

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
March 5, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Honda Motor Co., Ltd.
v.
Dakota Motorcycles USA Inc.

Opposition No. 91162109
to application Serial No. 78206784
filed on January 24, 2003

Anthony L. Fletcher of Fish & Richardson, P.C. for Honda
Motor Co., Ltd.

Dakota Motorcycles USA Inc., pro se.

Before Seeherman, Grendel and Walsh, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Dakota Motorcycles USA Inc., applicant herein, seeks
registration on the Principal Register of the mark depicted
below



for goods identified in the application as "on road vehicles, namely motorcycles; featuring an in line, air-cooled, four-cylinder engine."¹ Applicant has disclaimed MOTORCYCLES apart from the mark as shown.

Honda Motor Co., Ltd., opposer herein, has opposed registration of applicant's mark on the ground that the mark, as applied to applicant's goods, so resembles the mark depicted below



previously registered by opposer for goods identified in the registration as "motorcycles, and structural parts therefor,"² as to be likely to cause confusion, to cause

¹ Serial No. 78206784, filed on January 24, 2003. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Registration No. 2414536, issued on November 19, 1998. Section 8 and 15 affidavits accepted and acknowledged, respectively. In its notice of opposition, opposer also has pleaded and relies

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mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer to the notice of opposition, by which it admitted that opposer is the owner of its pleaded design mark Registration No. 2414536, but otherwise denied the salient allegations of the notice of opposition.³

Both parties presented evidence at trial. The case is fully briefed. After careful consideration of the evidence of record and the arguments of the parties, we sustain the opposition.

Initially with regard to evidentiary issues, the Board's March 7, 2007 order sustaining opposer's procedural objections to applicant's Notices of Reliance Nos. 1-9 and

upon its Registration No. 2088198, which is of the mark VALKYRIE (in standard character form) for goods identified in the registration as "land motor vehicles, namely, motorcycles and structural parts therefor." In view of our decision sustaining the opposition as to opposer's pleaded design mark Registration No. 2414536, we need not and do not consider opposer's claim insofar as it pertains to its word mark registration.

³ In its brief, applicant contends that opposer has abandoned its pleaded mark, and requests that discovery be reopened to allow applicant to investigate this issue. Applicant's request is denied. Applicant's abandonment claim would constitute a compulsory counterclaim for cancellation of opposer's registration. Applicant has provided no reason why it could not have ascertained information about a possible abandonment during the discovery period, nor has it given any reason for its failure to amend its pleading to assert a counterclaim in a timely manner during trial and prior to briefing. We note that there is no evidence in the record to support an abandonment claim; the evidence of record in fact directly refutes such a claim. (Gurga Test. Depo. at 22-23.)

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14-15 stands,⁴ and that evidence has been given no consideration. Opposer's ongoing substantive objections to applicant's Notices of Reliance Nos. 6, 10, 11 and 12 are overruled, and we have given that evidence whatever probative value it deserves.

The evidence of record in this case thus consists of: the file of applicant's involved application; the pleadings herein; opposer's Notice of Reliance on status and title copies of its pleaded registration; the testimony deposition of opposer's witness, Robert Gurga, and exhibits thereto; applicant's Notice of Reliance No. 6 (excerpts from a motorcycle magazine); applicant's Notice of Reliance No. 10 (Wikipedia entry for "Thor"); applicant's Notices of Reliance Nos. 11 and 12 (dictionary definitions of "dictionary" and "reference"); applicant's Notice of Reliance No. 13 (opposer's marketing video, submitted by applicant without objection by opposer); and opposer's rebuttal Notice of Reliance on dictionary definitions of "Valkyrie," "Odin," "Valhalla" and "Viking."

Because opposer has properly made its pleaded registration of record, we find that opposer has established its standing to oppose registration of applicant's mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d

⁴ We add that even if we had considered all of the evidence submitted by applicant at trial, our decision herein would be the same.

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1024, 213 USPQ 185 (CCPA 1982); *see also* *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000);

Moreover, because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & 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 Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the second *du Pont* factor (similarity or dissimilarity of the goods). We find that the goods identified in applicant's application, i.e., "on road vehicles, namely motorcycles; featuring an in line, air-cooled, four-cylinder engine," are encompassed by and thus legally identical to the goods identified in opposer's registration, i.e., "motorcycles, and structural parts

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therefor." Applicant and opposer both market or intend to market motorcycles under their respective marks. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the third *du Pont* factor (similarity or dissimilarity of trade channels), given the legally identical nature of the parties' goods (motorcycles) and the absence of any trade channel restrictions in either party's identification of goods, we find that the parties' motorcycles are or would be marketed in the same trade channels, to the same classes of purchasers. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor (conditions of purchase), we find that motorcycles can be fairly expensive items which are likely to be purchased with a degree of care. The fourth *du Pont* factor weighs against a finding of likelihood of confusion.

Under the sixth *du Pont* factor, there is no evidence of any third-party use of similar design marks on similar goods. The sixth *du Pont* factor is neutral in this case.

Under the fifth *du Pont* factor (fame of opposer's mark), we find that opposer has failed to establish that its mark is famous. However, we find that the mark is a strong mark even if not famous, in view of opposer's evidence of

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sales (37,000 motorcycles sold for \$440,000,000 at wholesale between 1996 and 2005), and in the absence of any evidence of third-party use of similar marks. To the extent that such strength in the marketplace exists, the fifth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn finally to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, 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 impression that confusion as to the source of the goods 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). Finally, in cases such as this, where the applicant's goods are identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate*

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Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Although a side-by-side comparison is not the proper test in determining the similarity of the marks, we set them forth below for ease of reference and discussion.

Applicant's mark:



Opposer's mark:



In terms of appearance, we find that the marks obviously are dissimilar to the extent that applicant's mark contains wording (VIKING MOTORCYCLES), while opposer's mark does not. However, we find that there is a high degree of similarity between the design elements of the respective marks. Both marks depict human figures presented in

profile, who wear horned helmets which readily would be perceived as being Viking helmets. Although the respective Viking figures face different ways, and although the Viking in applicant's mark clearly is male while the Viking in opposer's mark appears to be female, those points of dissimilarity are outweighed, in our analysis, by the fact that both figures essentially would be perceived as being Vikings.⁵ Finally with respect to our comparison of the marks in terms of appearance, we find that the marks are similar to the extent that they both include elements (the hair streaming behind the Viking in opposer's mark, and the horizontal lines in applicant's mark which look like hair streaming from the Viking's beard or from under his helmet⁶) which suggest that the Viking figures are moving forward at a high rate of speed. In sum, we find that although the marks are not identical in terms of appearance, they are quite similar in appearance when viewed in their entireties.

In terms of sound, the marks are dissimilar in that opposer's mark is a design mark without wording which would

⁵ The record does not support applicant's contention that Vikings were exclusively male, or that relevant purchasers today would be aware of such fact even if true. Rather, purchasers today are likely to perceive the figure in opposer's mark as a female Viking, regardless of whether there ever were female Vikings as a matter of historical fact.

⁶ Given the degree of integration between applicant's Viking's hair and beard and the horizontal lines streaming behind, we are not persuaded by applicant's contention that purchasers would perceive the horizontal lines as a representation of the cooling fins of applicant's air-cooled motorcycle engine.

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be pronounced, while applicant's mark would be pronounced "Viking Motorcycles."

In terms of connotation and commercial impression, we find that the marks are quite similar. Each of the marks suggests and connotes a Viking moving forward at high speed (most likely on a motorcycle). The Viking motif is arbitrary as applied to motorcycles, and it creates the same commercial impression in both marks. The presence of the literal word VIKING in applicant's mark does not distinguish applicant's mark from opposer's mark; in fact, it reinforces the "Viking" motif of applicant's mark and increases the similarity between the marks.

Comparing the marks in their entireties in terms of appearance, sound, connotation and commercial impression, we find that the marks are similar. As noted above, where the parties' goods are identical, a lesser degree of similarity between the marks is necessary in order to find a likelihood of confusion. We find that applicant's mark is sufficiently similar to opposer's mark that confusion is likely to result from use of the marks on the parties' identical goods. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Considering and balancing all of the evidence of record as it pertains to the relevant *du Pont* factors, and for the reasons discussed above, we conclude that there is a

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likelihood of confusion between applicant's mark as applied to motorcycles and opposer's registered design mark as applied to motorcycles. The fact that the goods are likely to be purchased with a degree of care does not suffice to overcome the likelihood of confusion arising from the similarity of the marks, the identical nature of the goods, trade channels and purchasers, and the strength of opposer's mark. We have considered all of applicant's arguments to the contrary (including any arguments not specifically discussed in this opinion), but are not persuaded by them. To the extent that any doubts might exist as to the correctness of our likelihood of confusion conclusion, we resolve such doubts against applicant. See *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

In summary, we find that opposer has established its standing to oppose and its Section 2(d) ground of opposition.

Decision: The opposition is sustained.