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*Decision mailed:
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GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Volkswagen AG
v.
Mentken

Opposition No. 91165323 to application Serial No. 78423442
filed on May 22, 2004

Stewart L. Gitler of Hoffman, Wasson & Gitler, P.C. for
Volkswagen AG.

Jon A. Schiffrin of Jon A. Schiffrin, P.C. for Robert Mentken.

Before Hohein, Bucher and Drost, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Robert Mentken has filed an application to register the
mark "Volks-bagen" in standard character form on the Principal
Register for "backpacks, totebags, [and] luggage" in
International Class 18.¹

Volkswagen AG has opposed registration, alleging in its
notice of opposition that, among other things, opposer "is and
has at all relevant times been actively engaged in the design,

¹ Ser. No. 78423442, filed on May 22, 2004, which is based on an
allegation of a bona fide intention to use such mark in commerce.

manufacture, development, marketing and sale of a wide range of products and services, including ... automobiles, ... leather goods, luggage, carry-on luggage and totebags"; that, in connection therewith, opposer is using and has used the mark "VOLKSWAGEN" since at least as early as 1950 in commerce in the United States and long prior to the filing date of applicant's application; that opposer is the owner of five "valid, subsisting, unrevoked, and uncanceled" registrations for its mark, including registrations for the mark "VOLKSWAGEN" in standard character form on the Principal Register for, *inter alia*, "vehicles--namely, automobiles and trucks, ... and accessories for automobiles--namely, ... baggage racks" in International Class 12² and for "leather and imitation leather articles, namely, wallets, key cases, credit card holders, business card holders, luggage, suitcases, duffle bags, carry-on luggage and tote bags, and garment bags for travel" in International Class 18;³ that "[a]s a result of the extensive use and advertising by Opposer, the trademark, VOLKSWAGEN, has become world famous"; that the "VOLKSWAGEN mark is closely and uniquely associated with Opposer and the products and related services it offers and has become a 'famous mark' as defined in 15 U.S.C.

² Reg. No. 617,131, issued on December 6, 1955, which alleges a date of first use anywhere and in commerce of July 1, 1950; third renewal.

³ Reg. No. 1,378,042, issued on January 14, 1986, which includes goods in several other classes but, as to the goods in International Class 18, alleges a date of first use anywhere of October 14, 1984 and a date of first use in commerce of January 17, 1985; cancelled §8 as to the goods in International Class 18. The registration contains a statement that: "The word 'VOLKSWAGEN' translates from the German as 'people's car'."

§1125(c)"; that the goods listed in applicant's application "are confusingly similar or identical to" the goods and services provided by opposer under its "VOLKSWAGEN" mark; and that applicant's mark, "Volks-bagen, so resembles Opposer's previously used and registered mark, VOLKSWAGEN, as to be likely to cause confusion, mistake, or deception as to the source of the goods."⁴

Applicant, in his answer, has denied the essential allegations of the notice of opposition.

The record consists of the pleadings; the file of applicant's involved application; two notices of reliance, filed by opposer as its case-in-chief, on (respectively) applicant's answer to an interrogatory served by opposer⁵ and a certified copy of each of its five pleaded registrations;⁶ and a notice of reliance, filed by applicant as its case-in-chief, on certain third-party registrations of marks which consist of the term

⁴ Although opposer has also raised an allegation of dilution by pleading that "[a]pplicant's proposed use of the mark Volks-bagen will be likely to cause dilution of Opposer's famous and distinctive mark, VOLKSWAGEN," no evidence with respect thereto was offered at trial. Such allegation, therefore, will not be given any further consideration.

⁵ Specifically, applicant answered opposer's Interrogatory No. 6, which requests information on applicant's monthly sales, by stating that "[t]here have been no sales of products under [the mark] VOLKS-BAGEN as yet."

⁶ In particular, opposer pleaded in the notice of opposition that it "is the owner of U.S. Trademark Registration Nos. 617,131; 790,621; 808,381; 819,297; [and] 1,378,042." The certified copies of such registrations show that opposer is the owner thereof and, with the exception of International Classes 18 and 21 of Reg. No. 1,378,042, which have been cancelled, the registrations are in full force and effect. However, as discussed later in this opinion, opposer has also filed a certified copy of and has relied upon a sixth registration for the mark "VOLKSWAGEN," namely, Reg. No. 2,835,662, which includes goods in International Class 18 but was not pleaded in the notice of opposition.

"VOLK" or include the element "VOLKS-,"⁷ an expired registration issued to opposer,⁸ and copies of pages from Cassell's German-English English-German Dictionary (1978).⁹ Both parties have filed main briefs and opposer has submitted a reply brief. In addition, opposer has sought by its notice of reliance on its five pleaded registrations to rely upon a certified copy of a sixth but unpleaded registration for the mark "VOLKSWAGEN" in standard character form on the Principal Register for, *inter alia*, "automobiles" ... [and] luggage carriers for vehicles" in International Class 12 and "goods made from leather and imitations of leather, namely, valises, wallets, suitcases, executive cases, bags, namely, all purpose athletic bags, all purpose sports bags, ... beach bags, book bags, carry-on bags, cricket bags; luggage; luggage trunks; ... [and] key cases," in International Class 18.¹⁰ Inasmuch as applicant has treated such registration as being of record,¹¹ the registration is considered

⁷ While applicant has also relied upon information pertaining to several third-party applications, such information evidences only that the applications were filed and has no other evidentiary value.

⁸ Specifically, applicant states that he relies upon "[a] copy of Opposer's expired registration for VOLKS and Design, Registration No. 945,614, showing non-use [sic] of this prefix term."

⁹ Applicant indicates that he relies upon "[c]opies of the German to English translation of 'volks' as [']people['] and 'wagen' as 'car,' including excerpts ... showing no German word 'bagen'."

¹⁰ Reg. No. 2,835,662, issued on April 27, 2004, which is based on German Federal Republic Reg. No. 39800185, dated July 1, 1998. It is noted that opposer filed its notice of opposition, thereby commencing this proceeding, more than a year later on May 17, 2005.

¹¹ Although applicant, in his brief, has raised certain evidentiary objections (which will be addressed later in this opinion), he has not objected to consideration of any of the registrations offered into evidence by opposer, including Reg. No. 2,835,662, and specifically

to form part of the record herein by stipulation of the parties pursuant to Trademark Rule 2.123(b) and the pleadings are accordingly deemed to be amended to include reference thereto pursuant to Fed. R. Civ. P. 15(b).

Priority of use is not in issue in this proceeding with respect to the various goods and services which are the subjects of opposer's six registrations for its "VOLKSWAGEN" mark since, as shown by the certified copies thereof, such registrations--except to the extent previously indicated¹² with respect to International Classes 18 and 21 of Reg. No. 1,378,042--are subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Opposer's ownership thereof, moreover, serves to establish its standing to bring this proceeding. Id. Thus, and because International Class 18 of opposer's Reg. No. 2,835,662 includes goods which, on their face, are identical in part and otherwise are the most closely related to applicant's goods, the focus of our determination is on the issue of whether applicant's "Volks-bagen" mark, when used in connection with the "backpacks, totebags, [and] luggage" items set forth in his application, so resembles opposer's "VOLKSWAGEN" mark for, *inter alia*, "goods made from leather and imitations of leather, namely, valises, wallets, suitcases, executive cases, bags, namely, all purpose athletic bags, all purpose sports bags, ... beach bags, book

states that opposer's "record of evidence only references its own registrations."

¹² See footnote 6.

bags, carry-on bags, cricket bags; luggage; luggage trunks; ... [and] key cases," as listed in International Class 18 of its Reg. No. 2,835,662, as to be likely to cause confusion, mistake or deception as to source or sponsorship.

Determination of the issue of likelihood of confusion is based upon consideration of all of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for which there is evidence in the record. See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.¹³ Such considerations, in this proceeding, are the only *du Pont* factors for which there is any evidence with respect thereto in the record.

Turning first to consideration of the *du Pont* factor which pertains to the similarity or dissimilarity of the goods at issue, opposer argues in its main brief that the goods listed in its Reg. No. 2,835,662 "include all purpose athletic bags and all

¹³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

purpose sports bags in International Class 18" (underlining in original). Because applicant's mark "is sought to be registered for backpacks, tote bags and luggage in International Class 18," opposer contends that "[t]he goods in the opposed application and Opposer's registration are identical and issuance of a registration will cause a likelihood of confusion with respect to the source of these goods." Although applicant, in his brief, asserts that opposer "is engaging in speculation by stating that its products ... are similar" to applicant's goods and maintains that, while opposer "can only rely on the identification of goods to make this assumption, ... it has not provided any evidence to support its claim that the products under the marks will be the same price and will be marketed to the same consumers."

It is well settled, however, that the registrability of an applicant's involved mark must be evaluated on the basis of the identification of the goods as set forth in the subject application and the identification(s) of the goods as recited in the registration(s) made of record by the opposer for its mark, regardless of what the record may (or may not) reveal as to the particular nature of the respective goods, their actual channels of trade, or the classes of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). It is also well established that, absent any specific limitations or restrictions in the identification(s) of goods as

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listed in an applicant's subject application and in the identification(s) of goods as set forth in the opposer's registration(s), the issue of likelihood of confusion must be determined in light of a consideration of all normal and usual channels of trade and methods of distribution for the respective goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as broadly identified in the subject application and the most pertinent of opposer's registrations, it is obvious that, on their face, the goods identified as "luggage" in applicant's application are legally identical to or encompass in all respects the goods identified as "suitcases," "luggage" and "luggage trunks" in opposer's registration and that, at a minimum, the goods listed as "backpacks" and "totebags" in such application are closely related in their nature and use to the goods set forth as "beach bags, book bags, [and] carry-on bags" in opposer's registration. Furthermore, as identified, neither parties' goods contain any express limitation or restriction as to types of purchasers or channels of distribution. Thus, insofar as the respective goods of the parties are identical or otherwise closely related, such goods would be sold to the same classes of purchasers, including ordinary consumers, through identical channels of trade, including department stores and mass merchandisers. Clearly, if such goods were sold under the same

or similar marks, confusion as to the source or sponsorship thereof would be likely to occur. The *du Pont* factor pertaining to the similarity or dissimilarity of the goods at issue therefore favors opposer.¹⁴

As to the *du Pont* factor which pertains to the similarity or dissimilarity of the respective marks in their entirety as to appearance, sound, connotation and commercial impression, opposer insists in its main brief that "[t]he only difference between the marks is the substitution of the soft 'W' in Opposer's mark for the soft 'B' in Applicant's mark." In view thereof, and since, as "evidenced by [the pages from] Cassell's German dictionary submitted by Applicant . . . , there is no German Word 'Bagen,'" opposer urges that its mark and applicant's mark, "in their entirety, are similar as to appearance, sound and commercial impression" and that "confusion between the two is inevitable."¹⁵ Applicant, on the other hand, maintains in his brief that inasmuch as "the issue of this opposition sits squarely on the common and suggestive nature of the words 'volks' and 'wagen,' and the differences in the sound, appearance and

¹⁴ Plainly, given the absence of any limitations or restrictions in the identifications of the respective goods, the related *du Pont* factors of the similarity or dissimilarity of established, likely to continue trade channels and the conditions under which and buyers to whom sales are made likewise necessarily favor opposer and a finding of a likelihood of confusion.

¹⁵ While opposer, as to the *du Pont* factor concerning any other established fact probative of the effect of use, asserts in its main brief that, "[c]learly, the adoption of the mark VOLKS-BAGEN by Applicant was solely to have a mark similar to Opposer's mark and trade off the good name and world famous notoriety of Opposer's mark," the record contains no evidence which suffices to demonstrate that applicant's adoption of and intent to use his mark were due to an attempt to trade upon opposer's mark and hence were in bad faith.

commercial impression of the words 'volkswagen' and 'volks-bagen,' ... the dissimilarity of the marks is a key factor in determining that there is no likelihood of confusion."

Specifically, as to opposer's assertion that "the only difference in the marks is the substitution of the soft 'W' in Volkswagen's mark for the soft 'B' in Mentken's mark," applicant argues that, in light of the evidence of record (emphasis in original):

Volkswagen can only establish similarity between VOLKSWAGEN and VOLKS-BAGEN based on the shared use of the prefix component "volks." The marks clearly differ in their suffix words, "wagen" and "bagen," and in overall sound, appearance and meaning. In fact, "wagen" is a German word meaning "car," which suggests the automobiles provided by Volkswagen under its registrations, while "bagen" is a coined term which, by its sound and appearance, clearly refers to bags.

The only shared component of VOLKSWAGEN and VOLKS-BAGEN is the prefix word "volks," which is a German word for "people." VOLKSWAGEN is a suggestive word defined in English as "people's car", while VOLKS-BAGEN has no specific meaning, but can be construed to refer to people's bags. For Volkswagen to say that the marks are confusingly similar based on the shared prefix "volks," a suggestive word translated as "people" in English, means that it alleges to hold dominion over all "volks" marks with all types of suffixes for all products. That generalization cannot stand when the overall sound, appearance and connotation of the marks differ, as they do with VOLKSWAGEN and VOLKS-BAGEN.

Mentken believes the *differences* in the marks are sufficient to create dissimilar commercial impressions, especially since "volks" is a suggestive word referring to "people," and "wagen" suggests "car."

....

.... The mere fact that Mentken and Volkswagen's marks both include "volks" is not enough for a finding for a finding of likelihood of confusion, given the weakness and descriptiveness of "volks" and the specific differences in sound, appearance and meaning of "wagen" and "bagen." Volkswagen states that the marks differ by a soft "W" and a soft "B." Mentken respectfully disagrees by stating that the "B" is a hard consonant which changes the sound of "bagen" and "wagen," and the hyphen between "volks" and "bagen" further differentiates VOLKSWAGEN from VOLKS-BAGEN in appearance. In this case, the underlying marks are clearly dissimilar in sound, appearance and connotation, when considered in their entirety, thus conveying separate overall commercial impressions.

Applicant also points out that the record contains evidence of third-party "registrations using 'volks' or 'volk' in connection with various products and services." Such registrations include the following: the mark "VOLKSCROWN" for "pharmaceutical and sanitary preparations for dental use in supporting dental teeth restorations"; the mark "VOLKSCOPE" for "consulting services in the field of electrical system analysis and testing for others"; the mark "VOLKSWINE" for "wine"; the mark "VOLKS-GURKEN" and design for "German style fresh dill pickles"; the mark "VOLK" for "ophthalmoscopy lenses"; the mark "VOLKSKAFFEE COFFEE ON THE MOVE" for "coffee and espresso"; the mark "VOLKSGARDEN" for, *inter alia*, "hydroponic planting mediums; fertilizers and growth enhancers for plants"; and the mark "VOLKSBETT" for "bed frames [and] beds." Applicant contends, in view thereof, that (citations omitted):

[C]onsumers are familiar with the use of "volks" and, therefore, this portion of the

underlying marks ought to be given a narrow scope of protection. Further, these third-party registrations are relevant to show that "volks" expresses a connotation and translation relating to ... products for everyone (or people) and is so commonly used that the public will look to other elements to distinguish the source of the goods, including, but not limited to, the other different letters that compose VOLKSWAGEN and VOLKS-BADEN.

Accordingly, as the facts indicate [that] "volks" is a diluted and weak prefix, and that the marks differ in sound, appearance and commercial impression based on the differences in "-BAGEN" and "WAGEN," this factor strongly favors Robert Mentken.

We disagree. Instead, we concur with opposer that, when considered in their entirety, the marks at issue are confusingly similar. In this regard, it must be kept in mind that, as indicated in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Here, as noted previously, applicant's goods are identical in part and otherwise closely related to certain of opposer's goods in International Class 18. Thus, while there are minor differences between applicant's mark "Volks-baden" and opposer's mark "VOLKSWAGEN" which are apparent upon a side-by-side comparison,¹⁶ the respective marks overall are

¹⁶ Such a comparison, however, is not the proper test to be used in determining the issue of likelihood of confusion since it is not the ordinary way that consumers will be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion

substantially similar in sound and appearance, given that applicant's mark differs from opposer's mark only by the presence of the letter "B" instead of the letter "W" and a hyphen connecting the terms which comprise his mark. The marks at issue, furthermore, are substantially similar in connotation and commercial impression.

Specifically, as to similarity or dissimilarity in sound, it is well settled that there is no correct pronunciation of a mark. See, e.g., *Gio. Budon & C. S.p.A. v. Buitoni Foods Corp.*, 205 USPQ 477, 482 (TTAB 1979); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701, 703 (TTAB 1977); and *Sterling Drug Inc. v. Sankyo Co., Ltd.*, 139 USPQ 395, 396 (TTAB 1963). Consequently, the letter "B" in applicant's mark is considered susceptible to pronunciation as a "soft 'B'" just as the letter "W" in opposer's mark may be pronounced as a "soft 'W'". The term "bagen," moreover, rhymes with the term "wagen." Both marks also have the same number of syllables and each begins with the identical term "volks." The respective marks, therefore, not only sound substantially the same but, as to similarity or dissimilarity in appearance, also look substantially the same. Such similarities, moreover, are not affected by the presence or

as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *In re United Service Distributors, Inc.*, 229 USPQ 237, 239 (TTAB 1986); *In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

absence of a hyphen. In addition, because opposer's mark is not registered in any special form, the depiction thereof is not limited to a particular manner of display. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Such registration consequently covers the use of the "VOLKSWAGEN" mark by opposer in any reasonable style of lettering, including "Volkswagen," which obviously is identical to the upper and lower case format of applicant's standard character form "Volks-bagen" mark.

As to the similarity of the respective marks in connotation, applicant is essentially arguing a variation of the doctrine of foreign equivalents in contending that his mark differs in meaning from opposer's mark. However, as set forth by our principal reviewing court in Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005), the doctrine of foreign equivalents is not an absolute rule and should be applied only when the "ordinary American purchaser would 'stop and translate [the word] into its English equivalent.'"¹⁷ Here, there is no

¹⁷ Strictly speaking, the court noted that:

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks. *See In re Sarkli, Ltd.*, 721 F.2d 353 [220 USPQ 111] (Fed. Cir. 1983); *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d 1459, 1460 (T.T.A.B. 1987) (finding BUENOS DIAS for soap confusingly similar to GOOD MORNING for shaving cream). When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (T.T.A.B. 1975) (no likelihood of confusion between TIA

evidence that the ordinary consumer of goods such as opposer's suitcases, luggage, luggage trunks, beach bags, book bags and carry-on bags and applicant's luggage, backpacks and totebags would translate the German terms "volks" and "wagen" into their literal English counterparts of, respectively, "people" and "car" for the purpose of distinguishing between opposer's "VOLKSWAGEN" mark and applicant's "Volks-bagen" mark.¹⁸ Neither term is a cognate and there is nothing to indicate that those terms are so commonly encountered in the marketplace that the average purchaser of the respective goods, even if also possessed of a basic familiarity with or casual understanding of German, would stop and translate those terms so as to regard opposer's mark as

MARIA for a Mexican restaurant and AUNT MARY's for canned vegetables).

....

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline. *In re N. Paper Mills*, 64 F.2d 998, 999 (C.C.P.A. 1933); *McCarthy on Trademarks*, at §11:34. The doctrine should be applied only when it is likely that the ordinary American purchaser would "stop and translate [the word] into its English equivalent." *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B. 1976).

Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, supra at 73 USPQ2d 1696. Consequently, as to the marks "VEUVE ROYALE" for sparkling wine and "THE WIDOW" for champagne, the court stated that it "agrees with the T.T.A.B. that it is improbable that the average American purchaser would stop and translate [the French term] 'VEUVE' into [the English word] 'widow' and thus found no likelihood of confusion. Id.

¹⁸ Specifically, the pages from Cassell's German-English English-German Dictionary (1978) show that "Volk" (or its plural "volk(e)s") means "people, nation, tribe, race; soldiery, troops, men, crew; herd (of beasts), flock (of birds), covey (of partridges etc.), swarm (of bees); the common people, the lower classes; the populace or crowd, the common herd, rabble," while "Wagen" means "van, truck, car, lorry; wagon, cart, carriage (also of typewriters), coach, chariot."

if it were "People's Car" and view applicant's mark as if it were either "People's Bagen" or, because the term "bagen" has no meaning in German, "People's Bag."

Instead, on this limited record, the average American purchaser is most likely to regard the marks at issue as two foreign terms which appear to be quite similar in meaning, given that they differ only by a single letter. That is, to the extent that an American consumer would ascribe any meaning to the respective marks, such a purchaser or prospective customer would probably treat the term "volks" as a cognate sounding like the word "folks" (rather than "people" as applicant has asserted) and would similarly regard the term "wagen" as a cognate signifying the word "wagon" (instead of "car" as applicant has contended), while the term "bagen" would be regarded as sounding like "bag" (as applicant has admitted). Inasmuch as a wagon and a bag plainly are both items used by persons or folks for carrying or toting items, the marks "VOLKSWAGEN" and "Volks-bagen" could reasonably be surmised as being substantially similar in connotation.

Moreover, as to applicant's argument, based on various third-party registrations for marks which are prefaced by the term "VOLKS," that such registrations, like dictionary definitions, demonstrate that opposer's mark is weak in the sense that it is highly suggestive of its goods, see, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976), suffice it to say that applicant has failed to

establish what it is that is highly suggestive about opposer's mark, particularly when used for goods in International Class 18. As noted by opposer in its reply brief, "the goods at issue are not cars but [luggage items and] bags so that, even given Applicant's flawed analysis, the mark VOLKSWAGEN is not suggestive of [luggage items and] bags." While applicant contends (as mentioned previously) that "these third-party registrations are relevant to show that "volks" expresses a connotation and translation relating to ... products for everyone (or people)," the significance thereof in relation to the goods at issue herein is simply not apparent. Nonetheless, even if opposer' and applicant's marks were to be regarded as weak in the sense of being highly suggestive of their respective goods, such would not mean that opposer's mark is entitled to protection only against the same or a virtually identical mark. Instead, it is well established that even a weak mark is entitled to protection against the registration of the same or a substantially similar mark for identical and/or closely related goods, which is the case with respect to applicant's "Volks-bagen" mark for backpacks, totebags and luggage. See, e.g., In re Farah Manufacturing Co., Inc., 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971) [even weak marks are entitled to protection where confusion is likely]; and Plus Products v. Physicians Formula Cosmetics, Inc., 198 USPQ 111, 114 (TTAB 1978). Here, both opposer's "VOLKSWAGEN" mark and applicant's "Volks-bagen" mark are substantially similar in their connotations, such that confusion

would be likely even if the marks were considered to be highly suggestive.

Lastly, because of their substantial similarities in sound, appearance and connotation, as discussed above, opposer's mark and applicant's mark would also engender a substantially similar overall commercial impression, particularly when used in connection with the same or closely related goods. The *du Pont* factor of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression accordingly favors opposer.

Turning next to applicant's argument, which is also premised on the third-party registrations which he made of record, that opposer's "VOLKSWAGEN" mark is a weak mark that is entitled to a narrow scope of protection which does not encompass applicant's "Volks-baden" mark, it is pointed out that such argument, which essentially concerns the *du Pont* factor of the number and nature of similar marks in use on similar goods, is misplaced. Not only are none of the third-party registrations for marks which cover luggage items or bags, but more fundamentally, it is well settled that third-party registrations are not evidence of what happens in the marketplace or that the purchasing public is familiar with the use of the marks which are the subjects thereof and has therefore learned to distinguish those marks by the differences therein. See, e.g., National Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). Such registrations therefore do not show that the subject marks are actually being used, much less

that the extent of their use is so great that customers have indeed become accustomed to encountering the marks in the marketplace and will differentiate "VOLKS-" prefixed marks by the differences in their suffixes. See, e.g., *Smith Brothers Manufacturing Co. v. Stone Manufacturing Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), in which the court indicated that:

[L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

See also *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) [third-party registrations "may not be given any weight" (emphasis in original) as to the strength of a mark]; and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). Accordingly, because there is no evidence of any actual third-party use of "VOLKS-" formative marks in the record to support applicant's position, the *du Pont* factor which concerns the number and nature of similar marks in use on similar goods is considered to be neutral rather than in favor of applicant.

With respect to the *du Pont* factor of the fame of the prior mark (including sales, advertising and length of use), opposer in its main brief asserts that:

Courts and Arbitration panels have repeatedly recognized the mark "VOLKSWAGEN" as being famous. Two such cases are Virtual Works, Inc. v. Volkswagen of America, Inc., 238 F.3d 264, 266 (4th Cir. 2001) and Volkswagen of American, Inc. v. Compugraphics; FA 0012000096265 (Nat. Arb. Forum January 16, 2001). Copies of these cases are attached as Exhibit C. Opposer has registered the mark "VOLKSWAGEN" in the United States as early as May 4, 1954 and has continuously used and advertised the mark in all fifty states. Opposer's mark enjoys a high degree of recognition among the general public and is now the subject of multiple federal registrations. As evidenced by Opposer's registrations, the "VOLKSWAGEN" mark is applied to a wide range of products, raising the awareness of the mark among consumers.

Opposer, in view thereof, refers in its reply brief to its "world famous mark" and "world famous brand."

Applicant, in his brief, raises the following evidentiary objections to opposer's assertions:

Mentken objects to any claims made by Volkswagen concerning the fame of its mark. Volkswagen did not submit any evidence regarding fame during the testimony period, and the case law it references in its Exhibit C only pertains to the fame of [the mark] "VW". Furthermore, the case law in Exhibit C pertains to an entirely different set of facts [than] as [to] those presented in this opposition--there is no discussion of the fame of VOLKSWAGEN, a suggestive word in connection with regard to automobiles Furthermore, the mark at issue is VOLKS-BAGEN, and there is no indication that any alleged fame for VOLKSWAGEN carries over to all "volks" prefix marks. Essentially, Volkswagen is using case law for different marks under different legal standards (cybersquatting cases do not have the same issues as oppositions), and is attempting to shoehorn these cases into the fact pattern of the instant application. Further, as Volkswagen did not present any evidence [of fame] during testimony, it should be precluded from doing so in its opening brief.

TBMP Section 705.02. Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976) ... (Evidence submitted for the first time with a brief will not be considered); Blue Man Productions Inc. v. Tarmann, 75 USPQ2d 1811 (TTAB 2005) (It is the duty of a party asserting its mark is famous to clearly prove it).

Moreover, applicant contends that because "no evidence has been submitted by Volkswagen proving that the VOLKSWAGEN mark is famous in connection with luggage and tote bags," it accordingly is the case that "this factor must favor Mentken."

As noted by our principal reviewing court in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992), "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." The Federal Circuit reiterated these principles in *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), stating that "the fifth *DuPont* factor, fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *DuPont* factors," *citing, inter alia, Kenner Parker Toys*, 22 USPQ2d at 1456, and reaffirmed that "[f]amous marks thus enjoy a wide latitude of legal protection." Recognizing, however, that "[d]irect evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion," the Federal Circuit has also stated that "the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the

length of time those indicia of commercial awareness have been evident." Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

However, in this proceeding, applicant is correct that the record contains absolutely no evidence as to the asserted fame of opposer's "VOLKSWAGEN" mark. As provided in TBMP §539 (2d ed. Rev. 2004):

Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party. If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike or otherwise.

Copies of the two cases referred to by opposer in its main brief and attached thereto as Exhibit C were not made of record during trial. Moreover, not only are the findings of fact in such cases not evidentiary matters for the purpose of establishing the alleged fame of opposer's mark in this proceeding, but even if they were, such findings pertain to determinations made over five years prior to, instead of on or about, the March 11, 2006 closing date of opposer's initial testimony period and,¹⁹ as accurately pointed out by applicant, concern cybersquatting decisions relating to the mark "VW" rather than likelihood of confusion actions involving opposer's "VOLKSWAGEN" mark. Mere

¹⁹ While whether, at a time previous to this proceeding, opposer's "VOLKSWAGEN" mark was famous is indeed a fact which would be relevant to the issue of likelihood of confusion, opposer must nonetheless demonstrate with respect to the asserted fame of its mark that the mark is or continues to be famous as of the closing of the trial phase of this proceeding. Opposer has not introduced any evidence which would suffice to constitute such a showing.

ownership of several subsisting registrations, moreover, is not evidence of the claimed fame of the mark which is the subject thereof.

Applicant's evidentiary objections, in light of the above, are thus well taken. As set forth in TBMP §704.06(b) (2d ed. rev. 2004):

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest.

Accordingly, in view of opposer's failure to present any evidence to support a claim of fame, such *du Pont* factor is considered to be neutral in that not only does it not favor opposer but, contrary to applicant's contention, it does not favor applicant either. There is, instead, simply no proof of fame.

Finally, applicant argues as to the *du Pont* factors pertaining to the nature and extent of any actual confusion and the length of time during and conditions under which there has been contemporaneous use of the respective marks without evidence of actual confusion that "there is no evidence submitted by either party that there has been any actual confusion." Applicant insists, in view thereof, that "these factors favor Mentken." While opposer has not addressed applicant's arguments in either of its briefs, it is clear from the record herein that, as stated by applicant in his answer to opposer's Interrogatory No. 6, "[t]here have been no sales of products under [the mark] VOLKS-BAGEN as yet." It is clear, therefore, that inasmuch as

applicant has not sold any goods under his mark, there has been no opportunity for any actual confusion to have occurred from the contemporaneous use by applicant of his mark for backpacks, totebags and luggage and the use by opposer of its "VOLKSWAGEN" mark in connection with the same or closely related products.

Consequently, while the absence of any instances of actual confusion over a significant period of time is indeed indicative of no likelihood of confusion, it is meaningful only where the record demonstrates appreciable and continuous use by the defendant of its mark in the same market(s) as those served by the plaintiff under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); and *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 541 (TTAB 1979). Specifically, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Here, the sole evidence pertaining to use establishes that, to the contrary, there has been no chance for actual confusion to have occurred. There are therefore no mitigating factors which favor applicant.²⁰

²⁰ Although applicant also contends that, because there is no evidence of record which pertains thereto, all remaining *du Pont* factors (e.g., variety of goods on which a mark is or is not used (such as a house mark, "family" mark or product mark), market interface between the parties (such as a consent agreement), the extent to which applicant has the right to exclude others from use of his mark on his goods, the extent of any potential confusion, and any other established fact probative of the effect of use) "strongly favor Robert Mentken," suffice it to say that absence of evidence is not evidence of absence with respect thereto and, thus, such factors are neutral.

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Accordingly, because all of the pertinent *du Pont* factors either favor opposer or are neutral, and none of such factors favors applicant, we conclude that contemporaneous use by applicant of the mark "Volks-bagen" in connection with backpacks, totebags and luggage would be likely to cause confusion with use by opposer of the mark "VOLKSWAGEN" in connection with its identical in part and otherwise closely related suitcases, beach bags, book bags, carry-on bags, luggage and luggage trunks.

Decision: The opposition is sustained and registration to applicant is refused.