

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

Mailed:
December 4, 2008
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bombardier Recreational Products Inc.

v.

Duramax, Inc.

Opposition No. 91163205
against Serial No. 76479757

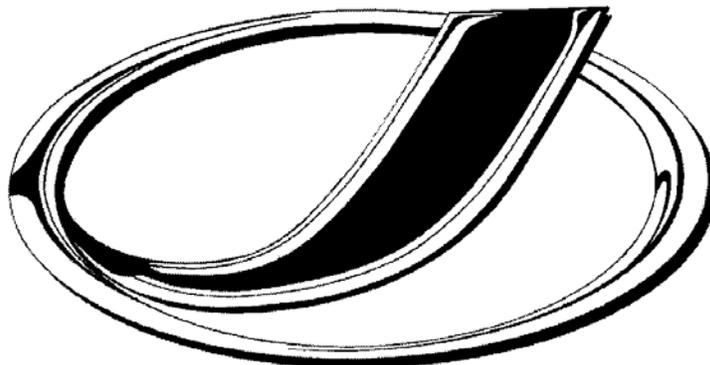
Peter B. Kunin, of Downs Rachlin Martin PLLC for Bombardier
Recreational Products Inc.

D. Peter Hochberg of D. Peter Hochberg, Co., L.P.A. for
Duramax, Inc.

Before Bucher, Walsh and Mermelstein, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Duramax, Inc. seeks registration on the Principal
Register of the following mark:



Johnson
rubber company

for services recited in the application, as amended, as follows:

"distributorships in the fields of land vehicles and marine equipment" in International Class 35; and

"manufacture of general product lines in the fields of land vehicles and marine equipment to the order and specification of others" in Int. Class 40;¹

Bombardier Recreational Products Inc. has opposed this application on the ground of priority of use and likelihood of confusion, alleging that applicant's mark, when used in connection with the recited services, so resembles its **JOHNSON** mark, registered in connection with the following goods and services:

JOHNSON	for "outboard motors" in International Class 7; ² for, <i>inter alia</i> , "internal combustion engines for boats, marine engines and outboard motors, and parts therefore-namely, outboard motor stands, fuel filters, and fresh water flushing attachments" in International Class 7; "electrical cigarette lighters; safety equipment-namely, buoyant vests; marine instruments-namely, tachometers, speedometers, water pressure gauges, voltmeters, ammeters, temperature gauges, fuel gauges, hour meters, trim position indicators and oil pressure gauges" in International Class 9;.
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¹ Application Serial No. 76632896 was filed on January 2, 2003 based upon claims of first use anywhere and first use in commerce in both classes of services at least as early as September 1999. The mark consists of a stylized letter "J" in an oval; the top of the "J" extends slightly above the top of the oval; and the text "Johnson Rubber Company" appears below the oval. No claim is made to the right to use the words "rubber company" apart from the mark as shown.

² Registration No. 0519909 issued to Outboard, Marine & Manufacturing Company on January 17, 1950; third renewal. Subsequent assignments are recorded with the Assignment Division of the United States Patent and Trademark Office at Reel 0026/Frame 0059, Reel 2759/Frame 0642 and Reel 2777/Frame 0469.

"motor boat accessories-namely, marine propellers" in International Class 12;
"instructional booklets available separately - namely, owner's manuals, service manuals, and parts catalogs all relating to outboard motors, electric trolling motors and other marine engines" in International Class 16;
"maintenance and repair of internal combustion engines, outboard motors and marine accessories" in International Class 37; and
"retail store services in the field of marine equipment" in International Class 42.³

as to be likely to cause confusion, to cause mistake or to deceive, under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Applicant, in its answer, denied all the essential allegations of these claims.

I. THE RECORD

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the record includes the pleadings and the file of the involved application.

The record also includes opposer's Notice of Reliance filed on March 28, 2008, making of record certified copies of opposer's registered **JOHNSON** marks, U.S. Registration Nos. 0519909 and 1277753, as discussed above; a book *EVINRUDE*

³ Registration No. 1277753 issued to Outboard Marine Corporation on May 15, 1984; renewed. Subsequent assignments are recorded with the Assignment Division of the United States Patent and Trademark Office at Reel 2759/Frame 0642 and Reel 2777/Frame 0469.

JOHNSON AND THE LEGEND OF OMC;⁴ an article from the *Milwaukee Journal Sentinel*;⁵ a news release;⁶ web pages showing opposer's **JOHNSON** outboard motors and marine engines currently available for sale;⁷ and web pages showing retail dealers of Opposer's **JOHNSON** marine products.⁸

Applicant submitted no testimony or evidence, nor did applicant file a final brief.

II. FACTUAL FINDINGS

The Rodengen book discusses how the Johnson brothers started the commercial production of outboard boat motors in Indiana in 1922. The other sources on which opposer relies report that eighty-six years later, after enormous changes in technology, multiple changes in ownership (including a bankruptcy sale of Outboard Marine in 2000), use of this mark has been continuous, and opposer is still using the **JOHNSON**

⁴ By Jeffrey L. Rodengen, at iii-v, 32 - 43, 67 (Write Stuff Syndicate, Inc. 1992).

⁵ Entitled "Trolling for market share BRP stirs the waters to regain prominence of Evinrude, Johnson motor brands" by staff writer, Rick Barrett, June 7, 2005.

⁶ Entitled "Boating Industry Magazine Announces 2007 Top 100 and Leadership Alliance," May 30, 2007.

⁷ <http://www.brp.com/en-US/Products/Johnson/Showroom/>, as accessed by opposer's counsel on March 18, 2008.

⁸ <http://dealerlocator.johnson.com/en/joDealerLocator.asp> as accessed by opposer's counsel on March 19, 2008.

mark to identify outboard motors and marine engines, and to identify retail services in the field of marine equipment. Retail dealers who sell and service opposer's **JOHNSON** brand marine products are available nationwide.

III. ANALYSIS

A. Standing

Opposer's 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 enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) 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). Opposer has submitted evidence of its ownership of its **JOHNSON** registrations. We consider this sufficient to establish opposer's interest and, therefore, standing, in this proceeding.

B. Priority

Because opposer has established that it owns valid and subsisting registrations of its pleaded marks, priority is not an issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

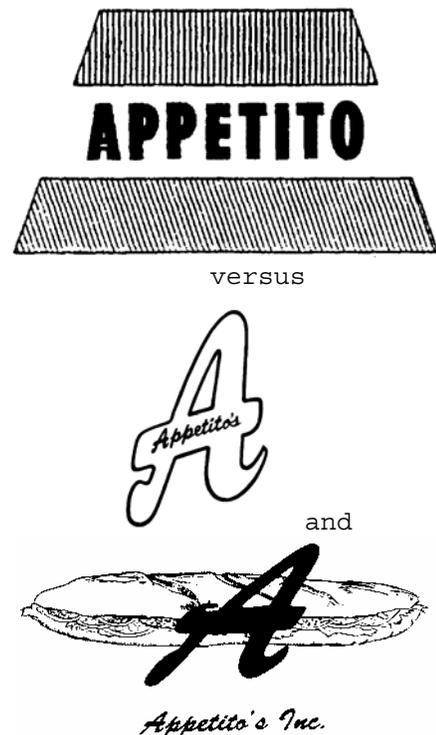
C. Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Trademark Act. Our determination must be 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." See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Marks

We turn first to examine the similarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Opposer argues that the dominant element in applicant's mark is "Johnson," the sole element in opposer's mark. Opposer points out that applicant has disclaimed the exclusive right to use the words "rubber company" apart from the mark as shown, and applicant's design element does little to distinguish its mark from opposer's. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) [Mark having the word "Appetito" in block letters, prominently displayed between broad geometric stripes as applied to Italian sausages, likely to cause confusion with "Appetito's" printed in small script letters across a large capitalized letter "A," and "Appetito's Inc." with a large capitalized letter "A" and the design of a sandwich, for restaurant services].



We take guidance from our primary reviewing court, which has on occasion found that the words, rather than the design features of the respective logos, will create a greater impression on customers. *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983):



Similarly, see also *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987):



Inasmuch as consumers generally call for goods or services in the marketplace by the word portion of the marks, we find that there is nothing improper in stating that the audio-literal element generally has more significance than the design feature in articulating reasons for reaching a conclusion on the issue of likelihood of confusion. In the instant case, we agree that from applicant's composite mark, the portion that prospective purchasers will recall and use in calling for or recommending applicant's services is the distinctive, literal element, "Johnson."

Furthermore, inasmuch as opposer's mark is presented in a standard character format, opposer is not limited to any

particular presentation. Therefore, applicant cannot avoid likelihood of confusion with opposer's mark by presenting its mark in special form. The record shows opposer's "Johnson" mark presented in similar italicized block lettering, and it might well be reasonable for opposer to use its mark, for example, with a large letter "J" or within an oval carrier device. See *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987); and *In re Hester Industries, Inc.*, 231 USPQ 881, 883, n.6 (TTAB 1986).

Accordingly, this *du Pont* factor supports a finding of likelihood of confusion.

Relatedness of the goods and services, Channels of Trade and Conditions under which sales are made, and to whom

In looking at the respective recitations of services and goods, we agree with opposer that the manufacturing and distribution of marine equipment recited rather broadly in the involved application are closely-related to, if not even overlapping with, the services recited in opposer's '753 registration, and related to the goods in both cited registrations. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). When, as here, there is no limitation as to the nature, type, channels of trade or class of purchasers, it

must be assumed that the application and/or opposer's registrations encompass all the goods and/or services of the type described, that they move in all of the same channels of trade normal for these goods and/or services, and that they are available to all classes of purchasers.

Hence, these critical *du Pont* factors also support a finding of likelihood of confusion.

Renown of opposer's mark

Finally, as to the *du Pont* factor focusing on the degree of fame of opposer's prior mark (sales, advertising, length of use, etc.), opposer cites to the "continuous, successive, and widespread use of that mark since 1922" Opposer's brief at 8. Opposer also claims that "[t]he JOHNSON mark has acquired a legendary status and is clearly one of the most well-known marks, if not the most known mark, in the United States to identify outboard motors." *Id.* at 2. While it may indeed be true that opposer's mark is well-known for boat motors, it has not been properly demonstrated with evidence submitted for this record. Nonetheless, given the strong similarities in the commercial impressions of the respective marks and the close relationship of the involved services, in order to sustain the opposition herein, it is not necessary to find any degree of fame for opposer's mark.

Conclusion

In conclusion, we find that opposer has priority in view of its registrations of record; that applicant's services are closely-related to opposer's services; and that the respective trade channels and classes of customers are presumably identical.

Decision: The opposition is sustained based upon the ground of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant is hereby refused.