

Given further the customized nature of the classic car services provided by Excalibur (i.e., as the Examiner clearly understands, they do not manufacture cars, rather they at most customize or modify existing vehicles including providing such as taillights and other customization features), it would be a significant stretch to presume that an ordinary classic car customer of registrant would exhibit any degree of confusion with applicant's tire wholesale distributorship and retail store services.

Applicant also argues that the respective goods and services appeal to different classes of purchasers, stating that registrant's goods would be bought only by classic car enthusiasts, whereas applicant's goods and services would be bought by the general consumer.

We are not persuaded by applicant's arguments. The identifications of goods in the cited registrations contain no limitations and, thus, encompass all automobiles. Likewise, the identification of goods and services in the application contain no limitations and, thus, encompass all automotive tires and wheels, including those for classic cars, and distributorship and retail store services for all tires and wheels. We find the evidence from the Internet websites of several major automotive manufacturers, supported by the few third-party registrations, sufficient to conclude that at least some types of automotive wheels and tires originate from the same sources and are identified by the same marks as automobiles. And, certainly, a wholesale or retail establishment of the same name selling

the such products, is likely to be perceived as similarly related to automobiles. In other words, we find the goods and services sufficiently related that, if identified by confusingly similar marks, confusion as to source is likely.

Inasmuch as the identifications of goods and services in the involved application and the goods in the cited registrations are not limited to any specific channels of trade, we presume that the goods and services would be offered in all ordinary trade channels for these goods and services and to all normal classes of purchasers for the same. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Therefore, we find the trade channels and classes of purchasers are at least overlapping.

Having considered the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, XCALIBER, and registrant's EXCALIBUR marks, their contemporaneous use on the related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Decision: The refusal under Section 2(d) of the Act is affirmed.