

**This Opinion is Not a
Precedent of the TTAB**

Mailed: August 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Honda Motor Co., Ltd.

v.

Independent Cycle Inc.
—

Opposition No. 91218067
to Application Serial No. 86138520
—

Dyan Finguerra-Ducharme and Ryan S. Klarberg of Pryor Cashman LLP
for Honda Motor Co., Ltd.

Troy N. Leonard and Sander J. Morehead of Woods, Fuller, Shultz & Smith P.C.
for Independent Cycle Inc.

—
Before Kuhlke, Shaw and Greenbaum,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Independent Cycle Inc., seeks registration of the mark **LegendAero** in standard characters for goods identified as “Suspension systems for motorcycles, all-terrain vehicles (ATVs), utility terrain vehicles (UTVs),” in International Class 12.¹

¹ Application Serial No. 86138520, filed on December 9, 2013, based on an allegation of a *bona fide* intention to use the mark in commerce under Section 1051(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Opposer, Honda Motor Co., Ltd., has opposed registration of Applicant's mark on the ground that as used in connection with Applicant's goods, the mark so resembles Opposer's previously used and registered marks AERO for "motorcycles and structural parts therefor," and SHADOW AERO for "motorcycles and structural parts thereof," as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). By its answer, Applicant admitted that:

Opposer "is engaged in the business of manufacturing, marketing and selling, among other products, motorcycles and structural parts therefor, as well as all-terrain vehicles (ATV)s, throughout the world, including the United States";

Opposer is the "owner of U.S. Registration No. 2,260,820" and "Exhibit A is a copy of that registration";

Opposer is the "owner of U.S. Registration No. 2,932,931" and "Exhibit B is a copy of that registration"; and

Applicant is a South Dakota corporation in Sturgis, South Dakota and it filed the subject application on December 9, 2013.

Applicant otherwise denied the remaining salient allegations.

RECORD

The pleadings and, by operation of the Trademark Rules, the file of the subject application are of record. Trademark Rule 2.122, 37 C.F.R. § 2.122.

Opposer attached to its notice of opposition printouts from the USPTO Trademark Status & Document Retrieval database (TSDR) consisting of copies of its pleaded registrations showing their current status and title. The registrations are summarized as follows:

Registration No. 2932931 on the Principal Register for the mark AERO in standard characters for “Motorcycles and structural parts therefor,” in International Class 12, filed on November 21, 2003, issued on March 15, 2005, section 8 and 15 combined declaration accepted and acknowledged, renewed; and

Registration No. 2260820 on the Principal Register for the mark SHADOW AERO in typed form² for “motorcycles and structural parts thereof,” in International Class 12, filed on April 13, 1998, issued on July 13, 1999, section 8 and 15 combined declaration accepted and acknowledged, renewed.

In addition, Opposer submitted under notice of reliance (“NOR”) (1) more current TSDR copies of Opposer’s pleaded registrations, (2) Applicant’s responses to Opposer’s interrogatories, (3) Applicant’s responses to Opposer’s requests for the production of documents indicating whether or not responsive documents exist, and (4) Applicant’s responses to Opposer’s requests for admission.³

Finally, Opposer submitted declaration testimony,⁴ with accompanying exhibits, of Scott Proffer, Motorcycle Product Planning Manager for Opposer’s wholly owned subsidiary American Honda Motor Co., Inc. (“AHM”),⁵ and Lee Edmunds, Motorcycle National Advertising Manager for AHM.⁶

² Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (April 2016).

³ 9 TTABVUE; Confidential version 10 TTABVUE.

⁴ The parties stipulated to the submission of testimony by declarations or affidavits. 5 TTABVUE.

⁵ 11 TTABVUE; 12-13 TTABVUE (confidential version); 21 TTABVUE (rebuttal testimony).

⁶ 14 TTABVUE; 15 TTABVUE (confidential version).

Applicant submitted the declaration testimony, with accompanying exhibits, of Jesse Jurrens, founder and shareholder of Applicant.⁷

In addition, Applicant submitted under NOR (1) printouts of third-party registrations with marks that contain the term AERO, (2) printouts of web pages showing use of the marks in some of the third-party registrations and use of the term AERO by other third-parties, (3) internet search results for the search logic “aero & motorcycle,” (4) Wikipedia entry for “Aero (motorcycle),” and (5) Opposer’s responses to Applicant’s requests for production of documents and requests for admission.⁸

STANDING/PRIORITY

Because Opposer’s pleaded registrations are of record, are valid and subsisting, and owned by Opposer, Opposer’s standing to oppose registration of Applicant’s mark is established and its priority is not in issue as to the goods listed in the registrations. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *King Candy Co., Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn to the issue of likelihood of confusion under Section 2(d).

⁷ 18 TTABVUE.

⁸ 19-20 TTABVUE. The submitted produced documents are authenticated by the admissions.

LIKELIHOOD OF CONFUSION

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (listing thirteen factors). Two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Further, “[a]lthough confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user’s mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection.” *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1429 (TTAB 1993); *see also Majestic*, 65 USPQ2d at 1205 (“[M]istaken belief that [a good] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent”). We focus on Opposer’s registration for the standard character mark AERO because if we do not find a likelihood of confusion with that mark and its associated goods, then there would be no likelihood of confusion with the mark in the other pleaded registration. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Relatedness of the Goods, Channels of Trade, Classes of Consumers

We turn first to the goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in the application and registration, respectively. *See Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”); and *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

The goods listed in Registration No. 2932931 are “motorcycles and structural parts therefor” while the goods listed in the Application are “suspension systems for motorcycles.” Applicant’s goods and those of the Registrant are identical to the extent that Applicant’s “suspension systems for motorcycles” are encompassed by Opposer’s broader identification of “motorcycles and structural parts therefor.” *See, e.g., Proffer Test.*, 11 TTABVUE 7 (“structural parts, such as suspension systems”). We need not discuss the relationship between motorcycles in general and motorcycle suspension systems, because “a likelihood of confusion may be found with respect to a particular class based on any item within the identification of goods for that class.” *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1073 (TTAB

2011); see *Tuxedo Monopoly Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).


Considering the channels of trade and classes of purchasers, because there are no limitations as to channels of trade or classes of purchasers in either the application or Opposer's registration, we must presume that Applicant's and Opposer's goods travel through all usual trade channels for such goods and to all classes of prospective purchasers for those goods. See *Paula Payne Prods. Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973); and *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Thus, to the extent Applicant's goods are identical to the Registrant's, we must likewise presume that the purchasers and channels of trade for such goods are also identical. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"); see *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Moreover, Opposer’s witness, Mr. Proffer, testified that Opposer’s “motorcycle structural parts, such as suspension systems, are marketed and sold by retailers regardless of their direct affiliation with [Opposer]”⁹ and the record includes examples where the parties’ motorcycle parts are sold by the same online retail store,¹⁰ as shown below.¹¹

LEGEND LEGEND AERO-A TRI GLIDE ADJUSTABLE AIR SUSPENSION

- All the benefits of the Legend AERO suspension system above plus six internal shock adjustments allow the fine-tuning of rebound damping
- Provide optimum rebound performance for any given rider weight, personal ride-quality preference or personal riding style
- Light to heavy riders can fine-tune ride preference
- Riders with aggressive to casual styles can tune to desired quality or personal preference
- Tri-Glide rear 15 lb PART #1313-0120 also available (sold separately on page ???)
- Made in the U.S.A.

Appears on page 1454 of 2015 FatBuck™




BRIDGESTONE EXEDRA


CRUISER RADIAL TIRES FOR HONDA VALKYRIE

- Specifically constructed for today's cruiser bikes
- Honda approved replacement radial for Valkyrie models
- Constructed for exceptional ride, comfort and handling
- Unidirectional pattern for reliable performance on dry and wet surfaces
- Radial construction
- Tubless
- Stacked
- Rated for speeds up to 130 mph

Appears on page 52 of 2015 Tire

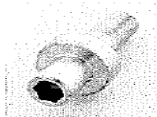


Legend AERO-ST Suspension System



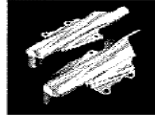
J&P Part: 124477
Everyday Low Price: \$1,549.99
Gold Club Price: \$1,549.99

Honda VTX 1800 Upper Shock Studs



J&P Part: 227872
Everyday Low Price: \$10.99
Gold Club Price: \$10.99

Kuryakyn Lower Fork Skirts for Honda VTX1800



J&P Part: 222104
10%!
Crossed Price: \$125.96
Regular Price: \$130.96

Product Description:
 Finish: Chrome
 OEM Reference: 52452-ADH-000
 Sold in Lots: Each
 (View Item)

In Stock

Qty: 1
 Add to Cart

⁹ Proffer Test., 11 TTABVUE 7.

¹⁰ Proffer Test. Exhs. 11-16, 11 TTABVUE 72-175.

¹¹ Retailer Drag Specialties, 11 TTABVUE 81, 87; and JP Cycles, 11 TTABVUE 113, 126. See also Opp. NOR Exh. C-2, 9 TTABVUE 41-42 (Applicant’s admissions that Drag Specialties offers parts for Opposer’s motorcycles).

In addition, the first three results from a search for “Honda” and “Legend Aero” on the internet brought up Honda dealerships that offer for sale both Applicant’s LEGENDAERO products and Opposer’s AERO and SHADOW AERO motorcycles.¹²

In view of the above, the *du Pont* factors of the similarity of the goods, the channels of trade, and classes of purchasers favor a finding of likelihood of confusion.

With regard to the conditions of sale, Applicant argues that the parties’ potential purchasers “will exercise more care in making purchasing decisions” because of the cost of Applicant’s suspension systems, approximately \$ 1,175, and Opposer’s motorcycles are also expensive. App. Br., 25 TTABVUE 22.¹³ Further, Applicant asserts that “[p]urchasers of aftermarket motorcycle parts, especially more expensive components like [Applicant’s] aftermarket coil and air systems, are very sophisticated and discriminating. These purchasers are particularly brand conscious and typically engage in substantial research about competitive products before selecting a component or their personal motorcycle.” App. Br., 25 TTABVUE 27.¹⁴ By contrast Opposer asserts that such purchasers are not discriminating and the “primary concern is whether the part is compatible with their motorcycle [and] a suspension system called LEGENDAERO will lead consumers to mistakenly believe that the part is compatible with the Honda AERO/SHADOW AERO motorcycle because there are no other motorcycles on the market that include the AERO mark

¹² See Proffer Rebuttal Test., 21 TTABVUE 3, 6.

¹³ We note the record shows that some of Opposer’s aftermarket parts are inexpensive items as shown above.

¹⁴ See also Jurrens Test., 18 TTABUVE 8.

in the brand name.”¹⁵ Opposer also asserts that its consumer survey filed under seal “shows that the level of sophistication among purchasers of the products at issue widely varies.” Opp. Rebuttal Br., 26 TTABVUE 19.

While purchasers of motorcycles and structural parts therefor, including suspensions, may be somewhat more discriminating in their purchase, this record does not support a finding that the level of care exercised in such purchase would obviate confusion. Even where there may be some care taken in the purchasing process, consumers sophisticated or knowledgeable in a particular field are not necessarily immune to source confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). We find this factor to be neutral.

Strength of Opposer’s Mark

Opposer argues that Opposer’s SHADOW AERO and AERO marks are famous based on inherent strength and marketplace strength. As acknowledged by Opposer, Opp. Br., 22 TTABVUE 19,¹⁶ the term AERO is suggestive of aerodynamic qualities, and as such, although inherently distinctive it is not a conceptually strong mark. However, Opposer has established that the SHADOW AERO and AERO marks have attained commercial strength for motorcycles and structural parts therefor. The evidence shows the marks SHADOW AERO and AERO have been in use for many years and have enjoyed broad consumer exposure. SHADOW AERO has been used on motorcycles which have been sold in high quantities for nearly two

¹⁵ Proffer Rebuttal Test., 21 TTABVUE 3.

¹⁶ *See also* App. Br., 25 TTABVUE 15.

decades;¹⁷ AERO is placed on the speedometer of the motorcycle;¹⁸ the website, marketing materials and press releases use both marks interchangeably;¹⁹ both marks are advertised in a range of media including cable and network television, radio, print advertisements in national publications, billboards, mobile advertising, banners at sports arenas, and dealer materials, website advertising, search engine marketing;²⁰ and both marks have received some unsolicited media mentions.²¹

In the likelihood of confusion context, fame “varies along a spectrum from very strong to very weak.” *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005)). A famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. The

¹⁷ Proffer Test., 11 TTABVUE 6. The specific numbers were submitted under seal.

¹⁸ Proffer Test. Exh. 3, 11 TTABVUE 23.

¹⁹ Edmunds Test., 14 TTABVUE 4-5.

²⁰ Edmunds Test., 14 TTABVUE 4; Edmunds Test. Exhs. 3-4, 14 TTABVUE 39-50, 56-65 (the examples appear to be limited to website and radio advertising).

²¹ Edmunds Test. Exh. 2 14 TTABVUE 12-37 Rider Magazine, Motorcycle USA, The Auto Channel.

commercial strength of a mark “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods or services traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 63 USPQ2d at 1305. In addition, some context in which to place raw statistics may be necessary. *Id.* at 1309.

Opposer did not provide evidence as to the market share for the SHADOW AERO and AERO motorcycles to better understand the impact of the sales and advertising figures. In addition, while there is testimony as to advertising on television and at sports arenas, etc., the only evidentiary examples consist of website advertising and the transcript of a radio advertisement. Nonetheless, although the record does not support a finding of fame, such that it plays a dominant role, we find that SHADOW AERO and AERO by itself have attained commercial strength for motorcycles and structural parts therefor and accord them a broader scope of protection.

Applicant argues that third-party use and registration of the term AERO “in the motorcycle market, reflects that the term ‘AERO’ has become synonymous with or descriptive of motorcycle-related or aerodynamic goods.” App. Br., 25 TTABVUE 15. Applicant specifically points to several examples of use from the record; for example, AERO FLEX and AERO TAPERED for motorcycle handlebars;²² AERO WINDSHIELD for motorcycle windshield;²³ AERO MACH and design for a heel

²² 19 TTABVUE 235-237.

²³ 19 TTABVUE 240-243.

shifter for motorcycles;²⁴ AEROFLOW and design for headlight covers and fairings;²⁵ AEROCHARGER for turbo systems for motorcycles;²⁶ AERO SKIRT for a skirt for motorcycles;²⁷ and TECH AERO for tank bags for motorcycles.²⁸ The Board also notes the mark AERO ROTORS for rotors for vehicle brakes.²⁹ Many of the other third-party uses are for different goods, even if generally in the vehicle field. For example, AEROSTITCH for primarily motorcycle clothing (but also other accessories such as tank bags, and products sold under other marks such as helmets, tents etc. on the online store);³⁰ AERO LEATHER for motorcycle jackets;³¹ AERO SHEILD for trailers to transport motorcycles;³² AERO TRAILERS for trailers to transport vehicles;³³ AERO STAR GLOBAL LOGISTICS, INC. for motorcycle transportation services;³⁴ AERO RACE WHEELS for wheel rims for

²⁴ 19 TTABVUE 244-247.

²⁵ 19 TTABVUE 248-255.

²⁶ 19 TTABVUE 256-260.

²⁷ 19 TTABVUE 262-264.

²⁸ 19 TTABVUE 267.

²⁹ 20 TTABVUE 165-171.

³⁰ 19 TTABVUE 97-227.

³¹ 19 TTABVUE 238-239.

³² 19 TTABVUE 267.

³³ 19 TTABVUE 270.

³⁴ 20 TTABVUE 35-36.

vehicles (appear to be only for cars);³⁵ AERO FIX for bicycles;³⁶ AERO for paint for vehicles.³⁷

The third-party registrations include OREGON AERO and design for motorcycle helmets and accessories³⁸; AEROPEG for motorcycle foot pegs;³⁹ OREGON AERO and design for seat cushions for land vehicles;⁴⁰ AERO and design for wheel rims.⁴¹ Most of the third-party registrations are for different goods, even if generally in the vehicle field. *See also* AEROTEX for acoustic insulation for automotive industry;⁴² AERO SPRAY aerosol paints for automobiles;⁴³ AEROS for bicycle frames;⁴⁴ AEROVORTEX for vortex generators for use on automobiles and trucks.⁴⁵ Such registrations are less relevant and as such have less probative value.

As noted by Opposer there are no specifics regarding the extent of sales or promotional efforts surrounding the third-party marks; however, third-party registrations and some evidence of use in the form of web pages may be sufficient where a considerable number of third parties use similar marks in connection with similar goods or services. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334,

³⁵ 20 TTABVUE 38-44.

³⁶ 20 TTABVUE 45-75.

³⁷ 20 TTABVUE 79-83.

³⁸ 19 TTABVUE 24.

³⁹ 19 TTABVUE 25.

⁴⁰ 19 TTABVUE 61.

⁴¹ 19 TTABVUE 78.

⁴² 19 TTABVUE 31.

⁴³ 19 TTABVUE 34.

⁴⁴ 19 TTABVUE 38.

⁴⁵ 19 TTABVUE 74.

115 USPQ2d 1671, 1674-1675 (Fed. Cir. 2015). *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (cert. denied January 25, 2016). Here, the examples of third-party use are for somewhat different goods. While they are in the same general vehicular industry or in some cases specific to motorcycles, none are for suspensions for motorcycles.⁴⁶ This record does not reveal “extensive evidence of third-party use and registrations” in connection with “motorcycles and structural parts therefor” and in particular “Suspension systems for motorcycles, all-terrain vehicles (ATVs), utility terrain vehicles (UTVs).” *Jack Wolfskin v. New Millennium*, 116 USPQ2d at 1136.

The probative evidentiary value of the third-party registrations alone is in showing the sense in which the term AERO is used and understood. *Id.* at 1675; *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) (third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). As discussed above, the term AERO has some suggestiveness evoking the concept of “aerodynamic” in relation to vehicular goods, including motorcycles. The relevant third-party registrations serve to

⁴⁶ There is one registration that includes “parts and components of motorcycles, namely, ... shock absorbers, suspension forks” in the identification of goods; however, it is based on Section 66(a) of the Trademark Act which does not require use in the United States prior to registration and the evidence of use of this mark (DT aerolite) in the U.S. market is limited to bicycle components. See App. NOR, 19 TTABVUE 19 (registration), 228-232 (web pages “DT Swiss is a globally renowned manufacturer of bicycle components with branches in the USA ...”). Several of the third-party registrations are based on either Section 66(a) or Section 44 of the Trademark Act and have less probative value as to the meaning of a term to U.S. consumers.

corroborate this and Opposer does not dispute this fact. Opp. Br., 22 TTABVUE 19 (“[T]he AERO mark is a suggestive mark”).

As to the question of the effect of third-party use on consumer perception, this record does not establish that the term AERO is used in connection with similar goods to such an extent that customers “have been educated to distinguish between different ... marks on the basis of minute distinctions,” *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383 (TTAB 1976); at least not to the extent that a mark that encompasses the entirety of the prior mark on identical goods is not likely to cause confusion. Thus, while the evidence does weigh in favor of Applicant by narrowing the scope of protection for the term AERO in connection with vehicle parts and accessories generally, including motorcycle parts and accessories, it does not outweigh the factors of the similarity of the marks, relatedness of goods and trade channels in this case.

Similarity/Dissimilarity of the Marks

We turn then to the *du Pont* factor of the similarities and dissimilarities between Applicant’s mark **LegendAero** and Opposer’s mark AERO. We analyze “the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Viterra*, 101 USPQ2d at 1908 *quoting du Pont*, 177 USPQ at 567. *See also Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1691. “When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Applicant argues that LEGEND is the dominant portion of its mark because it is the first portion and “most likely to be impressed upon the mind of a purchaser and remembered.” App. Br. (quoting) *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), 25 TTABVUE 24-25. Applicant further argues that portion of its mark common to Opposer’s mark, AERO, is weak based on the evidence of use and registration of this term “in the relevant market space.” *Id.*

While the common term AERO has some suggestive significance, and is used by itself or as a part of a mark for various vehicular parts and accessories, including in a few cases certain motorcycle parts and accessories, Opposer’s mark AERO does have commercial strength in relation to motorcycles and their structural parts.

Applicant’s mark incorporates the entirety of Opposer’s AERO mark. However, Applicant asserts that the LEGEND portion of its mark distinguishes them not only because it is first and AERO is weak but also because it is Applicant’s house mark. Opposer argues that adding the “purported house mark ‘Legend’ does not minimize the risk of confusion because the dominant portion of both marks -- AERO -- is the same.” Opp. Br., 22 TTABVUE 21. Opposer asserts that consumers will look to the common meaning of the word LEGEND suggesting that the “goods have something to do with the past.”⁴⁷ Opp. Br., 22 TTABVUE 23.

⁴⁷ The Board grants Opposer’s request for judicial notice of the dictionary definition for LEGEND as “a story coming down from the past; especially: one popularly regarded as historical although not verifiable.” www.merriam-webster.com; *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Applicant relies on *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2013) in support of its argument that the addition of its house mark precludes a finding of likelihood of confusion. However, in that case the common term ESSENTIALS was registered by third-parties for identical or nearly identical goods to the goods in issue. Here, the third-party registrations and uses are not for “suspensions systems for motorcycles, all-terrain vehicles (ATVs), utility terrain vehicles (UTVs).” In addition, the term ESSENTIALS was found to be highly suggestive, whereas this record does not support that level of suggestiveness and the record establishes a higher level of strength of the mark AERO for Opposer’s motorcycles.

As recognized by Applicant the addition of other matter may serve to distinguish the marks where (1) the marks in their entireties convey different commercial impressions or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *General Mills Inc. v. Fage Dairy Processing Industry S.A.*, 100 USPQ2d 1584, 1601, (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *Citigroup v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (CAPITAL CITY BANK held not likely to be confused with CITIBANK)), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). In this case, the addition of LEGEND does not convey such a different

commercial impression to obviate confusion nor is AERO descriptive or so diluted to preclude confusion.

Further, because Applicant seeks registration in standard characters, its mark is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re RSI Systems, LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Thus, we must consider Applicant's mark "regardless of font style, size, or color," including the manner in which Applicant actually uses the mark. *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d at 1258-59. Applicant's uses illustrate this point:⁴⁸

Legend AERO-A Features:

- All the benefits of the new Legend AERO Suspension systems above, plus six external knob adjustments allow the fine-tuning of rebound damping

**LEGEND
AERO**
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⁴⁸ Jurrens Test. Exhs. C, D, G 18 TTABVUE 20, 23, 58, 59.

We find the marks to be similar in appearance, sound, meaning and overall commercial impression, and this similarity in the marks outweighs the dissimilarities. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (confusing similarity found where the mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and LION was dominant part of both parties' marks). This factor weighs heavily in Opposer's favor.

Extent of Potential Confusion

Applicant argues that the potential for confusion is *de minimis* in view of the price of the parties' goods, the sophistication of the purchasers and the "myriad of third party uses and registrations containing some formative of 'AERO'." App. Br., 25 TTABVUE 24-25. Applicant relies on *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015) in support of its argument.

In view of the legally identical goods, the similarity of the marks, in particular considering displays of Applicant's mark that may emphasize the term AERO and the commercial strength of Opposer's mark, and the identical trade channels, likely confusion is not *de minimis*. The record in the *ex parte* proceeding *Thor Tech* differs substantially from the record in this *inter partes* proceeding. The record in *Thor Tech* (1) included only two third-party registrations to show a relationship between the involved goods which were rebutted by 50 third-party registrations showing towable recreational vehicles and trucks registered by different entities under the same mark, (2) did not establish overlapping channels of trade, and (3) established

that the towable recreational vehicles and trucks were much more expensive ranging in price from approximately \$8,000 – 40,000.

Balancing the Factors

Because Applicant's standard character mark LegendAero is similar to Opposer's mark AERO, the goods are legally identical, and the channels of trade and classes of consumers overlap, confusion is likely between Applicant's mark LegendAero and Opposer's mark AERO. We acknowledge the narrower scope of protection for the word AERO in connection with motorcycle accessories and some components, however, we resolve doubt as we must against Applicant as the newcomer. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d at 1701 (citing *In re Hyper Shoppes (Ohio)*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The opposition is sustained.