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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Haldex Brake Corporation and Haldex Brake Products Limited

v.

Akram Zikry

Opposition No. 91160715
against Serial No. 78267760

Wesley W. Whitmyer, Jr. and Andy I. Corea of St Onge Steward Johnston & Reens LLC for Haldex Brake Corporation and Haldex Brake Products Limited.

Akram Zikry, *pro se*.

Before Hairston, Bucher and Drost, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Akram Zikry seeks registration on the Principal Register of the following mark:

for goods identified in the application as "automotive brake pads" in International Class 12.[1]

Registration has been opposed by Haldex Brake Corporation, a Delaware corporation, and Haldex Brake Products Limited, a United Kingdom corporation. As their ground for opposition, opposers initially asserted that applicant's mark, when used in connection with applicant's goods, so resembles two of opposers' previously used marks:

HALDEX	for "automatic brake adjusting equipment and related parts, namely slack adjusters, drain valves and air driers, for use on land vehicles" in International Class 12;[2]
HALDEX EB+	for "electronic control apparatus for vehicle brakes and related parts, namely, microprocessors, electronic circuitry, electronic load sensors and pneumatic controllers" in International Class 9; and for "vehicle braking equipment and related parts, namely, brake disks, brake shoes, brake cylinders, friction pads, actuators, tappets, valves, piston/cylinder units, reservoirs, air dryers, condensers, pipes and couplings" in International Class 12.[3]

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[1] Application Serial No. 78267760 was filed on June 27, 2003 based upon Mr. Zikry's allegation of first use anywhere and first use in commerce at least as early as June 1, 2003.

[2] Registration No. 1455157 issued to Haldex, Inc. on September 1, 1987 claiming first use anywhere and first use in commerce at least as early as November 3, 1985; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. This registration has been assigned several times since the time of issue with a complete chain of title currently ending with Haldex Brake Corporation, a Delaware corporation.

[3] Registration No. 3080052 issued to Haldex Brake Products Limited on April 11, 2006 claiming first use anywhere and first use in commerce in both classes at least as early as January 2003. Opposers' Notice of Reliance included a status and title copy of application Serial No. 76352648, dated April 7, 2005. This application has since matured into Reg. No. 3080052.

as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act. In an amended notice of opposition, opposers also alleged that applicant committed fraud by asserting incorrectly in his application that he had used his trademark in commerce.

Applicant, in his answer, has denied all the salient allegations in the amended opposition.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposers, as part of their case-in-chief, have also made of record by notice of reliance their claimed registrations; the discovery deposition of Akram Zikry, taken on April 1, 2005, and exhibits thereto; Mr. Zikry's responses to opposer's interrogatories; and copies of third-party registrations obtained from the database of the United States Patent and Trademark Office. Applicant submitted no evidence in this proceeding and did not file a brief.

Factual Findings

Mr. Zikry is a research chemist and a member of the Army reserves, who is also currently working as a defense contractor. He likes cars, and runs several

entrepreneurial ventures on the side. The brake pads he has been selling over the past number of years are manufactured by Shandong Gold Phoenix Group Corporation, an international manufacturer of brake components for the automotive industry. While Mr. Zikry has tried repeatedly to break into the U.S. market, substantially all the goods he has sold, to date, have been shipped directly from Shandong province in China to Green Hand Imports and Exports in Cairo, Egypt – a business owned and operated by Mr. Zikry's cousins.

Opposers have presented no testimony or other evidence about their own usage of these marks. Thus, although they argue in their brief that they " … are leaders in the field of vehicles braking systems and related parts and have used the Trademark HALDEX on such systems and parts since at least as early as 1985," the only relevant evidence of record relating to opposers' place in the world of braking systems for land vehicles and related braking system components consists of the two identified registrations.

Opposers have standing and priority

Opposers' standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining

standing, i.e., whether one's belief that one will be damaged by the registration is reasonable and reflects a real interest in the case. *See also* *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). As noted above, opposers have shown that their pleaded registrations are valid, subsisting and owned by opposers. Thus, this proof, in addition to establishing their standing, removes the issue of priority from this case. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Accordingly, as to the claim of priority of use and likelihood of confusion, the focus of our determination is on the issue of whether applicant's **HALTIX** special form design mark, when used in connection with automotive brake pads, so resembles opposers' **HALDEX** and **HALDEX EB+** marks as to be likely to cause confusion, to cause mistake or to deceive as to source or sponsorship.

Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Act. Our determination of likelihood of confusion is based upon our analysis of all

of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). 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 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and the cases cited therein.

Registration No. 1455157

The marks

We turn first to the *du Pont* factor focusing on the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant's composite mark includes a design, while Haldex Brake Corporation's mark is simply the word **HALDEX**.

As noted by opposers, if a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods. *See In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). In comparing the literal portions of these two marks, opposers point out that the first syllable of each mark ("HAL-") is identical as is the final letter ("-X"). The minor difference in the appearance of the literal portions of the marks is in the middle portion ("TI" versus "DE").

As to connotation, applicant explained that he coined this term from the prefix "HALT" having the meaning of "stop," and the "-IX" or "-TIX" suffix, which Mr. Zikry testified suggested "high technology" to his way of thinking. Nonetheless, we would have to assume that most consumers would view both of these marks as being arbitrary when used in connection with brake parts, and would not be able to create a distinction based upon any clear different in meanings.

As to sound, we agree with opposers that applicant's choice of the coined term "Haltix" resulted in a two-syllable word mark that produces a very similar pronunciation to that of opposer's **HALDEX** mark:

> Moreover, the phonetic similarity between the marks more than overcomes any minor differences in their wording. Again the HAL and X portions of the marks are identical. The TI and DE portions of the marks are almost identical in sound.

Accordingly, given that these marks are somewhat alike as to overall appearance with no discernible difference in connotation, the fact that they are nearly identical in sound and commercial impression means that this *du Pont* factor favors opposers.

The goods

We turn next to a consideration of the relationship of the goods as described in the application and in the **HALDEX** registration.

Applicant's goods are described as "automotive brake pads." Applicant's web pages (made of record by opposers) include a page listing fewer than twenty different brake pads available as aftermarket brake pads for passenger cars and light trucks. The automobile models listed were mostly produced in the 1980's and 1990's by General Motors, Ford and Chrysler. In his testimony and his responses to opposers' first set of interrogatories, applicant discussed his attempts to market his products to automotive parts stores as well as service and repair shops. He also testified to the occasional email inquiries he receives

from individual, do-it-yourself mechanics who learn of him via the Internet. While this evidence confirms that applicant is directing his products to aftermarket parts for "autos," his identification of goods would have to be interpreted broadly enough to include sales to original equipment manufacturers of automobiles. However, we do not read this identification of goods as including brake parts for use on large land vehicles, either OEM or aftermarket.

Haldex Brake Corporation's goods are described as "automatic brake adjusting equipment and related parts, namely slack adjusters, drain valves and air driers [or dryers] for use on land vehicles." While opposers have placed no information in the record about what types of land vehicles are included in this identification, these three named products comprise components found in air braking systems. Air brakes are designed for use on large trucks and buses.

The goods of the parties are related in that both applicant and opposer will be selling parts for braking systems. The issue before us then, is how closely related are "automotive brake pads" and the air brake components identified in this registration.

We find that the third-party registrations of record are of no assistance to opposer in drawing these respective

goods closer.[4] In looking closely at all of these third-party registrations, we find no registrants that are obviously selling goods directed to both of these distinct market segments – the large, commercial vehicle braking market as well as the brake pad market for automobiles. Moreover, without any evidence in the record, we cannot be sure if they move in the same channels of trade.

Even assuming that these non-competing, braking products move in different channels of trade, we must still consider the degree of overlap of consumers exposed to the respective goods. The population most susceptible to confusion would be fleet owners and mechanics for commercial buses, trucks and trailers, who might well also service their own personal automobiles. Hence, all of Haldex Brake Corporation's customers are prospective consumers of applicant's goods. Our primary reviewing Court reminds us that "[t]he trademark law not only protects the consumer from likelihood of confusion as to commercial sources and relationships, but also protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer." *In re Shell*

[4] Merely picking up from the TESS database various identifications of goods having both the words "brake pads" and "systems" results in opposers' submitting highlights of brake pads as well as several quite different automotive systems (e.g., ventilation systems, crankcase systems, alarm systems, suspension systems, etc.).

Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1989-90 (Fed. Cir. 1993).

Accordingly, in weighing the relevant *du Pont* factors for this cited registration, while we cannot be sure these respective braking components move through the same channels of trade, we find that the overall similarities of the marks, when combined with the fact that all of opposer's customers are prospective consumers of applicant's goods, supports a finding of likelihood of confusion as to this registration.

Registration No. 3080052

The goods

Haldex Brake Products Limited's involved goods include "vehicle braking equipment and related parts, namely, brake disks, brake shoes, brake cylinders, friction pads …. " At first blush, these would seem to be quite similar to applicant's automotive brake pads. While the entire package of goods as identified in both classes in this cited registration, when considered cumulatively, would appear to comprise electronic braking and stability control systems for large semi truck trailers, they are not so limited on the face of the registration. Inasmuch as our determination of likelihood of confusion must be determined

on the basis of the goods as they are identified in the application and the registration (*See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990)), and opposer's goods in International Class 12 include individual braking components such as "brake disks, brake shoes, brake cylinders, friction pads," we have to presume that these individual braking components, as listed, could be substantially identical to applicant's named goods and might move in the same, or very similar, channels of trade, where they would be available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); and *In re Optica International*, 196 USPQ 775 (TTAB 1977). This *du Pont* factor favors the position taken by opposers.

The marks

We discussed earlier our determination as to the similarities between applicant's **HALTIX** and design mark and the **HALDEX** mark owned by Haldex Brake Corporation. Haldex

Brake Products Limited's **HALDEX EB+** has the additional designation "EB+."

As to sound, **HALDEX EB+** is a five-syllable term contrasted with applicant's two-syllable term. However, emphasis will clearly be on the leading and arbitrary term, "Haldex," and given the context of opposer's identified goods, the "EB+" term might well be suggestive of electronic braking, and more. In spite of these differences, we find that the respective marks convey a similar commercial impression. Accordingly, when compared in their entireties, we find these marks to be confusingly similar.

In weighing the relevant *du Pont* factors for this cited registration, we find that the goods must be presumed to be closely related, and the marks are similar enough as to sound, connotation and commercial impression to support a likelihood of confusion herein.

Fraud

We turn next to opposers' claim of fraud. It is settled that fraud upon the United States Patent and Trademark Office constitutes the willful withholding of material information, which if disclosed to the Office, would have resulted in the disallowance of the

registration. *See Girard Polly-Pig, Inc. v. Polly-Pig by Knapp, Inc.*, 217 USPQ 1338 (TTAB 1983); and *Crown Wallcovering Corp. v. Wall Paper Mfgrs. Ltd.*, 188 USPQ 141 (TTAB 1975). An essential element of such a fraud claim is that the defendant's false statements were made willfully, in bad faith, and with the intent to obtain that to which the defendant otherwise would not have been entitled. *See Id.* False statements that are occasioned merely by a misunderstanding, an inadvertence, a mere negligent omission, or the like, are not fraudulent. *See American Speech-Language-Hearing Assn. v. National Hearing Aid Society*, 224 USPQ 798, 805 (TTAB 1984); and *Rogers Corp. v. Fields Plastics & Chemicals, Inc.*, 176 USPQ 280, 283 (TTAB 1972). Furthermore, an allegation of fraud must be proven "*to the hilt*" with clear and convincing evidence. *See Smith International, Inc. v. Olin Corporation*, 209 USPQ 1033, 1043-44 (TTAB 1981).

On the record currently before us, we find that while it appears as if this *pro se* applicant has not been met with a great deal of success in marketing his brake pads in the USA, given his active attempts to create a market here, including his supplying prototypes to parts retailers in locations such as Tampa, Florida, and Washington DC, his ongoing presence on the Internet, and his meaningful volume

of sales in international commerce, we find that applicant may well have been unaware of the technical requirements for an allegation of "use in commerce" under the Lanham Act, and that accordingly, opposers have failed to meet their burden of proving by clear and convincing evidence that applicant has made a false representation of a material fact with knowledge of the falsity of the statement.

Decision: The opposition is hereby sustained as to likelihood of confusion with both of opposers' claimed registrations.