

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79234073

MARK:

79234073

CORRESPONDENT ADDRESS:

LANDTOURER AUTOMOBILE CO., LTD
No. 1 Yuanquan Road,
Shangrao Economic & Technological
334100 Jiangxi Province
CHINA

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_form.jsp

APPLICANT: LANDTOURER AUTOMOBILE CO., LTD

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1406563

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Trademark Act Section 2(d) - Likelihood of Confusion Refusal
- Identification of Goods
- Mark Description

Trademark Act Section 2(d) - Likelihood of Confusion Refusal

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in the commonly owned U.S. Registration Nos. 0863434 and 3084537, and with the commonly owned marks in U.S. Registration Nos. 1416549 and 3084187. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant(s). See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, "[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis "on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services]." *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

The applicant's mark comprises a design of a jumping horse appearing over a shaded square inside a circle design for "electric vehicles; automobile chassis; hub caps; vehicle running boards; ski carriers for cars; automobiles; automobile bodies; bumpers for automobiles; spare wheel covers; hubs for vehicle wheels."

The registrant, Ferrari S.p.A., owns U.S. Registration No. 0863434 comprising a prancing horse design for "automobiles" and U.S. Registration No. 3084537 comprising a prancing horse design for "land motor vehicles and structural parts and accessories thereof sold as a unit; engines, transmissions, suspensions and brakes for land vehicles; motor car bodies; bicycles."

The registrant, Ford Motor Company, owns U.S. Registration No. 1416549 comprising a design of a horse in motion for “automobiles and their structural parts, wheels and wheel covers” and U.S. Registration No. 3084187 comprising a design of a horse in motion for “automobile parts, namely automobile grilles.”

Similarity of Marks

When the marks at issue are both design marks, similarity of the marks is determined primarily on the basis of visual similarity. *See, e.g., Volkswagenwerk Aktiengesellschaft v. Rose 'Vear Enters.*, 592 F.2d 1180, 1183, 201 USPQ 7, 9 (C.C.P.A. 1979) (quoting *In re ATV Network Ltd.*, 552 F.2d 925, 929, 193 USPQ 331, 332 (C.C.P.A. 1977)); *Ft. James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1628 (TTAB 2007); TMEP §1207.01(c). However, a side-by-side comparison is not the test. *See Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 587, 177 USPQ 573, 574 (C.C.P.A. 1973). When comparing design marks, the focus is on the overall commercial impression conveyed by such marks, not on specific differences. *See Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d at 587, 177 USPQ at 574; *In re Triple R Mfg. Corp.*, 168 USPQ 447, 448 (TTAB 1970); TMEP §1207.01(c).

In the instant case, the applicant's mark comprising a jumping horse design is visually similar to the registered marks comprising a prancing horse design and the registered marks comprising a horse in motion because the marks feature designs of moving horses, creating the same overall commercial impression. Therefore, the marks are confusingly similar.

Relatedness of Goods

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Here, as evidenced by the identification of goods in the instant application and cited registrations, the applicant's goods are closely related to the registrants' goods, because the goods listed are automobiles and automobile parts including automobile bodies and wheel covers.

Vehicles and their various accessories, parts, and attachments may be closely related goods such that the average person encountering the same or similar marks for such products is likely to be confused as to their source. *See, e.g., In re Gen. Motors Corp.*, 196 USPQ 574, 576 (TTAB 1977). It is well established in the marketplace that manufacturers of vehicles often produce accessories and attachments for such vehicles and market them under the same mark. *E.g., In re Gen. Motors Corp.*, 23 USPQ2d 1465, 1469 (TTAB 1992); *In re Sien Equip. Co.*, 190 USPQ 84, 85 (TTAB 1976).

Neither the application nor the registrations contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., automobile parts and accessories stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii).

Accordingly, because confusion to source is likely, registration is refused under Trademark Act Section 2(d) based on a likelihood of confusion.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

If applicant responds to the refusal, applicant must also respond to the requirements set forth below.

Identification of Goods

Particular wording in the identification of goods is indefinite and too broad. This wording must be clarified because it is not clear what the goods are and could identify goods in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii). Please see specific requirements appearing below in italicized lettering and suggested wording that the applicant may adopt appearing below in bold lettering.

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and/or services from that assigned by

the International Bureau of the World Intellectual Property Organization in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, although the goods may be classified in several international classes, any modification to this wording must identify goods in International Class 012 only, the class(es) specified in the application for these goods and/or services. *See* TMEP §1904.02(c), (c)(ii).

Applicant may adopt the following wording in International Class 012, if accurate:

Class 012: “*{specify type of vehicle, e.g. Electric vehicles **namely, cars**}; automobile chassis; hub caps; vehicle running boards; ski carriers for cars; automobiles; automobile bodies; bumpers for automobiles; spare wheel covers; hubs for vehicle wheels*”

Applicant may amend the identification to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and/or services may not later be reinserted. *See* TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO’s online searchable [*U.S. Acceptable Identification of Goods and Services Manual*](#). *See* TMEP §1402.04.

Mark Description

The applied-for mark is not in standard characters and applicant did not provide a description of the mark with the initial application. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. *See* 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b).

Therefore, applicant must provide a description of the applied-for mark. The following is suggested:

The mark consists of a design of a stylized jumping horse appearing over a shaded square design contained inside a metallic circle design.

Foreign Pro Se Applicant May Wish to Seek Trademark Counsel

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a qualified U.S. attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant’s legal rights. TMEP §§705.02, 709.06. For attorney referral information, applicant may consult the [*American Bar Association’s Consumers’ Guide to Legal Help*](#) or an online directory of legal professionals, such as [FindLaw®](#). The USPTO, however, may not assist an applicant in the selection of a private attorney. 37 C.F.R. §2.11.

Please note that foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(c).

The only attorneys who may practice before the USPTO in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories; and**
- (2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(a), (e), 11.1, 11.14(a), (c); TMEP §602.

MANDATORY ELECTRONIC FILING RULES ADVISORY

The USPTO proposes to change federal trademark rules to require applicants and registrants to (1) file submissions concerning applications and registrations online using the USPTO’s Trademark Electronic Application System (TEAS) and (2) provide and maintain an accurate email address for receiving correspondence from the USPTO. [*See the Mandatory Electronic Filing Rules webpage for more information.*](#)

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; see 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a) (1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

/Natalie Polzer/
Trademark Examining Attorney
Law Office 108
Phone: (571) 272-4103
natalie.polzer@uspto.gov (not for formal responses)

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Print: Jul 10, 2018

72286258

DESIGN MARK

Serial Number

72286258

Status

REGISTERED AND RENEWED

Registration Number

0863434

Date Registered

1969/01/14

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(2) DESIGN ONLY

Owner

Ferrari S.p.A. CORPORATION ITALY Via Emilia Est 1163 MODENA ITALY
41100

Goods/Services

Class Status -- ACTIVE. IC 012. US 019. G & S: AUTOMOBILES. First
Use: 1965/11/14. First Use In Commerce: 1965/11/25.

Filing Date

1967/12/05

Examining Attorney

UNKNOWN

Attorney of Record

Curtis Krechevsky



DESIGN MARK

Serial Number

73590492

Status

REGISTERED AND RENEWED

Registration Number

1416549

Date Registered

1986/11/11

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(2) DESIGN ONLY

Owner

FORD MOTOR COMPANY CORPORATION DELAWARE ONE AMERICAN ROAD DEARBORN
MICHIGAN 48126

Goods/Services

Class Status -- ACTIVE. IC 012. US 019. G & S: AUTOMOBILES AND
THEIR STRUCTURAL PARTS, WHEELS AND WHEEL COVERS. First Use:
1964/04/15. First Use In Commerce: 1964/04/15.

Lining/Stippling Statement

THE STIPPLING IN THE DRAWING IS FOR SHADING PURPOSES ONLY.

Filing Date

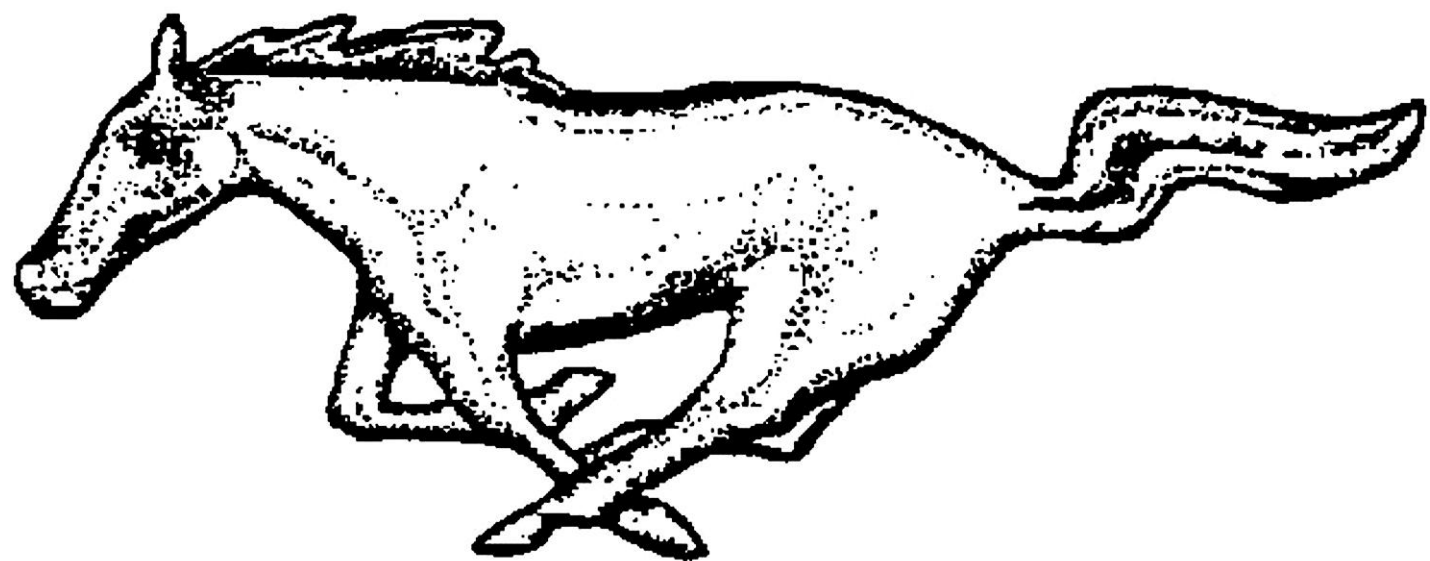
1986/03/28

Examining Attorney

STINE, DAVID

Attorney of Record

Casimir W. Cook II



DESIGN MARK

Serial Number

76616921

Status

REGISTERED AND RENEWED

Registration Number

3084187

Date Registered

2006/04/25

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(2) DESIGN ONLY

Owner

FORD MOTOR COMPANY CORPORATION DELAWARE One American Road Dearborn
MICHIGAN 48126

Goods/Services

Class Status -- ACTIVE. IC 012. US 019 021 023 031 035 044. G & S:
AUTOMOBILE PARTS, NAMELY, AUTOMOBILE GRILLES. First Use: 1964/04/16.
First Use In Commerce: 1964/04/16.

Prior Registration(s)

1416549;1921847;2000115;AND OTHERS

Description of Mark

The mark is three dimensional.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2004/10/20

Examining Attorney

FOSTER, STEVEN

Attorney of Record

Casimir W. Cook II



Print: Jul 10, 2018

78459836

DESIGN MARK

Serial Number

78459836

Status

REGISTERED AND RENEWED

Registration Number

3084537

Date Registered

2006/04/25

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(2) DESIGN ONLY

Owner

Ferrari S.p.A. SOCIETA PER AZIONI ITALY Via Emilia Est 1163 41100
Modena ITALY

Goods/Services

Class Status -- ACTIVE. IC 012. US 019 021 023 031 035 044. G & S:
Land motor vehicles and structural parts and accessories thereof sold
as a unit; engines, transmissions, suspensions and brakes for land
vehicles; motor car bodies; [motorbikes;] bicycles.

Foreign Country Name

ITALY

Foreign Registration Number

209029

Foreign Registration Date

1966/11/12

Foreign Expiration Date

1967/05/30

Foreign Renewal Registration Number

745553

Foreign Renewal Registration Date

1996/06/27

Print: Jul 10, 2018

78459836

Foreign Renewal Expiration Date

2006/06/27

Prior Registration(s)

0862632;0862633;0863434;AND OTHERS

Description of Mark

The mark consists of a representation of a prancing horse.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2004/07/30

Examining Attorney

WILKE, JOHN

Attorney of Record

Curtis Krechevsky

